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In the

Supreme Court of the United States

No. 543 October Term, 1949

Jiffy Lubricator Company
plaintiff-petitioner

v.

The Alemite Company
defendant-respondent

Petition for Writ of Certiorari

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Notes:

All emphasis in quotations has been supplied by petitioner, unless otherwise noted.

All parenthetical interpolations, in quotations, and all explanatory footnotes referenced to quotations, have been supplied by petitioner.

In referencing to the printed Transcript of Record, the Roman numerals preceding the letter "R" designate the volume number of the printed Transcript of Record, while the numbers immediately following the letter "R" refer to the pages of such Transcript of Record, and the numerals *following* a diagonal (/) are the line-numbers on the page or on the exhibit whose number immediately *precedes* such diagonal (/).

The abbreviation "PX" is used to designate plaintiff's exhibits and the abbreviation "DX" is used to designate defendant's exhibits.

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Petition for Writ of Certiorari

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Jiffy Lubricator Company, respectfully prays for a writ of certiorari to review the Decision (VIII R 2236-2245 and reported at 176 F.2d 444) and Judgment (VIII R 2246) of the U. S. Court of Appeals for the 8th Circuit rendered in the above-entitled case on August 17, 1949, which

> reversed the judgment (I R 61-62) of the U. S. District Court for the District of North Dakota in favor of petitioner (entered in accordance with the jury's verdict) for the amount of petitioner's actual damages found by the jury (I R 54) as resulting from respondent's infringement of petitioner's patent (and for an additional amount fixed by the trial judge under 35 U. S. C. 70 as petitioner's costs, and for interest), and
>
> overruled the jury's implied fact-finding of invention (expressly concurred in by the trial judge*), and directed entry of a judgment dismissing petitioner's patent-infringement complaint.

Within a time-extension granted therefor (VIII R 2293-4) petitioner filed a timely Petition for Re-Hearing (VIII R 2247-2285) in the Court of Appeals on September 19, 1949, which was denied on October 31, 1949 (VIII R 2287) without opinion.

A certified transcript of the record in the case, including the proceedings in said Court of Appeals, is furnished herewith, in accordance with Rule 38 of this Court.

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*I R 72-73, or see quotation on page 24 hereof

Summary of Matter Involved

This is a patent infringement suit tried to a jury, involving plaintiff-petitioner's "Jiffy" hydraulically-actuated multi-jawed or "chuck" type grease coupler and defendant-respondent's "Alemite" hydraulically-actuated multi-jawed or "chuck" type grease coupler;—respondent's "Alemite" hydraulic coupler having been found to be an infringement of petitioner's Johnson patent 2,040,177 covering said couplers.

The jury found for plaintiff and the trial judge denied respondent's motions for directed verdict and for judgment n. o. v., entered judgment for petitioner in accordance with the verdict and denied respondent's motion for new trial.

The Court of Appeals reversed and directed the dismissal of the complaint on the sole question of invention, (in the admittedly unanticipated construction of the patent in suit), on a prior patent and on authorities *never* relied on by defendant, and inconsistently with its own fact-findings in an earlier equity suit between the parties involving the same subject matter and in disregard of duly pleaded *res judicata* based thereon.

Statement of Matter Involved

Prior litigation between parties in respect to same device

This patent-infringement suit involves the *same* multi-jawed or "chuck" type hydraulic couplers and the *same* parties (or their privies) as were involved in

Stewart-Warner Corp. v. *Jiffy Lubricator Co.* 81 F.2d 786 (CCA-8) *decided February 11, 1936* (certiorari denied 299 U.S. 554),

Lincoln Engineering Co. v. *Stewart-Warner Corp.* 91 F.2d 757 (CCA-7) *decided June 29, 1937* (reversed at 303 U.S. 545), and

Lincoln Engineering Co. v. *Stewart-Warner Corp.* 303 U.S. 545, *decided March 28, 1938.*

The parties

By an agreement (DX-148 at V R 2104-9) dated January 5, 1938 between petitioner, Jiffy Lubricator Co. and Lincoln Engineering Co. (of St. Louis), the latter acquired certain rights in petitioner's Johnson patent 2,040,177 here in suit and under paragraph 6 thereof defrayed or advanced petitioner's expenses of this suit. This agreement was expressly passed on by the District Court prior to trial, upon its denial of respondent's motion (I R 38) to dismiss* on the ground that the Lincoln Engineering Co. was an indispensable party plaintiff;—the District Court holding that this suit was properly maintainable by petitioner as the sole plaintiff. This holding was *not* disturbed by the Court of Appeals.

In *Lincoln* v. *Stewart-Warner,* supra, the defendant-appellant, Lincoln Engineering Co. of Illinois, was a distributor for the Lincoln Engineering Co. (of St. Louis) and the latter defended such suit (91 F.2d 757).

In the suit at bar, defendant-respondent The Alemite Company is an exclusive distributor of Stewart-Warner Corporation under contract (PX-16 at IV R 1374-1384), and the Stewart-Warner Corporation openly and avowedly paid for and directed and controlled the defense of the suit at bar (IV R 1392-3 and III R 1316-7 & 1319 and see also appellate Court's comment in its Opinion at VIII R 2238-9, and see also the trial Judge's statement quoted in footnote 2 on page 4 hereof).

The Bassick Manufacturing Company and the Alemite Corporation are one and the same corporation, merely by a change of name, and such corporation was, at all times herein concerned, a wholly-owned subsidiary of Stewart-Warner Corporation. Until December of 1933 the lubricating-equipment branch of Stewart-Warner's business was carried on by the Alemite Corporation, and since December of 1933 directly by the Stewart-Warner Corporation under its "Alemite Division".

*which motion was based on defendant's Exhibit 148 (V R 2104-9) and upon the depositions of the officers of petitioner and of Lincoln Engineering Co. earlier taken by defendant for the purposes of this motion

Respondent's main defense in case at bar

In the suit at bar respondent placed its main reliance upon the Alemite-owned Butler patent 1,593,791, as its principal or *closest* "prior-art", and contended that the Johnson brothers had not exercised the inventive faculty in bringing into being the hydraulic coupler of petitioner's Johnson patent 2,040,177 here in suit, in view of the disclosure contained in the Butler patent.

Findings and Conclusions of same Court in earlier equity suit between the parties, support the inventive character of the "Jiffy" coupler of the Johnson patent here in suit

In the aforesaid prior (1931-1936) equity suit of *Stewart-Warner* v. *Jiffy* between the parties (or their *privies*[2]) involving the same subject matter, but wherein the parties' positions were reversed, respondent's privies[2]

> successfully contended that the petitioner's "Jiffy" hydraulic coupler (which is the subject-matter of petitioner's Johnson patent 2,040,177 here in suit[3]) placed on the market in 1930, *and* respondent's herein-accused "Alemite" hydraulic coupler placed on the market in 1933, were substantially alike and mechanical equivalents of each other,
>
> and
>
> **un**successfully contended that both petitioner's and respondent's aforesaid couplers were according to the disclosure and covered by the coupler-defining portion of the claim-language of the aforesaid Alemite-owned Butler patent 1,593,791 there in suit.

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[2] Respondent, The Alemite Company, is in privity with Stewart-Warner Corporation and its wholly-owned subsidiary, Alemite Corporation. The trial Judge so found: "You can't disassociate Stewart-Warner from this picture" (VI R 2133)

[3] for which patent-application Serial No. 492,173 (filed October 30, 1930) was then pending in the U. S. Patent Office

In the aforesaid equity suit, wherein both Courts concurred, it was held as follows, *favorably to the presence of invention in the "Jiffy" coupler of the Johnson patent here in suit:*

1. The aforesaid Alemite-owned Butler patent 1,593,791 there in suit had *not* been used commercially[4] and had never accomplished any new or useful result in industry[5]

2. Butler's coupler construction was not an efficient structure[6].

3. The standard of invention specifically applicable to multi-jawed or "chuck" type grease couplers is such that notwithstanding the foregoing, and notwithstanding the fact that the Butler patent was *not* a pioneer[10a] patent

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[4] the Butler "patent has not been put to commercial use" (81 F.2d 793)

[5] "The claim that Butler accomplished a new and useful result in the industry . . . is without merit." (81 F.2d 793)

[6] see footnotes 4 & 5 immediately preceding, and footnotes 11 on page 6 and 12b on page 7 hereof, and Finding of Fact XIII in the prior equity suit:

"in the construction shown by the Butler patent No. 1,593,791 the nipple is gripped by locking members which are forcibly compressed by spring fingers mounted on the piston and moved longitudinally by the forward movement of the piston. All of the pressure forcing the locking members inwardly is attributable to the action of the spring fingers. Neither the locking members nor the spring fingers project through or into any opening in the end of the cylinder. The spring fingers are supported *only* at the base where they are attached to the piston. *As lubricant pressure increased, internal pressure tending to force said spring fingers apart and to force the nipple out of the coupler is increased and the only resistance to such internal pressure is the inherent strength of such fingers.*"

(pages 40 & 41 of Volume I of the printed Transcript of Record in the case of *Stewart-Warner* v. *Jiffy* 81 F.2d 786; CCA-8; and 299 U. S. 554; No. 114 of the October Term, 1936 of this Court)

[10a] ". . . it is my opinion that the Butler patent is valid . . . it is not a pioneer patent . . . the drawings clearly show the purpose of mind of the inventor as he envisions his own patent and that it contemplated the use of spring fingers actuated by jaws free at one end, and he is limited to that."

"The Johnson patent does not include spring fingers, and the mechanism is not, in my judgment, the equivalent of the Butler patent, and I shall so hold."

(the District Court's Opinion on page 34 of Volume I of the printed Transcript of Record in the case of *Stewart-Warner* v. *Jiffy* 81 F.2d 786; CCA-8; and 299 U. S. 554; No. 114 of the October Term, 1936 of this Court)

[10b] ". . . the difference between the Butler patent and the Jiffy coupler (is) *substantial,* in that the mechanical or engineering principle . . . (of) the Butler patent . . . is different from that relied upon in the Jiffy structure . . ." (81 F.2d 793)

and the earlier Newton patent 1,118,876 (there and here relied on as "prior-art") showed Butler's specific "spring-finger" construction in a multi-jawed or "chuck" type coupler[7], Butler's coupler was nevertheless patentably *inventive*[8 & 9] over that and all other prior-art, although differing therefrom *only* in that Newton used a *side*-sealing member whereas Butler used an *end*-sealing member[9] (both urged into sealing relation by fluid pressure).

4. Neither petitioner's "Jiffy" hydraulic coupler[10a & 10b] *nor* respondent's "Alemite" hydraulic coupler[11] (there and here in suit) is according to the disclosure of the Butler patent, and *both* are *substantially different from*

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[7] "Newton showed a coupler comprising a sleeve or cylinder, an apertured piston movable within the cylinder, a sealing means to receive the end of the nipple of a hose, radially yielding spring fingers, extending from a clamping ring mounted upon the carrying plate portion of the piston; the fingers and piston being longitudinally movable in the cylinder." (81 F.2d 790-1)

. . . . . .

"The structure of Newton and the structure which plaintiff has made up for the embodiment of Butler each has a coupler and they have chuck elements. Both may be classified as automatic chucks; in each there is an automatic sealing of parts kept in contact during injections made under pressure. There are several elements in each which operate according to the same old, well-known mechanical principles. The pressure introduced into Newton's cylinder moves his apertured piston forward on the same principle on which Butler's does . . ." (81 F.2d 791)

[8] "We think that when we allow to the Butler patent such presumption of validity as its issuance by the Patent Office would entitle it to (citing cases), even though neither Lavoie nor Newton were there cited against it (citing cases), that the defense of anticipation for want of novelty was not sustained." (81 F.2d 791)

[9] "The differences between the sealing and clamping mechanisms revealed by the Newton patent and the gripping and end-sealing of the plaintiff's model coupler are so substantial that the teaching of the Newton patent *would not enable a mechanic, skilled in the art, to make such a coupler* for lubricating apparatus, *but invention would be necessary.*" (81 F.2d 791)

[11] "The plaintiff (*Stewart-Warner Corp.*) has not made or sold any coupler constructed according to the above drawing and specifications of its Butler patent, nor had it made or sold any couplers in which the pressure of the lubricant actuated the compression or gripping of the parts upon the bearing nipple until long after it had received examples of the defendant's so-called Jiffy lubricator. (81 F.2d 788)

[10a & 10b] see footnotes on page 5, supra.

Butler's disclosure[12] and are ***not mechanical equivalents of the constructions or mechanisms disclosed in the Butler patent***[13].

5. Butler did not invent and does not disclose a coupler construction such as is the subject-matter of the Johnson patent here in suit[14].

6. The "Jiffy" hydraulic coupler (which is the subject-matter of the petitioner's Johnson patent here in suit) is an **invention**[15].

7. Petitioner's "Jiffy" hydraulic coupler and respondent's herein-accused "Alemite" hydraulic coupler are substantially the same and are mechanical equivalents of each other[16] (as there contended by respondent's privies).

12a ". . . we find the latter (i. e. "the coupler . . . made up by" Stewart-Warner "to demonstrate the Butler patent") to be a departure and different from the real disclosure of that patent" (81 F.2d 793)

12b "It seems clear that the compression of spring fingers—elastic members which yield under stress and return to normal when stress is removed—is substantially different from compression by wedging action" (81 F.2d 793)

12c ". . . this Court distinguished the Jiffy hydraulic coupler, the accused device in that case, from the device of Butler, and was of the view that the Alemite hydraulic coupler, made by the Stewart-Warner Corporation, did not conform to the Butler patent," **(176 F.2d 447)**

13 "they are *not* mechanical equivalents" (81 F.2d 793)

14 ". . . it does not appear that Butler invented or disclosed such a chuck as that made by Jiffy" (81 F.2d 793)

15 "That locking members consisting of jaws or chuck members actuated longitudinally by the body of a movable core or piston, without the interposition of spring fingers and which are moved radially and produce locking action upon a nipple by being propelled by such piston body or core through or into a restricted opening in the end of a coupler cylinder (i. e. **the "Jiffy" hydraulic coupler**) are not mechanical equivalents of such (i. e. Butler's) specific means, but (the "Jiffy" coupler is) a different **invention."**
(District Court's *Conclusions of Law,* on pages 41 & 42 of Volume I of the printed Transcript of Record in the case of *Stewart-Warner* v. *Jiffy* 81 F.2d 786; CCA-8; and 299 U.S. 554; No. 114 of the October Term, 1936 of this Court)

16 "Although we consider the Jiffy coupler *a clear mechanical equivalent* of the coupler which has been made up by the plaintiff (i. e. Stewart-Warner) to demonstrate the Butler patent, we find the latter to be a departure and different from the real disclosure of that patent" (81 F.2d 793)

8. The coupler construction which is the subject-matter of the patent here in suit is an efficient structure[17 & 18].

9. Respondent's later-marketed (and herein-accused) "Alemite" hydraulic coupler was inspired by[17] and copied[19] from petitioner's efficient and earlier-marketed "Jiffy" hydraulic coupler.

Plaintiff-petitioner's plea of res judicata in case at bar

Petitioner duly pleaded (in its Complaint[1] and in its Amended Complaint[2]) that the aforesaid fact-findings and decisions of the Courts in the aforesaid earlier equity suit[3] are *res judicata* in the case at bar and that respondent was thereby estopped to deny the matters so determined in said earlier suit.

Evidence at bar sustains Courts' findings in an earlier suit and also independently sustains the verdict at bar which is consistent with Courts' findings in earlier suit

The evidence in the case at bar independently and more completely and conclusively showed the same facts which both Courts found in the earlier suit as hereinabove outlined;—inter alia, that petitioner's Jiffy coupler

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17 . . . the (Alemite hydraulic coupler is) a departure and different from the real disclosure of the (Butler) patent and . . . not suggested by the teaching of the Butler patent, but more probably, according to the evidence, by **the efficient structure of the** (earlier-marketed) **Jiffy coupler"** (81 F.2d 793) See also foregoing footnote 12c

18 "Shortly after its organization the *Jiffy* Company put on the market its lubricating apparatus which included a *coupler* intended and adapted to connect the coupler to the type of nipple above described by gripping on to the part of the tube of the nipple which extends out beyond the pin. It *combines automatic gripping and sealing of the parts and* **works effectively."** (81 F.2d 788)

19 "The plaintiff (Stewart-Warner) has not . . . made or sold *any* couplers in which the pressure of the lubricant actuated the compression or gripping of the parts upon the bearing nipple until long after it had received examples of the defendant's so-called Jiffy lubricator" (81 F.2d 788)

1 paragraphs 24 to 27 of the Complaint at I R 9-10

2 paragraphs 36, 38, 39 & 40 of the Amended Complaint at I R 24-25

3 *Stewart-Warner* v. *Jiffy*, 81 F.2d 786 (CCA-8)

(which is the subject matter of its Johnson patent here in suit) is a different *invention* from and superior to that disclosed in respondent's Butler patent and that respondent's commercial exploitation of its "Alemite" hydraulic grease-coupler, commenced in the middle of 1933, was a direct result of its copying of petitioner's Jiffy hydraulic coupler put on the market three years earlier (all as shown more fully on page 8 and pages 11 to 16 hereof).

Commercial success of the hydraulic coupler involved in the suit at bar and also involved in the earlier suits

In each of the aforesaid earlier suits the device in suit was the same as the device in suit in the case at bar, namely, the *hydraulically actuated multi-jawed or "chuck" type coupler which,* since about 1930-1933[1], *has* virtually *completely* (i.e. 98% to 99%) *replaced*[2] both the bayonet type "Alemite" coupler of the Alemite-owned Gullborg patent 1,307,734[3] and the alternative push-contact type "Alemite-Zerk" nozzle of the Alemite-owned Zerk patent 1,475,980[4] which, together, had *theretofore* represented 98% (I R 148) of all grease-delivery couplers and nozzles

[1] petitioner placed its "Jiffy" multi-jawed or "chuck" type hydraulic coupler on the market in 1930 (see footnote 11 on page 6 hereof and footnote * on page 11 hereof) while respondent's herein-accused "Alemite" multi-jawed or "chuck" type hydraulic coupler was placed on the market 3 years later, namely, in June of 1933, as shown, inter alia, by respondent's announcement thereof in its June 1933 issue of its house organ "Alemite High Pressure" (PX-45 at IV R 1401-9) wherein respondent hailed it as "Alemite's Latest Contribution to Automotive Progress" and as "one of the most important developments in Automobile Lubrication" in a decade (IV R 1503)

[2] I R 124-*125* and 148, *149 & 150*

[3] held unenforceable (or invalid) in *Bassick* v. *Hollingshead* and in *Rogers* v. *Alemite* 298 U.S. 415 because Gullborg's claims 1-6 and 8 & 10 (while adequately defining Gullborg's concededly patentable bayonet type coupler construction) improperly *also* included the *old* pump and the *old* bayonet type grease-cup, and because Gullborg's claims 14 and 15 (while adequately defining Gullborg's concededly patentable bayonet type grease-cup or "pin-fitting" construction) improperly *also* included the *old* pump and the *old* bayonet couplers of the prior art

[4] held invalid in *Stewart-Warner* v. *Rogers and Univesral* 101 F.2d 762 (CCA-3) upon the authority of this Court's decisions in the *Bassick, Alemite* and *Lincoln* cases, *supra,* because Zerk's claims also improperly included the *old* pump and the *old* grease-cup (also called "nipple" or "fitting") of the prior art

in use in the United States for 12 to 15 years prior to about 1930-1933:

> "For approximately thirty years the manufacturers of such vehicles have equipped them with tubular nipples or pin fittings at points where greasing was necessary. The nipples are of a type which can be connected by a coupler with a grease gun capable of forcing grease, under high pressure, to the bearing to be lubricated." (176 F.2d 445-6 and VIII R 2239).
>
> . . . . . .
>
> "The owner of the Gullborg patent took the position that anyone making, using or selling a pin fitting to be connected with the Gullborg coupler, was guilty of contributory infringement. *The market for grease guns, couplers and pin fittings was large and lucrative. Much patent litigation ensued.* The question of contributory infringement reached the Supreme Court in 1935 and was decided on May 18, 1936, in the cases of *Bassick Manufacturing Co.* v. *R. M. Hollingshead Co.*, and *Rogers et al.* v. *Alemite Corporation*, 298 U.S. 415." (176 F.2d 446 and VIII R 2239-2240).
>
> . . . . . .
>
> "It is safe to say that in or about 1930, when the Johnsons devised their so called 'Jiffy coupler' and applied for the patent in suit, virtually all automobiles were equipped with Gullborg pin fittings, and the makers of grease guns with bayonet type couplers, as well as those who made pin fittings which could be used in Gullborg's combination, were being sued as contributory infringers of Gullborg patent No. 1,307,734." (176 F.2d 446 and VIII R 2240).

Between the Spring of 1933 and the end of 1934 Stewart-Warner Corp. had sold more than $2,800,000.00 worth of lubricating equipment based upon its use of the herein-accused "Alemite" hydraulic coupler (see paragraph "21" of Stewart-Warner's proposed *Findings of Fact* on page 20 of Volume I of the Transcript of Record in *Stewart-Warner* v. *Jiffy*, 299 U.S. 554; No. 114 October Term, 1936).

Respondent's piracy of petitioner's hydraulic coupler of the patent here in suit, and the subsequent large-scale commercial exploitation of such coupler by respondent and its privies and the suppression of petitioner's sales of such couplers by an unwarranted sales-depressant suit levelled at petitioner's "Jiffy" hydraulic coupler

Petitioner's multi-jawed or "chuck" type hydraulic coupler of its Johnson patent here in suit was placed on the market by petitioner in 1930* (under its trademark "Jiffy").

Respondent's president had known August Johnson, petitioner's president and patentee, since 1924 (I R 129 & 251) and felt Jiffy's competition since 1925† (I R 231).

Respondent began to lose sales[1]

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*By April 15, 1930 the Johnson brothers had reduced to practice the hydraulic coupler of the patent here in suit (VR 1988-9 and pages T-3332-3 & T-3346 of Defendant's Exhibit 107), and started to manufacture such couplers about April 15, 1930 (Q 263 on page T-3355 of Defendant's Exhibit 107).

Petitioner was incorporated on April 17, 1930 (PX-2).

"Shortly after its organization the Jiffy Company put on the market its lubricating apparatus which included a coupler intended and adapted to connect the coupler to the type of nipple above described by gripping on to the part of the tube of the nipple which extends out beyond the pin. It combines automatic gripping and sealing of the parts and works effectively. The plaintiff contends that it infringes the Butler patent." (*Stewart-Warner* v. *Jiffy Lubricating Co.* 81 F.2d 786, at 788; CCA-8).

†prior to petitioner's incorporation in April of 1930, the Johnson brothers carried on the same business under the name "Jiffy Lubricating Company", but *not* incorporated

[1] Upon the trial in 1935 of *Stewart-Warner* v. *Jiffy* (81 F.2d 786) respondent's president testified that the reason for instituting that earlier suit (on August 21, 1931) against petitioner's "Jiffy" multi-jawed or "chuck" type hydraulic coupler of its then pending patent-application upon which its patent here in suit was later issued (on the charge that such "Jiffy" hydraulic coupler infringed the Alemite-owned Butler patent 1,593,791) was that

> "I have encountered and know of sales by Jiffy Lublicator Company of Fargo of compressors and couplers of the general character represented by Plaintiff's Exhibit 10. Such sales of this equipment by the Jiffy Company have effected our business by eliminating sales of our product, that is, we have lost the sale of the product."

this appears on pages 80 & 81 of Volume I of the printed *Transcript of Record* filed in this Court in *Stewart-Warner Corp.* v. *Jiffy Lubricator Co.* (299 U.S. 554;—No. 114, October Term 1936) in connection with the Petition for Writ of Certiorari in that case.

Respondent's president testified to like effect in the case at bar at I R 207 & 230-1.

(of its "Alemite" bayonet type couplers[2] and its "Alemite-Zerk" push-contact type nozzles[3] and its "Alemite" grease-guns equipped therewith)

to petitioner, to an increasing extent, soon after petitioner introduced on the market its "Jiffy" multi-jawed or "chuck" type hydraulic coupler of the patent here in suit in 1930, and was "disturbed"[4] by petitioner's competition with such "Jiffy" hydraulic coupler, and reported the competition to the "factory", namely to Alemite Corporation (Stewart-Warner Corporation) in Chicago (I R 132 & 207 and VI R 2151).

Some time prior to June 20, 1930, respondent's president obtained a Jiffy circular (DX-102 at V R 1857) "which they (petitioner) are broadcasting" (PX-86 at IV R 1430, line 2);—which circular described petitioner's "Jiffy" hydraulic coupler (also called the "Jiffy chuck coupler") and respondent's president sent this circular to the "factory" (i.e. the Alemite Corporation) in Chicago with his letter dated June 20, 1930 (to the attention of Alemite's chief executive officer J. E. Otis, Jr.) reading as follows:

"Dear Mr. Otis: June 20, 1930

"You no doubt are familiar with the Jiffy Lubricator which was formerly manufactured by William S. Robertson and Company of Chicago, Ill.

"This Lubricator will soon be in production in Fargo and we are enclosing a circular which they are broadcasting. We do not know whether this will conflict with the Alemite patents or not and we will appreciate hearing from you by return mail." (PX-86 at IV R 1429 & 1430)

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[2] of the Alemite-owned Gullborg patent 1,307,734 involved in *Bassick* v. *Hollingshead* and *Rogers* v. *Alemite* 298 U.S. 415

[3] of the Alemite-owned Zerk patent 1,475,980 involved in *Stewart-Warner* v. *Rogers and Universal* 101 F.2d 762 (CCA-3)

[4] VI R 2151

Mr. Otis acknowledged the receipt of this Jiffy circular (DX-102 at V R 1857) in his letter (PX-85) of June 23, 1930 addressed to respondent's president reading as follows:

"Dear Mr. Schuck: June 23, 1930

"This will acknowledge your letter of June 20, enclosing a copy of the 'Jiffy' Circular.

"We do not think that this particular piece of equipment is outside the Alemite patents, even though they do not supply it with an Alemite coupler.

"We say this for the reason that we have had the courts in the past hold that anyone who would make any device whatever with the intent and purpose that it should be used on Alemite fittings, that it was an infringement.*

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*This is the over-reaching patent-theory, practice and form which was evolved and promulgated by Alemite, and through which it corralled virtually the entire lubricating-equipment business of the Country for more than 20 years (see Court's statement in the second quoted paragraph on page 10 hereof), and which is the patent-theory, practice and form of each of the following patents:

a) the Alemite-owned Gullborg patent 1,307,734, which for 16 years was levelled at all bayonet-type couplers and grease-cup and all pump used therewith, until condemned in *Bassick* v. *Hollingshead* and *Rogers* v. *Alemite* (298 U.S. 415), after more than 400 injunctional decrees (mostly on defendants' consents) had been improvidently entered on this patent-theory, and

b) the Alemite-controlled Jacques patent 1,383,306, which for years was levelled at multi-jawed or "chuck" type hydraulic couplers, like those involved in the suit at bar (as well as at all old headed grease-cups or "nipples" used therewith) until condemned in *Jacques* v. *Universal* (22 F.Supp. 458; DC WD Pa.), and

c) the Alemite-owned Zerk patent 1,475,980, which for 16 years was levelled at all *concave* push-contact nipples, all old push-contact grease-cups and all old pumps used therewith, until condemned in *Stewart-Warner* v. *Rogers and Universal* (15 F.Supp. 410 and 101 F.2d 762; CCA-3), after injunctional decrees (mostly on defendants' consents) had been improvidently entered on this patent-theory, and

d) the Alemite-owned Butler patent 1,593,791, which was for about 10 years was levelled at all multi-jawed "chuck" type couplers and all old pumps and all old grease-cups used therewith, until condemned in *Lincoln* v. *Stewart-Warner* (303 U.S. 545), after many injunctional decrees had been improvidently entered on this patent-theory, and

e) the Alemite-controlled Boker patent 1,802,700, which for about 8 years was levelled at all *convex* push-contact nozzles and all old grease-cups used therewith, until condemned in *Min-A-Max Co. Inc.* v. *Sundholm* (24 F.Supp. 89 and 102 F.2d 187; CCA-8; certiorari denied 307 U.S. 637), after a number of injunctive decrees had been improvidently entered on this patent-theory, and

f) still other Alemite-owned patents levelled at the same couplers, nozzles, grease-cups and pumps as those at which the patents of foregoing sub-paragraphs "a", "b", "c", "d", and "e" had been levelled;—all based on the same patent-theory, practice and form, and which were the subject of still other litigation some reported but mostly not reported.

> "We are not filing any more suits for the time being until we hear the outcome of two which have already been tried on this same subject and which are at the present time under deliberation by the judges." (PX-85 at IV R 1529).

Apparently not satisfied with Otis' above-quoted answer (namely, that the "factory" was not inclined to file any more patent-infringement suits at that time) and apparently not satisfied to leave unmolested petitioner's "Jiffy" lubricator or grease-gun which had then recently been launched in Fargo with the "Jiffy" multi-jawed or "chuck" type hydraulic coupler of the Johnson patent here in suit, respondent's president sent another one of these "Jiffy" circulars (DX-102 at V R 1857) directly to Stewart-Warner's patent-attorneys in Chicago, with his letter (PX-130) of July 8, 1930;—advising Stewart-Warner's patent-attorneys that this "Jiffy" equipment "is now being manufactured in the city of Fargo" and again invited suit against petitioner:

> "if this is an infringement of the Alemite patent, we would like to hear from (you) in regard to this" (IV R 1535).

Respondent's above-quoted second letter (PX-130) addressed directly to Stewart-Warner's patent-attorneys, brought on the unwarranted suit[1] against petitioner. Thus, in the patent-attorneys' letter (PX-131) of reply dated August 2, 1930, they advised respondent that

> "If the device is now being manufactured by the Jiffy Lubricator Company, Inc. of Fargo, North Dakota, we would commence an immediate suit" (IV R 1535-6),

and asked respondent to investigate the facts

> "and if it is possible, to make a purchase of one of the complete 'Jiffy' equipments" (IV R 1536).

[1] *Stewart-Warner* v. Jiffy 81 F.2d 786 (CCA-8)

On or before October 27, 1930 respondent's president obtained from petitioner a "Jiffy" grease-gun with a hydraulic coupler like that shown in the Johnson patent 2,040,177 in suit,[2] together with several adapters (IV R 1537), and sent it to his principal's (ie. Alemite Corporation's and Stewart-Warner Corporation's) patent-attorneys, with his letter of October 27, 1930, saying:

> "As previously advised this is an *improved* type over the gun manufactured by the William Robertson & Son of Chicago" (PX-133 at IV R 1537).

On October 30, 1930* the Johnson brothers filed in the U. S. Patent Office their timely patent-application on their so previously marketed "Jiffy" hydraulic coupler, on which the patent here in suit was thereafter issued on May 12, 1936 (PX-1 at IV R 1348-51).

On December 2, 1930, respondent's president advised Stewart-Warner's patent-attorneys of the then pendency of petitioner's patent-application on its coupler (PX-135 at IV R 1539).

On August 21, 1931 Alemite filed a complaint (PX-501 at VII R 2194-6) against petitioner in the District of North Dakota (Equity No. 519) charging that petitioner's aforesaid "Jiffy" hydraulic coupler infringed claims 9, 11, 13, 16-18 of the much-litigated Alemite-owned Gullborg patent 1,307,734;—the coupler-defining portions of the Gullborg claims being couched in broad, all-inclusive language comprehending *all* couplers irrespective of their type, construction or mechanism. This is shown by Alemite's Bill of Particulars (PX-5a at IV R 1353) and by *drawing "B"* attached thereto (PX-5b at IV R 1355) both filed September 21, 1931; said *drawing* showing the "Jiffy" hydraulic coupler of the Johnson patent here in suit.

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[2] Johnson so testified at I R 251. Respondent's president (Schuck) admitted it at I R 129 & 130 and never denied it though he was recalled many times (I R 119; I R 285; I R 372; III R 1150; III R 1242; III R 1298 and III R 2119)

*i.e. well within the 2-year time-limit *then* provided by R.S. 4886 (35 U.S.C. 31)

On October 10, 1931, petitioner formally advised Alemite[2] that petitioner's "Jiffy" multi-jawed or "chuck" type hydraulic coupler

> "has new and distinctive features *not* existing in the coupler illustrated and described in the patent aforesaid[3] or in any United States patent, and *such new and distinctive features are described and claimed in an application*[4] *filed for patent on said device,* all rights under which are owned and controlled by defendant[5], which application is pending in the United States Patent Office and *in which certain claims are allowed.*" (PX-512, at VII R 2209).

By a Supplemental Complaint later filed in 1931 in the aforesaid earlier suit, Equity 519, Alemite charged that petitioner's aforesaid "Jiffy" hydraulic coupler *also* infringed claim 1 of the Alemite-owned Butler patent 1,593,791.

The pendency of the aforesaid earlier suit (kept inactive for 3½ years) was effective to suppress petitioner's sales of its Jiffy hydraulic coupler and its Jiffy grease-guns sold therewith*.

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[2] through petitioner's Answer filed on that day in the aforesaid earlier suit instituted by Alemite against petitioner in North Dakota.

[3] i.e. the Alemite-owned patent asserted against the Jiffy hydraulic coupler, in that earlier suit

[4] the Johnson patent here in suit was later issued on this application

[5] Jiffy, petitioner at bar

* Petitioner's president testified (I R 231-250) to the large-scale nation-wide distribution of "Jiffy" equipment arranged with Wayne Company (see also PX-407 at VII R 2179-2180) and Wayne's unwillingness to distribute petitioner's Jiffy equipment because of the pendency of the early suit notwithstanding Wayne's belief that it "could do an enormous business on it" (PX-407 at VII R 2168 & PX-411 at VII R 2180);—and petitioner's contract with Jiffy of September 6, 1935 (PX-36 at IV R 1399-1400) entered into after the District Court's decision in the early suit favorable to petitioner (see also PX-415 at VII R 2181 & PX-417 at VII R 2183; PX-418 at VII R 2184; PX-420 at VII R 2185; PX-404a at VII R 2172; PX-403 at VII R 2169; PX-405 at VII R 2173 & 2175; PX-406 at VII R 2177). Petitioner's sales under the aforesaid contract of September 6, 1935 between petitioner and Wayne (PX-36 at IV R 1399-1400) were thereafter quickly suppressed and stopped by Stewart-Warner's suit filed on December 28, 1935 against the Wayne Company in the U.S. District Court for the Northern District of Illinois, Eastern Division (PX-509 at VII R 2198; DX-155 at VII R 2227-8; PX-436 at VII R 2192; PX-509 at VII R 2198). This further *unwarranted* sales-depressant suit (*Stewart-Warner* v. *Wayne Company*) was based on the Alemite-owned Gullborg patent 1,307,734 which had been *withdrawn* from the earlier suit of *Stewart-Warner* v. *Jiffy* (81 F.2d 786) and such *unwarranted* assertion of the Alemite-owned Gullborg patent 1,307,734 was just before this Court condemned Alemite's patent-theory upon which the Gullborg patent was so asserted (*Bassick* v. *Hollingshead* and *Rogers* v. *Alemite* 298 U.S. 415)

While this earlier suit was kept inactive and petitioner's sales of its equipment including its Jiffy hydraulic couplers thereby supressed, respondent and its privy (Alemite Corp. and Stewart-Warner Corp.) placed on the market their imitative "Alemite" branded multi-jawed or "chuck" type hydraulic couplers in the middle of 1933 (see footnotes 1 and 2 on page 9 hereof).

Prior to the trial of 1935, Stewart-Warner was substituted for Alemite, as plaintiff in the aforesaid earlier suit, Equity 519, (because in December 1933 Stewart-Warner took over all assets of its wholly-owned subsidiary, the Alemite Corporation, including all patents).

At or just before the trial in 1935, Stewart-Warner withdrew its Gullborg patent 1,307,734 (which it had relied on in its original and supplemental complaints) and the case was tried on the sole charge that the "Jiffy" hydraulic coupler infringed Butler patent 1,593,791.

After trial[2], the District Court in its Opinion[3] on March 5, 1935 and in its Findings & Conclusions[4] dated March 18, 1935, held that the Jiffy hydraulic coupler is substantially *different* from, and is *not* a mechanical equivalent of the coupler construction disclosed in Butler patent 1,593,791, and hence *not* an infringement of the Butler patent;— which patent it held *valid* notwithstanding the *many* other multi-jawed hydraulic couplers and chucks of the prior-art.

The Court of Appeals for the 8th Circuit in its Opinion (81 F.2d 786) dated February 11, 1936 affirmed the District Court's holding of *validity* and *non*-infringement and expressly found as stated on foregoing pages 5 to 8 hereof, *favorably to invention* in the "Jiffy" coupler which is the subject matter of the Johnson patent here in suit.

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[2] on January 16-18, February 28 and March 1-5, 1935

[3] the District Court's March 5, 1935 Opinion in *Stewart-Warner* v. *Jiffy* appears on pages 34 & 35 of the printed *Transcript of Record* filed in this Court on Petition for Writ of Certiorari (299 U.S. 554)

[4] the District Court's *Findings & Conclusions* filed March 18, 1935 in *Stewart-Warner* v. *Jiffy* appear on pages 35 to 42 of the printed *Transcript of Record* filed in this Court on Petition for Writ of Certiorari (299 U.S. 554)

The findings in the prior equity suit were recognized (and then, in effect, ignored) by the Court of Appeals in the case at bar;

> ". . . this Court distinguished the Jiffy hydraulic coupler, the accused device in that case, from the device of Butler, and was of the view that the Alemite hydraulic coupler, made by the Stewart-Warner Corporation did *not* conform to the Butler patent . . ." (176 F.2d 447 and VIII R 2242).
>
> "Implications favorable to the plaintiff which might, perhaps, be drawn from some of the statements of this Court in Stewart-Warner Corporation *v.* Jiffy Lubricator Co., supra, 81 F.2d 786" (176 F.2d 448 and VIII R 2245)

Evidence in the case at bar as to the "prior-art"

The case at bar was tried to a jury upon the Amended Complaint (I R 16-26) and Answer thereto (I R 26-37). The trial consumed 13 days (May 12th to 27th, 1947).

Respondent's expert, fully cognizant of the fundamental principles of patent-law (III R 1041/27-32 and 1042/11-25), testified that of all the "prior-art" patents relied upon by the defendant, the Alemite-owned Butler patent 1,593,791 (DX-A at V R 1705), the Alemite-owned Tecalemit patent 562,500 (DX-133 at V R 2055 & 134 at V R 2065) and Meyer patent 1,754,639 (DX-137 at V R 2069), were the prior patents which, in his opinion, were the closest approach to the Johnson patent here in suit (III R 1044/29 to 1045/28) and that of these three, *the Butler patent was (in his opinion) the closest* (III R 1045/29 to 1046/1-9), and, being familiar with the legal principles of patent-claims (III R 1046-7) respondent's expert further testified that *none* of the claims of the Johnson patent here in suit are readable on the Butler 1,593,791 (III R 1095) *nor* upon the Tecalemit patent 562,500 of DXs 133 & 135 (III R 1097) *nor* upon the Meyer patent 1,754,639 of DXs 137 & 138 (III R 1097), nor upon *any* of the devices of any of the other prior

patents and prior publications (III R last 3 lines on p. 1097 and first 4 lines on p. 1098).

Moreover, the Butler patent and the Tecalemit patent were specifically considered by the Patent Examiner in connection with the issuance of the Johnson patent here in suit, as was also the Saxton patent 1,751,600 (DX-106 at V R 1887 & DX-106 at V R 1909) relied upon by respondent, though Saxton 1,751,600 was not considered by respondent's expert to be as close as Butler, Tecalemit or Meyer (which latter three he admitted were *not* anticipatory in character).

In the case at bar, Butler (respondent's witness) testified that neither he nor the owners of *his* patent 1,593,791 ever made a chuck type coupler like that disclosed in Figure 2* of his patent (principally relied upon by respondent to negative invention in the Johnson patent here in suit) nor had any of the mechanical "chucks" of Figures 3, 4 & 9 of his patent 1,593,791 ever been commercially practical (II R 896 & III R 897), and Butler clearly recognized the *differences* between the chuck type coupler of his patent 1,593,791 and the chuck type coupler of the Johnson patent here in suit and that all the features by which the coupler of the Johnson patent here in suit differed from the coupler of his prior patent 1,593,791 were features

a) which the herein-accused "Alemite" hydraulic coupler had in common with the coupler of the Johnson patent here in suit, and

b) which accounted for the commercial practicability and success of the herein-accused "Alemite" hydraulic coupler.

(see: II R 862-3, 875-883, 889, 896 & III R 897, 903-9).

Petitioner's expert (I R 292-311), respondent's expert (III R 1082-1090) and respondent's president

* the only coupler disclosed in Butler patent 1,593,791 which respondent has *ever* contended is "hydraulic" in actuation (but which both Courts in *Stewart-Warner* v. *Jiffy, supra,* held was *not* hydraulically actuated at all, in respect to the gripping action of its jaws, but was, instead, spring-actuated, as indicated in footnotes 6 and 10a on foregoing page 5; and footnote 12b on foregoing page 7.

(I R 179-187), *all* testified that the herein-accused "Alemite" hydraulic couplers contained all the elements of the claims of the Johnson patent here in suit, and that the Alemite hydraulic couplers embody the same principle of operation as the coupler of the Johnson patent here in suit (see also trial Judge's Opinion quoted on pages 23 & 24, *infra*).

Respondent's motion for directed verdict did not include ground adopted by Court of Appeals

At the close of all the evidence, respondent moved (under Rule 50-a) for a directed verdict (I R 51-3 and III R 1310-3), which was denied (III R 1313).

Respondent's aforesaid motion for directed verdict did **not** include, as a ground thereof, **either** Gullborg patent 1,307,734 **or** this Court's decisions in *Bassick* v. *Hollingshead* and *Rogers* v. *Alemite,* 298 U.S. 415 and in *Lincoln* v. *Stewart-Warner,* 303 U.S. 545 (all of which are the grounds of the appellate Court's reversing decision; the review of which is here sought).

Trial Court's instructions to jury, and jury's verdict

The trial court instructed the jury at great length (III R 1322-1340) and very adequately on the question of invention and, indeed, at respondent's request, also instructed the jury, *inter alia,* in the language of this Court's decision in *Cuno Engineering Corp.* v. *Automatic Devices Corp.* 314 U.S. 84;—the trial judge saying to the jury:

> "A new device, to be patentable, must reveal a *flash of creative genius,* not merely the skill of those working in the field."
>
> "If what Johnson and Johnson claimed in their patent was not, in your opinion, the result of the exercise of inventive genius as distinguished from the ability of a mechanic skilled in the art, it will be your *duty* to find that the patent claims are invalid" (III R 1336).

In view of the uncontroverted evidence (including the testimony of defendant-respondent's own expert witness) that *none* of the "prior-art" anticipated the coupler construction defined by the claims of the Johnson patent here in suit[1], the trial judge instructed the jury accordingly[2], and further instructed the jury that if they found in the prior-art a mechanical equivalent[3] of the coupler construction of the Butler patent here in suit they would have to find for the defendant, and further instructed the jury that it was not necessary to find all elements of the coupler structure defined by the claims of the patent in suit in a single prior-art patent or publication, but they could combine any number of the prior patents and publications in determining whether the hydraulic coupler

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1 the "prior-art" (i. e. the Butler patent) which defendant's expert regarded the closest and upon which defendant placed its main reliance, having been expressly held to be **non**-anticipatory and **substantially** different in construction and principle from, and **not** the equivalent of the "Jiffy" hydraulic coupler of petitioner's Johnson patent here in suit (see quotations from Court's decision in the earlier equity suit, on foregoing pages 5 to 7 hereof)

2 "The Delaney patent 895,438 . . . does not anticipate claims of the Johnson patent and you cannot find in favor of the defendant on the basis of this patent unless you find that the hydraulic coupler described in the claims of Plaintiff's Johnson patent in suit did not constitute an invention by the Johnson brothers, in October, 1930, in view of the device disclosed in this Delaney patent." (III R 1331)

"Now what I have just said with reference to the Delaney patent . . . applies with equal force to the Oliver patent, the Newton patent, the Lavoie patent, and the other Lavoie patent . . ." (III R 1331)

"Saxton patent 1751,660 . . . does not anticipate claims of plaintiff's Johnson patent in suit because these claims do not describe or are not readable on the coupler of this Saxton patent, and, therefore, you cannot find in favor of the defendant on the basis of this Saxton patent unless you find that the hydraulic coupler described in claims of the Johnson patent in suit did not, in October of 1930, constitute invention of the Johnson brothers in view of the disclosure of this prior Saxton patent . . . and other prior art. (III R 1331)

"What I have just said applies with equal force to the Meyer patent number 1,753,639 and the French Tecalemit patent number 562,500 . . ." (III R 1331).

3 "To constitute an anticipation of a patent it is not necessary that the anticipation relied upon by the defendant should have been used commercially or was commercially successful. If you find that any of the prior couplers established by the evidence and relied upon by defendant were the same as or the mechanical equivalent of the Johnson and Johnson coupler, you should find for the defendant." (III R 1336).

construction of the Johnson patent here in suit was either anticipated or lacked invention[4].

The jury returned a verdict for petitioner and against respondent (I R 54).

Respondent's motion for judgment n.o.v. did not include ground adopted by Court of Appeals

Respondent thereafter filed a timely motion (I R 54-7) on June 5, 1947 to set aside the verdict and to enter judgment in accordance with its aforesaid motion for directed verdict. Respondent's aforesaid motion under Rule 50-b for judgment notwithstanding the verdict, likewise did **not** include, as a ground thereof, **either** Gullborg patent 1,307,734 **or** this Court's decisions in *Bassick* v. *Hollingshead* and *Rogers* v. *Alemite,* supra, and in *Lincoln* v. *Stewart-Warner,* supra. Respondent's aforesaid motion for judgment notwithstanding the verdict was denied on February 7, 1948, after extensive oral argument and briefs (I R 57).

The entry of judgment

After further hearings before the trial court in May of 1948 (VI R 2117-2151 and VII R 2153-2229) on the matter of allowances under 35 U.S.C. 70 (as amended in 1946), the Court entered judgment on June 8, 1948 for the amount of the jury's verdict ($11,371.80) plus $12,000.00 for costs under 35 U.S.C. 70, plus interest on the amount of the jury's verdict (I R 61-2); for a total of $23,840.53.

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[4] "In your consideration of the lack of invention or anticipation of the patent in suit, I instruct you that it is *not* necessary to find all of the parts of a patent claims in any one earlier patent or device available to the public prior to the date of the alleged Johnson invention. Earlier patents, publications, and devices may be (considered) in combination by you in your determination relative to the validity of the patent in suit; if you believe that an ordinary mechanic skilled in the art based upon suggestions contained in these various patents, publications or devices, could make a device of the kind disclosed and described in the patent in suit, then you *must* find for the defendant." (III R 1337)

Respondent's motion for new trial

Thereafter respondent filed a timely motion for a new trial (I R 62-7) which was denied (I R 67-8) *with an Opinion* (I R 71-4), after a hearing thereon.

Trial Judge's found verdict consistent and in harmony with decision of Court of Appeals in Stewart Warner v. Jiffy

First on motion for judgment n.o.v. and then on motion for new trial, *the trial Judge found* (I R 72-4) *that the jury's verdict was* (not only consistent with and amply supported by the evidence independently adduced in the case at bar, but also) *entirely consistent and in harmony with and fully supported by the Court's fact-findings and decisions in the earlier equity suit of Stewart-Warner* v. *Jiffy, supra:*

> "Robertson[1] and Platt[2] and Schuck[3]—and the Circuit Court of Appeals certainly held in this Circuit, that the Butler patent did not anticipate the Jiffy patent. That's very clear and among the differences was that there was not such a chuck made by Butler as the chuck made by Jiffy, and from what I heard in this law suit the chuck was one of the most determinative characteristics that existed." (I R 72).
>
> ". . . the Circuit Court of Apepals in this Circuit has held that the Butler patent did not anticipate the Jiffy patent. If it didn't anticipate it, so far as all practical purposes are concerned, so far as my conception of the thing is concerned, that takes it out. It also held, in language which has been quoted here this morning, that it was different from the real teachings of the Jiffy patent. What does this mean? It means just what it says. The Jiffy patent teaches something and the Butler patent teaches something else that is different." (I R 73).

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1 defendant-respondent's expert witness
2 plaintiff-petitioner's expert witness
3 defendant-respondent's president

"I think it was a case where it should go to the Jury on the testimony that was introduced in the record to determine whether or not Saxton or Johnson or Butler—who did the inventing. A Jury trial was asked for; it was granted. That was the question that went before them. I hadn't any business to decide it under the evidence and I think I did right in permitting it to go to the Jury, and, generally, I think that the Defendant, on the whole record, on the evidence of this complicated case, had a fair and a just trial, and the motion for new trial is over-ruled." (I R 74).

Trial Judge expressly concurred in jury's fact-finding of invention

In his Opinion denying respondent's motion for a new trial, the trial Judge expressed his concurrence in the jury's fact-finding of invention;—saying, inter alia:

". . . in the progress of time they (i.e., the Johnson brothers) did evolve something that had value, and I think inventiveness" (I R 72),

". . . (the coupler of the patent in suit) came into being in their (i.e., the Johnson brothers') effort towards finding something that would *supply this great need in lubrication*" (I R 72),

". . . there was no such a chuck made by Butler as the chuck made by Jiffy, and from what I heard in this law suit the chuck was one of the most determinative characteristics that existed" (I R 72)

"I am of the opinion this (Johnson patent in suit) patent possessed invention" (I R 73).

The decision of the Court of Appeals in the case at bar

In the case at bar, the Court of Appeals for the 8th Circuit (differently composed*), recognizing but going

*in *Stewart-Warner* v. *Jiffy* (CCA-8) the Court was composed of Judges Gardner, Woodrough and Van Valkenburgh, with the Opinion written by Judge Woodrough, while in the case at bar the Court was composed of Judges Sanborn, Woodrough and Johnsen, with the Opinion written by Judge Sanborn

counter to its own fact-findings in the earlier equity suit between the same parties, overruled and set aside the jury's fact-finding of invention implied in its verdict and reversed the judgment on the *sole* question of invention* (176 F.2d 449), in

> reliance (for "prior-art") upon the Alemite-owned Gullborg patent 1,307,734[2] which was *never* relied upon by respondent either in the District Court or in the Court of Appeals *in the case at bar,* although fully considered by that Court in the earlier suit and there found to be inapplicable to multi-jawed or "chuck" type couplers,
>
> and in further
>
> reliance *(for its authority)* upon this Court's (inapplicable) decisions in *Bassick* v. *Hollingshead* and *Rogers* v. *Alemite* (298 U.S. 415) and *Lincoln* v. *Stewart-Warner* (303 U.S. 545), which decisions were likewise *never* relied upon by respondent either in the District Court or in the Court of Appeals *in the case at bar,*

and directed the dismissal of the complaint without affording petitioner the opportunity of a new trial or its day in court in respect to such untried basis of invalidity.

The appellate Court did *not* hold that respondent's *motion for directed verdict* or its *motion for judgment n. o. v.* was grantable or should have been granted, nor did the appellate Court hold that there was lack of invention *as a matter of law.*

Nor did the Court of Appeals base its reversing decision on any *question of law* (going to the defense of non-

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* i.e., that the patentees' admittedly *un*anticipated *contribution* to the art of lubrication did not rise to the level of patentable invention (VIII R 2245, penultimate paragraph of the appellate Opinion).

[2] The Gullborg patent 1,307,734 is the most litigated U.S. patent. Well over 400 injunctional decrees were improvidently issued by U.S. District Courts (most of them on the consent of the defendants) between from 1920 to 1936, until this Court in *Bassick* v. *Hollingshead* and Rogers *v.* Alemite (298 U.S. 415), condemned the basis of such decrees.

invention) made the basis of respondent's motions for directed verdict or for judgment n.o.v.

The appellate decision does not refer to or mention any of the prior-art patents or publications or the alleged prior use which were the basis of respondent's motions for directed verdict and for judgment n.o.v., excepting only Butler patent 1,593,791.

Insofar as the reversing appellate decision at bar is based on non-invention, it is based merely upon the appellate Court's own *present opinion*

> (inconsistent and out of harmony with the Courts' own findings and conclusions in the aforesaid earlier equity suit between the parties)

that "the evidence . . . does not sustain the conclusion that Johnsons' contribution to the art of lubrication rose to the level of patentable invention";—the appellate Court *now* overlooking

> the established rule of law that the issuance of a patent creates a prima facie presumption that the subject matter thereof in inventive, and
>
> that the infringer has the burden of overcoming such presumption by clear and convincing evidence to the contrary, and
>
> that both the jury and trial Judge were satisfied that the subject matter of the patent in suit was inventive, and
>
> that in its findings and decision in the earlier equity suit *(Stewart-Warner* v. *Jiffy, supra)* it found all the facts necessary to sustain the inventive character of the "Jiffy" coupler there and here in suit.

The appellate Court's decision in the case at bar appears to proceed on the assumption that *now*, even in the Court of Appeals, *plaintiff-appellee* still has the burden of sustaining the conclusion that "the patentees' contribu-

tion to the art . . . rose to the level of patentable invention" (176 F.2d 449).

In reaching its *present* contrary conclusion, the Court of Appeals did *not* point to *any* prior patent or other "prior-art" or any other evidence or authority which, in its opinion, negatived invention in the patent in suit, *as a matter of law or otherwise* (excepting only the Alemite-owned Gullborg patent 1,307,734 and this Court's decisions in *Bassick* v. *Hollingshead* and *Rogers* v. *Alemite*, 298 U.S. 415, and in *Lincoln* v. *Stewart-Warner*, 303 U.S. 545;—*neither of which patent or decisions was ever relied on by respondent in either of the Courts below*).

Insofar as the reversing appellate decision is based on the Gullborg patent and this Court's aforesaid decisions (adjudicating the Gullborg patent and the Butler patent) the Court of Appeals has misinterpreted this Court's aforesaid decisions, and has based its reversing decision on grounds *never* advanced or urged by respondent in either of the Courts below either in brief or in oral argument, as indicated in the following chart.

CHART.

	"prior-art" and certain other defenses					in Stewart-Warner *v.* Jiffy 81 F.2d 786 (Feb. 11, 1936) (cert. den. 299 U.S. 554)			in the case at bar (176 F.2d 444) decide					
											relied on by defendant-re			
	name of patentee	patent owned or controlled by	patent number	filing date or effective date of patent as "prior-art"	issue date of patent	exhibit number	reproduced in record at page	considered by Court, and Butler's coupler **held inventive** over prior patents	exhibit number	reproduced in record at page	in Answer or Notice under 35 USC 69	offered in evidence by defendant or otherwise relied on by defendant during trial to jury	**relied on as ground of motions under Rules 50-a & 50-b**	
1	Alley (Br.)		21893	10- 4-06		DX-1	IIR-675	yes	PX-187	IVR-1657	no	no	no	
2	Delaney		895438	3-16-08	8-11-08	DX-15	IIR-753		DX-123	VR-2037	no	yes	no	
3	Dupre		927337	4- 4-08	7- 6-09	DX-2	IIR-681	yes			no	no	no	
4	Oliver	Bardons et al	926761	1-14-09	7- 6-09	DX-16	IIR-757		DX-122	VR-2027	no	yes	no	
5	Newton	N. Y. Air Brake Co.	1118876	3- 7-14	11-24-14	DX-22	IIR-795	yes	DX-126	VR-2045	yes	yes	yes	
6	Winkley	Alemite (Stewart-Warner)	Re. 14667	10-17-16	6-10-19	DX-4	IIR-693	yes			no	no	no	
7	Lavoie		1236453	8-16-16	8-14-17	DX-20	IIR-781	yes	DX-117	VR-2005	yes	yes	yes	
8	Lavoie		1295994	6- 8-18	3- 4-19	DX-21	IIR-789		DX-119	VR-2017	yes	yes	yes	
9	**Gullborg***	**Alemite** (Stewart-Warner)	**1307734**	**12-21-18**	**6-24-19**	**PX-3**	**IIR-325**	**yes**	**PX-141**	**IVR-1545**	**NO**	**NO**	**NO**	
10	The defense that Johnson patent here in suit is invalid, under the authority of this Court's decisions in *Bassick* v. *Hollingshead* (298 U. S. 415), *Rogers* v. *Alemite* (298 U. S. 415) and/or *Lincoln* v. *Stewart-Warner* (303 U. S. 545)					.....	.....	.....	.....	.....	**NO**	**NO**	**NO**	
11	Goldman		1406847	8-12-19	2-14-22	DX-23	IIR-801	yes			no	no	no	
12	Davis	Alemite (Stewart-Warner)	1465254	3-17-20	8-21-23	DX-6	IIR-705	yes			no	no	no	
13	Jacques	Alemite (Stewart-Warner)	1383306	8-23-20	7- 5-21	DX-8	IIR-715				no	no	no	
14	Bruce		1435103	9- 7-20	11- 7-22	DX-9	IIR-719	yes			no	no	no	
15	Tecalemit (Fr.)	Alemite (Stewart-Warner)	562500	2-20-22	9- 6-23	PX-27	IIR-551		DX-133	VR-2055	yes	yes	yes	
16	Zerk	Alemite (Stewart-Warner)	1711870	5-29-22	5- 7-29	DX-25	IIR-811	yes	PX-178	IVR-1627	no	no	no	
17	Tarlton	Alemite (Stewart-Warner)	1558313	10-10-22	10-20-25	DX-24	IIR-807	yes			no	no	no	
18	**Butler†**	**Alemite** (Stewart-Warner)	**1593791**	**2-19-23**	**7-27-26**	**PX-2**	**IIR-317**	**patent in suit**	**DX-A**	**VR-1705**	**yes**	**yes**	**yes**	
19	Muller		1767391	12-20-26	6-24-30						yes	no	no	
20	Meyer		1754639	6- 1-27	4-15-30	PX-27	IIR-503		DX-137	VR-2069	yes	yes	yes	
21	Saxton	Grease-Rite Corp.	1751660	1-17-28	3-25-30	PX-27	IIR-493		DX-AA	VR-1713	yes	yes	yes	
22	Butler	Alemite (Stewart-Warner)	1796827	3-26-28	3-17-31				PX-150	IVR-1559	yes	no	no	
23	Butler	Alemite (Stewart-Warner)	1816567	3-26-28	7-28-31				PX-151	IVR-1565	yes	no	no	
24	Parker	Alemite (Stewart-Warner)	2005556	11-21-28	6-18-35						yes	no	no	
25	**Johnson**	**Jiffy** (petitioner)	**2040177**	**10-30-30**	**5-12-36**	**the Johnsons' "Jiffy" coupler of this patent was distinguished over Butler 1,593,791, and Jiffy-equivalent "Alemite" hydraulic coupler was held inspired by Johnsons' earlier-marketed "Jiffy" coupler (and *not* by the "prior-art")**			**PX-1**	**IVR-1345**				

*the bayonet coupler of this Gullborg patent was held to be patentably inventive over the bayonet couplers of the prior-art, in *Lyman* v. *Bassick*, 18 F. 2d 29 (CCA 6 reported decisions following it, and the patentability of such coupler, *per se*, was conceded by this Court in *Bassick* v. *Hollingshead* and *Rogers* v. *Alemite*, 298 U.S. 41

†the multi-jawed or "chuck" type coupler of this Butler patent was held to be patentably inventive over all the couplers (including the many multi-jawed couplers or ch cited above, in the case of *Stewart-Warner* v. *Jiffy*, 81 F.2d 786 (CCA 8) and in the case of *Lincoln* v. *Stewart-Warner*, 91 F.2d 757 (CCA 7), and the patentabilit *per se*, was conceded by this Court in *Lincoln* v. *Stewart-Warner*, 303 U. S. 545

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her defenses			in Stewart-Warner *v.* Jiffy 81 F.2d 786 (Feb. 11, 1936) (cert. den. 299 U.S. 554)			in the case at bar (176 F.2d 444) decided Aug. 17, 1949								
								relied on by defendant-respondent?						
patent number	filing date or effective date of patent as "prior-art"	issue date of patent	exhibit number	reproduced in record at page	considered by Court, and Butler's coupler **held inventive** over prior patents	exhibit number	reproduced in record at page	in Answer or Notice under 35 USC 69	offered in evidence by defendant or otherwise relied on by defendant during trial to jury	**relied on as ground of motions under Rules 50-a & 50-b**	relied on or urged on oral argument or in brief in support of motions under Rules 50-a & 50-b	relied on in oral argument or in brief in Court of Appeals	relied on by appellate Court (?) on its fact-finding of non-invention in Johnson patent in suit	
21893	10- 4-06		DX-1	IIR-675	yes	PX-187	IVR-1657	no	no	no	no	no		1
895438	3-16-08	8-11-08	DX-15	IIR-753		DX-123	VR-2037	no	yes	no	yes	yes		2
927337	4- 4-08	7- 6-09	DX-2	IIR-681	yes			no	no	no	no	no		3
926761	1-14-09	7- 6-09	DX-16	IIR-757		DX-122	VR-2027	no	yes	no	yes	yes		4
1118876	3- 7-14	11-24-14	DX-22	IIR-795	yes	DX-126	VR-2045	yes	yes	yes	yes	yes		5
Re. 14667	10-17-16	6-10-19	DX-4	IIR-693	yes			no	no	no	no	no		6
1236453	8-16-16	8-14-17	DX-20	IIR-781	yes	DX-117	VR-2005	yes	yes	yes	yes	yes		7
1295994	6- 8-18	3- 4-19	DX-21	IIR-789		DX-119	VR-2017	yes	yes	yes	yes	yes		8
1307734	**12-21-18**	**6-24-19**	**PX-3**	**IIR-325**	**yes**	**PX-141**	**IVR-1545**	**NO**	**NO**	**NO**	**NO**	**NO**	**YES**	**9**
is invalid, under the authority of *d* (298 U. S. 415), *Rogers* v. *Alemite er* (303 U. S. 545)								**NO**	**NO**	**NO**	**NO**	**NO**	**YES**	**10**
1406847	8-12-19	2-14-22	DX-23	IIR-801	yes			no	no	no	no	no		11
1465254	3-17-20	8-21-23	DX-6	IIR-705	yes			no	no	no	no	no		12
1383306	8-23-20	7- 5-21	DX-8	IIR-715				no	no	no	no	no		13
1435103	9- 7-20	11- 7-22	DX-9	IIR-719	yes			no	no	no	no	no		14
562500	2-20-22	9- 6-23	PX-27	IIR-551		DX-133	VR-2055	yes	yes	yes	yes	yes		15
1711870	5-29-22	5- 7-29	DX-25	IIR-811	yes	PX-178	IVR-1627	no	no	no	no	no		16
1558313	10-10-22	10-20-25	DX-24	IIR-807	yes			no	no	no	no	no		17
1593791	**2-19-23**	**7-27-26**	**PX-2**	**IIR-317**	**patent in suit**	**DX-A**	**VR-1705**	**yes**	**yes**	**yes**	**yes**	**yes**		**18**
1767391	12-20-26	6-24-30						yes	no	no	no	no		19
1754639	6- 1-27	4-15-30	PX-27	IIR-503		DX-137	VR-2069	yes	yes	yes	yes	yes		20
1751660	1-17-28	3-25-30	PX-27	IIR-493		DX-AA	VR-1713	yes	yes	yes	yes	yes		21
1796827	3-26-28	3-17-31				PX-150	IVR-1559	yes	no	no	no	no		22
1816567	3-26-28	7-28-31				PX-151	IVR-1565	yes	no	no	no	no		23
2005556	11-21-28	6-18-35						yes	no	no	no	no		24
2040177	**10-30-30**	**5-12-36**	**the Johnsons' "Jiffy" coupler of this patent was distinguished over Butler 1,593,791, and Jiffy-equivalent "Alemite" hydraulic coupler was held inspired by Johnsons' earlier-marketed "Jiffy" coupler (and *not* by the "prior-art")**			**PX-1**	**IVR-1345**						**patent in suit**	**25**

ullborg patent was held to be patentably inventive over the bayonet couplers of the prior-art, in *Lyman* v. *Bassick*, 18 F. 2d 29 (CCA 6) and in many other , and the patentability of such coupler, *per se*, was conceded by this Court in *Bassick* v. *Hollingshead* and *Rogers* v. *Alemite*, 298 U.S. 415

ype coupler of this Butler patent was held to be patentably inventive over all the couplers (including the many multi-jawed couplers or chucks) of the prior-art *tewart-Warner* v. *Jiffy*, 81 F.2d 786 (CCA 8) and in the case of *Lincoln* v. *Stewart-Warner*, 91 F.2d 757 (CCA 7), and the patentability of Butler's coupler, Court in *Lincoln* v. *Stewart-Warner*, 303 U. S. 545

Jurisdiction

This is a suit arising under the Patent Laws of the United States, and the U. S. District Court's jurisdiction was invoked under Section 24(7)[2] of the Judicial Code;—28 U.S.C. 41(7)[2].

The jurisdiction of this Court is invoked under Section 1254 (1) of Title 28 of the United States Code[3].

The Court of Appeals stayed its mandate (VIII R 2296) pending the filing and determination of a Petition to this Court for a writ of certiorari.

The present petition for writ of certiorari is timely because the time specified by 28 U.S.C. 1254(1) does not begin to run until the denial of Petition for Re-Hearing in the U. S. Court of Appeals[4].

The Questions Involved

Question 1: Is invention a question of fact or a question of law ?

(This Question is the basis of *Reason 1-A*, and is covered by *Argument—Point 1-A* of supporting Brief)

Question 2: *Is a patent prima facie valid,* namely,

does the infringer have the burden of proving *non*-invention in the patent in suit

or

does the patentee have the burden of proving invention in his patent in suit (as the Court of Appeals' decision indicates) ?

(This Question is the basis of *Reason 1-B*, and is covered by *Argument—Point 1-B* of supporting Brief)

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[2] since, replaced by 28 U.S.C. 1338

[3] which became effective September 1, 1948 (the corresponding Statute effective prior to September 1, 1948, having been 28 U.S..C 347)

[4] *Craig* v. *United States,* 298 U.S. 637 (80 L.Ed. 1371); *Weinblatt* v. *United States,* 298 U.S. 637 (80 L.Ed. 1371); *Citizen's Bank of Michigan City* v. *Opperman,* 249 U.S. 448; 450 (63 L.Ed. 701, 702); *Chicago Great Western Railroad Co.* v. *Bascham,* 249 U.S. 164, 166-7 (63 L.Ed. 534, 535-6); *United States* v. *Seminole Nation,* 229 U.S. 417, 421 (81 L.Ed. 316, 318).

Question 3: Where the same Court of Appeals (differently composed) having the same parties and the same subject-matter before it in two different suits* (decided by it 13 years apart) draws diametrically opposite inferences from the same set of underlying facts and so makes diametrically opposite ultimate fact-findings in the successive two cases,

a) aren't those underlying facts *inherently* such "as to which reasonable men could differ" as to the inferences and ultimate fact-finding to be drawn therefrom, and hence such as were and must be left within the exclusive province of the jury (to whom the second suit was tried) to weigh and draw the ultimate fact-finding therefrom, and

b) may that Court of Appeals overrule and set aside the jury's fact-finding of invention (implied in its verdict) which was consistent and in harmony with (and the verdict is also cogently supported by) the facts found in the decision of that Court of Appeals in such earlier equity suit, on the theory (implied in such reversal) that reasonable men could not differ as to the fact of invention ?

(This Question is the basis of *Reason 2*, and is covered by *Argument—Point 2* of supporting Brief)

Question 4: Where a Court of Appeals has, in a previous equity suit involving the same parties (or those in privity with them) and the same subject-matter, decided certain fact-questions, is not the Court of Appeals bound to follow its earlier fact-decisions under the principles of res adjudicata and/or stare decisis, as a matter of public policy in the administration of justice in the Federal Courts, and does it not constitute prejudicial error and a violation of the *Seventh Amendment to the Constitution*, for the Court of Appeals to reverse a judgment entered in accordance with a jury's verdict and set aside the jury's

*the first suit being an equity suit and the second suit being one tried by a jury

fact-finding (implied in its verdict) which judgment, verdict and fact-finding are consistent and in harmony with and in effect follow and are cogently supported by such fact-decisions of the Court of Appeals in the earlier equity suit ?

(This Question is the basis of *Reason 2*, and is covered by *Argument—Point 2* of supporting Brief)

Questions 5, 6, 7, 8 & 9

Where, in a patent-infringement suit tried to a jury[1], the patent-in-suit was admittedly *not* anticipated[2] by any prior-art relied on by defendant and the *only* issue (which was decided by the appellate Court adversely to appellee)

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[1] upon a timely and proper demand under Rule 38 (I R 37);—neither the timeliness nor the propriety of which demand for jury trial was *ever* questioned

[2] i.e. In the earlier (1936) case of *Stewart-Warner* v. *Jiffy Lubricator Co.* 81 F.2d 786 (CCA-8) both Courts expressly held that petitioner's earlier-marketed "Jiffy" hydraulic coupler which is the subject matter of the Johnson patent here in suit (as well as respondent's later-marketed imitative and herein-accused "Alemite" hydraulic coupler) is substantially *different* from and *not* the mechanical equivalent of the "chuck" type coupler disclosed in the Alemite-owned Butler patent 1,593,791 there in suit (81 F.2d 793). In the case at bar, defendant's expert testified to like effect, namely, that while of all the "prior-art" relied upon by defendant, this Butler patent was, in his opinion, the closest to the Johnson patent here in suit, yet none of the claims of the Johnson patent here in suit were readable upon the disclosure of this Butler patent nor upon the disclosure of any other "prior-art" relied upon by defendant-respondent in the suit at bar (III R 1044/29 to 1046/9 and III R 1095, 1097, 1098). In the case at bar, Butler (as defendant's witness) testified to like effect, namely, that neither he nor the owners of his patent 1,593,791 *ever* made a chuck type coupler like that disclosed in Figure 2 of his patent (relied upon by defendant to negative invention in the Johnson patent here in suit), nor had his mechanical "chucks" ever been commercially practical (11 R 896 & III R 897) and Butler clearly recognized the *differences* between the chuck type coupler of his patent 1,593,791 and the chuck type coupler of the Johnson patent here in suit, and Butler *further* recognized that all the features by which the coupler of the Johnson patent here in suit differed from the coupler of his prior patent 1,593,791, were features which the herein-accused "Alemite" hydraulic coupler had in common with the coupler of the Johnson patent here in suit and which accounted for the commercial practicability of the herein-accused "Alemite" hydraulic coupler (II R 862-3, 875-883, 889, 896 & III R 897, 903-9).

was a fact-question, namely, whether the differences between

the structure of the patent in suit

and

the constructions of the prior-art

required the exercise of the inventive faculty,

Question 5: may a U. S. Court of Appeals overrule the jury's fact-finding of invention which was expressly concurred in by the trial Judge[3] (and substitute its own fact-finding of non-invention) ?

(This Question is the basis of *Reasons 1-B & 1-C*, and is covered by *Argument—Points 1-B & 1-C* of supporting Brief)

Question 6: may a U. S. Court of Appeals do so (i.e. "5" above), on the basis of a prior-art patent[4] (well known to[5] but) *never* relied upon by the defendant either in the trial Court[6] or in the Court of Appeals[7] (and as to which

[3] Thereafter the trial judge, in his Opinion (I R 71-4) denying defendant's motion for new trial, expressly concurred in the fact-finding of invention implied in the jury's verdict, as will be seen from said Opinion and more particularly from the parts quoted therefrom on page of the within Petition.

[4] i.e. the Alemite-owned Gullborg patent 1,307,734, which was held unenforceable (or invalid) by this Court in *Bassick* v. *Hollingshead* and *Rogers* v. *Alemite* (298 U.S. 415) because the claims thereof were drawn to an old and exhausted combination of pump, grease-cup and coupler (*this Court conceding the patentability of the Gullborg coupler per se*)

[5] i.e. at all times herein concerned owned by the Stewart-Warner Corporation which openly and avowedly defended and paid for the defense of this suit

[6] namely, *not* cited in the Answer (I R 26-36), *nor* in any amendment thereto *nor* in any Notice under 35 U.S.C. 69, *nor* relied upon by defendant at any time during the trial, and *not* cited in defendant's Motion for Directed Verdict under Rule 50 (I R 51-3) and *not* cited in defendant's Motion under Rule 50-b for Judgment Notwithstanding the Verdict (I R 54-7), and not cited in defendant's Motion for New Trial under Rule 59 (I R 62-7)

[7] namely *not* cited or relied upon in defendant-appellant's brief filed in the Court of Appeals *nor* upon oral argument in that Court

prior-art patent plaintiff-appellee has therefore not had its day in court)[8] ?

(This Question is the basis of *Reason 3* and is covered by *Argument—Point 3* of supporting Brief)

Question 7: may a U. S. Court of Appeals reverse a judgment (entered in accordance with the jury's verdict) and direct the entry of a judgment for appellant (i.e. without directing a new trial) where there has been no motion for a directed verdict under Rule 50-a[9], nor a motion for judgment notwithstanding the verdict under Rule 50-b[10] *directed to the ground upon which reversal was based* (even though there were motions under Rules 50-a[9] and 50-b[10] directed to grounds other than the grounds of the appellate Court's reversing decision) ?

(This Question is the basis of *Reasons 3 & 4*, and is covered by *Argument—Points 3 & 4* of supporting Brief)

Question 8: is not such a reversing decision of a U. S. Court of Appeals an abridgment of the right of trial by jury and a re-examination of a fact tried by the jury (in a manner other than according to the rules of common law) in violation of the *Seventh Amendment of the Constitution of the United States* ?

(This Question is the basis of Reasons 1-C, 3 & 4, and is covered by Argument—Points 1-C, 3 & 4 of supporting Brief)

Question 9: does not such action of a U. S. Court of Appeals constitute a deprivation of petitioner's property without due process of law, in violation of the *Fifth Amendment of the Constitution of the United States* ?

(This Question is the basis of *Reasons 3 & 4*, and is covered by *Argument—Points 3 & 4* of supporting Brief)

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[8] In so holding the patent-in-suit invalid, the appellate Court also *erroneously* relied on (for its authority) and misconstrued this Court's decisions in *Bassick* v. *Hollingshead* and *Rogers* v. *Alemite* 298 U.S. 415, and *Lincoln* v. *Stewart-Warner* 303 U.S. 545 (*which decisions were likewise never relied upon by respondent either in the trial Court or in the appellate Court*);—wherefore the decision of the 8th Circuit (the review of which is here sought) is in conflict with this Court's aforesaid decisions in the *Bassick, Rogers* and *Lincoln* cases. This conflict is the basis of the following Question 10

[9] I R 51-53

[10] I R 54-57

Question 10: Does not the Court of Appeals' decision at bar misinterpret and unduly expand this Court's decisions in *Bassick* v. *Hollingshead* and *Rogers* v. *Alemite* (298 U.S. 415) and in *Lincoln* v. *Stewart-Warner* (303 U.S. 545) and is not the Court of Appeals' decision at bar in conflict with this Court's aforesaid decisions ?

in that the Court of Appeals' decision at bar interpreted this Court's aforesaid decisions to mean that there can be no patentability in the construction or mechanism of the improved and admittedly unanticipated *unitary* device (i.e. a coupler) *per se*, even though such improved *unitary* device is *not* claimed in combination with the old environmental devices (i.e. the old pump and the old grease-cup between which the new and improved coupler is to make a temporary fluid-tight connection),

whereas in its aforesaid decisions, this Court conceded the patentability of the improved *unitary* device[11] (i.e. the coupler) *per se*, and merely held that one who invents an improved *unitary* device (i.e. a coupler) otherwise patentable *per se*[12], may not claim such device *in combination with* the other old devices (i.e. the old pump and the old grease-cup) which merely constitute the old *environ-*

[11] i.e. the coupler which is specifically and adequately defined in the claims, in terms of its detailed construction or mechanism, so as to distinguish such device from the prior-art devices in its class

[12] namely patentable in respect to its own internal construction or mechanism, *as, for instance,* the construction or mechanism of the bayonet type coupler specifically defined in the coupler-defining portions of claims 1 to 6 and 8 & 10 of Gullborg patent 1,307,734 held unenforceable (or invalid) in *Bassick* v. *Hollingshead* and *Rogers* v. *Alemite* (298 U.S. 415), because the claims improperly also included the *old* pump and the *old* grease-cup of the prior art, and *as, for instance,* the construction or mechanism of the multi-jawed chuck type coupler specifically defined in the coupler-defining portion of claim 2 of Butler patent 1,593,791 held invalid in *Lincoln* v. *Stewart-Warner* (303 U.S. 545), because the claim improperly also included the *old* pump and the *old* grease-cup (or "nipple") of the prior-art.

ment[13] in which his improved device (i.e. the coupler) finds its utility;—this Court, in its aforesaid decisions, holding that one who invents an improved coupler should claim such coupler *per se* (which is precisely what the Johnson brothers did in their patent here in suit).

(This Question is the basis of *Reason 5*, and is covered by *Argument—Point 5* of supporting Brief)

Question 11: Has this Court, in and by its recent decisions in

Cuno Engineering Corp. v. *Automatic Devices Corp.* (314 U.S. 84),
Jungersen v. *Ostby & Barton Co.* (335 U.S. 560) and
Mandel Brothers, Inc. v. *Wallace* (335 U.S. 291),

so raised "the standards of originality necessary to sustain a patent"* (as the Court of Appeals concluded in the case at bar) as to require or authorize a U. S. Court of Appeals to overrule and set aside a jury's verdict and implied fact-finding of invention in the admittedly unanticipated[2] device of the patent in suit which the evidence showed and both Courts recognized was a valuable contribution to the art and achieved great public acceptance and commercial success,[3] and so to reverse a judgment entered for plaintiff in accordance with such verdict and direct the dismissal of the Complaint, on the basis of a "prior-art" patent,[4] principle and authorities[5] (applicable

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[13] which environmental devices are included in the claims in broad, all-inclusive language comprehending *all* environmental devices of the same classes, irrespective of their construction or mechanism

* quoted from the appellate Opinion in the case at bar (176 F.2d 448)

[2] see footnote 2 on page 33, supra

[3] see pages 9 & 10, supra

[4] Gullborg 1,307,734

[5] *Bassick* v. *Hollingshead* and *Rogers* v. *Alemite* (298 U.S. 415) and *Lincoln* v. *Stewart-Warner* (303 U.S. 545)

to and adjudicating such "prior-art" patent) *never* relied on by defendant-respondent,

where such fact-finding and verdict of the jury (and the judgment entered in accordance therewith) were wholly consistent and in harmony with that same appellate Court's fact-findings in an equity suit[6] between the same parties and involving the same subject matter, decided by that Court 13 years earlier,

where such earlier fact-findings and decision of that appellate Court were *res judicata* in the case at bar (and were so pleaded by plaintiff-petitioner), and

where the trial Court instructed the jury in the language of this Court's decision[7] supposedly raising the standard of invention, and

where the trial Judge, fully cognizant of this Court's above-cited decisions supposedly raising the standard of invention, expressly concurred[8] in the jury's fact-finding of invention ?

(This Question is a basis of Reason 6, and is covered by *Argument—Point 6* of supporting Brief)

Reasons Relied on for the Allowance of Writ of Certiorari

Reason 1 relied on for grant of certiorari:

Under the authority of *Douglas* v. *Cunningham* 294 U.S. 207, 209; *Mandel Bros.* v. *Wallace* 335 U.S. 291; *Jungersen* v. *Ostby and Barton Co.* 335 U.S. 560; and

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[6] *Stewart-Warner* v. *Jiffy* 81 F.2d 786 (CCA-8)

[7] *Cuno* v. *Automatic*, supra (see page 20, supra, for the trial Judge's instructions)

[8] see page 24, supra

Faulkner v. *Gibbs* 338 U.S. , 94 L.Ed. 30,* this Court should grant certiorari because the Court of Appeals for the 8th Circuit, in the case at bar, has passed on a number of important Federal questions (i.e. questions relating to the law of patents) in a way in conflict with the following applicable decisions of this Court and of Courts of Appeals for other Circuits on the following points of law:

1-A) A patent is presumed to be valid and an infringer who seeks to invalidate the patent in suit must, in order to prevail, establish the defense of non-invention by clear and convincing evidence, reasonable doubts being resolved against the infringer:

Coffin v. *Ogden* 18 Wall. 120, 124; 21 L.Ed. 821, 823

Lehnbeuter v. *Holthaus* 105 U.S. 94; 26 L.Ed. 939, 940

Cantrell v. *Wallick* 117 U.S. 689, 695, 696; 29 L.Ed. 821, 823

Washburn & Moen Mfg. Co. v. *Beat 'Em All Barbed Wire Co.* 143 U.S. 275, 285; 36 L.Ed. 154, 159

Radio Corp. v. *Radio Engineering Laboratories* 293 U.S. 1, 7, 8; 79 L.Ed. 163, 168

Mumm v. *Decker* 301 U.S. 168, 171; 81 L.Ed. 983, 985

(whereas the Court of Appeals' decision at bar was obviously based on the assumption that the patentee, i.e. petitioner, had the burden of affirmatively establishing invention in order to prevail)

This Reason involves foregoing *Question 2.*

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* the foregoing authorities are to the effect that certiorari should be granted when the decision below involves an important question of federal law and is in probable conflict with the applicable decisions of this Court and in conflict with the decisions of Courts of Appeals for other Circuits. These authorities for the granting of certiorari are applicable also to *Reasons 2, 3, 4, 5 & 6* set forth hereinbelow.

1-B) Invention is a question of fact and, in cases tried to a jury, is the sole province of the jury to decide:

Keyes v. *Grant* 118 U.S. 25, 30 L.Ed. 54, 57, 58

Thomson Spot Welder Co. v. *Ford* 265 U.S. 445, 446, 68 L.Ed. 1098, 1100

United States v. *Esnault-Pelterie* 299 U.S. 201, 205, 81 L.Ed. 123, 125

Battin v. *Taggert* 17 How. 74, 85, 15 L.Ed. 37, 41

Bischoff v. *Wethered* 9 Wall. 812, 814, 19 L.Ed. 829, 830

Williams Mfg. Co. v. *United Shoe Machinery Corp.* 316 U.S. 364, 367, 88 L.Ed. 1537, 1542

Elishewitz v. *Bronston* 40 F.2d 434, 435 (CCA 2)

Kurtz v. *Belle Hat Lining Co.* 280 Fed. 277 (CCA 2)

Radiator Specialty Co. v. *Buhot* 39 F.2d 373, 376 (CCA 3)

Stubnitz-Greene v. *Fort Pitt Bedding Co.* 110 F.2d 192 (CCA 6)

Vulcan Corp. v. *Slipper City Co.* 89 F.2d 109 (CCA 6)

Research Products Co. v. *Tretolite* 106 F.2d 530 (CCA 9)

(whereas the Court of Appeals' decision at bar reconsidered the evidence de novo as if it were the fact-trier and, without giving any weight to the fact-findings and verdict of the jury, made a fact-finding of non-invention based solely on its own interpretation of conflicting evidence, as to which reasonable men could disagree)

This Reason involves foregoing *Questions 1 & 5.*

1-C) A jury's fact-finding on the question of invention should not be disturbed on appeal in the absence of a very obvious showing of error, and where there is cogent and credible evidence in the record to support the fact-finding and the verdict based thereon, and where the fact-finding and verdict were concurred in by the trial Judge (who considered and denied defendant's motions for directed verdict and for judgment notwithstanding the verdict), a reversal of the jury's fact-finding and verdict and the judgment entered thereon is erroneous and constitutes a deprivation of the fundamental right to a jury trial as guaranteed by the *Seventh Amendment to the Constitution:*

Continental Paper Bag Co. v. *Eastern Paper Bag Co.* 210 U.S. 405, 416, 422; 52 L.Ed. 1122, 1127, 1129

Adamson v. *Gilliland* 242 U.S. 350; 61 L.Ed. 356

Williams Mfg. Co. v. *United Shoe Machinery Corp.* 316 U.S. 364, 367; 86 L.Ed. 1537, 1542

Goodyear Tire & Rubber Co. v. *Ray-O-Vac Co.* 321 U.S. 275, 278; 88 L.Ed. 721, 724

Graver Tank & Mfg. Co. v. *Linde Air Products Co.* 336 U.S. 271; 93 L.Ed. 492, 496

Faulkner v. *Gibbs* 338 U.S. ; 94 L.Ed. 30

(whereas the Court of Appeals' decision at bar set aside the jury's verdict and fact-finding of invention, *not* on the theory that the evidence was insufficient to take the case to the jury as a matter of law but, instead, on the theory that the weight of evidence did *not*, in the Court of Appeals' view, establish invention as a matter of fact)

This Reason involves foregoing *Question 5, 8 & 9.*

Reason 2 relied on for grant of certiorari:

This Court should grant certiorari under the authorities cited at bottom of page 38 hereinabove, under *Reason 1,*

2-A) because the decision of the Court of Appeals for the 8th Circuit in the case at bar

(which was based on fact-finding diametrically opposite to those made by the same Court (differently composed) upon the same underlying facts in an earlier suit, decided 13 years before, between the same parties or their privies)

is in conflict with the following decisions of Courts of Appeals for other Circuits which hold that a Court is bound by its own prior fact-findings in a suit between the same parties or their privies, involving the same subject matter:

Carey v. *Ford Motor Co.* 115 F.2d 204 (CCA 6)

Murray v. *Detroit Wire Spring Co.* 206 Fed. 465 (CCA 6)

Arlac Dry Stencil Corp. v. *A. B. Dick Co.* 46 F.2d 899, 902 (CCA 3)

Concrete Mixing and Conveying Co. v. *Powers-Kennedy Contracting Corp.* 27 F.2d 668, 670 (CCA 2); reversed on other grounds 282 U.S. 175

and

2-B) because the aforesaid decision of the Court of Appeals, which reversed

(upon the theory, necessarily implied in such reversal, that reasonable men could not disagree upon the facts)

the jury's verdict and the fact-finding implied therein

where such verdict and fact-finding were consistent with and in effect followed the aforesaid earlier decision of the same Court of Appeals (differently composed)

and

where the verdict and fact-finding were expressly concurred in by the trial judge,

constituted a violation of the *Seventh Amendment to the Constitution* and was an abridgement of the right of trial by jury and a re-examination of a fact tried by a jury in a manner other than according to the rules of common law and is in conflict with the following decisions of this Court and of Courts of Appeals for other Circuits:

Fowler v. *Rathbones,* 79 U.S. 102; 20 L.Ed. 281

Duncan v. *Atchison, T. & S.F.R. Co.,* 72 Fed. 808 (CCA 9)

J. W. Bishop Co. v. *Shelhorse,* 141 Fed. 643 (CCA 5)

McCann v. *New York Stock Exchange,* 107 F.2d 908 (CCA 2), certiorari denied 309 U.S. 684

This Reason involves foregoing *Questions 3 & 4.*

Reason 3 relied on for grant of certiorari:

This Court should grant certiorari under the authorities cited at bottom of page 38 hereinabove, under *Reason 1,* because the decision of the Court of Appeals for the 8th Circuit, in the case at bar

(which based its reversal upon a prior patent not relied on by defendant-respondent in the District Court and not considered by the jury or by the trial Judge and not made a ground of either motion under Rule 50-a or under Rule 50-b and not included in

defendant-respondent's Statement of Points under Rule 75-d of the Federal Rules of Civil Procedure and not relied on by defendant-respondent on its appeal to the Court of Appeals),

deprives petitioner of its property without due process of law, in violation of the *Fifth Amendment to the Constitution* and is in violation of the *Seventh Amendment to the Constitution* and is in conflict with the applicable decisions of this Court and of Courts of Appeals for other Circuits which are to the effect that, especially in a jury case, a Court of Appeals must decide the case on the record below and cannot set aside a verdict and a fact-finding inherent therein on grounds or on evidence not considered below and not urged on appeal.

Parsons v. *Bedford* 3 Pet. 433, 447, 448, 7 L.Ed. 732, 737

Jesionowski v. *Boston & Maine Railroad* 329 U.S. 452, 458, 459, 91 L.Ed. 416, 421

Ritchie v. *Drier,* 165 F.2d 238, 240 (U.S. App. D.C.)

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Federal Deposit Insurance Corp. v. *Congregation Poiley Tzedeck* 159 F. 2d 163, 167 (CCA 2)

Siano v. *Helvering* 79 F.2d 444, 446 (CCA 3)

Roe v. *Sears, Roebuck & Co.* 132 F.2d 829, 832 (CCA 7)

This reason involves foregoing *Questions 6, 7, 8 & 9.*

Reason 4 relied on for grant of certiorari:

This Court should grant certiorari under the authorities listed hereinabove, under *Reason 1,* because the decision of the Court of Appeals for the 8th Circuit, in the case at bar,

(which reversed the jury's verdict and the judgment entered below and directed entry of judgment for appellant, defendant-respondent (as distinguished from directing a new trial) on the basis of a patent not relied on in defendant-respondent's motion for judgment notwithstanding the verdict),

is a deprivation of petitioner's property without due process of law, in violation of the *Fifth Amendment to the Constitution* and is an abridgment of the right of trial by jury and a re-examination of a fact tried by the jury (in a manner other than according to the rules of common law) as violates the *Seventh Amendment to the Constitution* and is in conflict with the applicable decisions of this Court and of the Courts of Appeals for other Circuits, which are to the effect that a Court of Appeals cannot order judgment for the appealing party and, instead, *must* send the case back for a new trial where the basis for reversal was not brought to the attention of the trial Judge by a motion for judgment notwithstanding the verdict under Rule 50(b) of the Federal Rules of Civil Procedure:

Cone v. *West Virginia Pulp & Paper Co.* 330 U.S. 212, 214-218, 91 L.Ed. 849, 851-854

Aetna Insurance Co. v. *Kennedy* 301 U.S. 389, 394, 81 L.Ed. 1177, 1181

Globe Liquor Co. v. *San Roman* 332 U.S. 571, 573-574, 92 L.Ed. 177, 179-180

Fountain v. *Filson* 336 U.S. 681, 93 L.Ed. 768, 769

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Garman v. *Metropolitan Life Insurance Co.* 175 F.2d 24, 28 (CA-3)

Marsh v. *Illinois Central R. Co.* 175 F.2d 498, 500 (CA-5)

This Reason involves foregoing *Questions 7, 8 & 9.*

Reason 5 relied on for grant of certiorari:

This Court should grant certiorari, under the authorities cited at the bottom of page 38, under foregoing Reason 1 because the decision of the Court of Appeals for the 8th Circuit in the case at bar, is probably in conflict with the following applicable decisions of this Court, which are to the effect that coupler mechanisms are patentable, per se, and should be covered by patent-claims directed to the coupler *per se* and *not* by patent-claims directed to the combination of the coupler with an old pump and an old grease-cup or lubricant-receiving nipple or fitting (the Court of Appeals in the case at bar, on the other hand, held that the mechanism of the coupler, per se, is not patentable and cannot be the subject of patent-claims, and erroneously relied on this Court's following decisions as its authority for so holding):

Bassick v. *Hollingshead* 298 U.S. 415
Rogers v. *Alemite* 298 U.S. 415
Lincoln Engineering Co. v. *Stewart Warner Corp.* 303 U.S. 545

This Reason involves foregoing *Question 10.*

Reason 6 relied on for grant of certiorari:

This Court should grant certiorari under the authorities cited at the bottom of page 38 hereof, under *Reason 1,* because the decision of the Court of Appeals for the 8th Circuit, in the case at bar, has misconstrued and misapplied this Court's decision in the case of *Cuno Engineering Corp.* v. *Automatic Devices Co.,* supra, and because the extreme circumstances of the case at bar, as set out in foregoing *Question 11* (under which the appellate Court so misapplied this Court's aforesaid decision) point up the general and widespread concern and comment of both the Bench and the Bar as to what the proper and intended interpretation should be of this Court's aforesaid decision.

This *Reason* involves foregoing *Question 11.*

Conclusion

Wherefore, your petitioner respectfully prays for a writ of certiorari to the United States Court of Appeals for the Eighth Circuit, to the end that this cause may be reviewed and determined by this Court, and that the judgment and decision of the Court of Appeals for the Eighth Circuit may be reversed.

JIFFY LUBRICATOR COMPANY, INC.
by
LEONARD L. KALISH,
C. A. TANEY, JR.,
attorneys for petitioner.

Counsel's Certificate

The undersigned hereby certify that the foregoing petition is, in their opinion, well founded, and that the case is one in which the petitioner's prayer should be granted by this Court.

LEONARD L. KALISH,
C. A. TANEY, JR.,
attorneys for petitioner.

FILE COPY

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CHARLES ELMORE CROPLEY

In the

Supreme Court of the United States

No. 543 October Term, 1949

Jiffy Lubricator Company
plaintiff-petitioner

v.

The Alemite Company
defendant-respondent

BRIEF

in support of
Petition for Writ of Certiorari

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Brief in suport of Petition for Writ of Certiorari

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

The opinion of the Court below

The opinion of the Court of Appeals for the 8th Circuit is reproduced at pages 2236 to 2245 of Volume VIII of the Transcript of Record and is reported at 176 F.2d 444.

The judgment of the U. S. District Court for the District of North Dakota in favor of petitioner is reproduced at pages 61 to 62 of Volume I of the Transcript of Record, and the jury's verdict is reproduced at page 54 of Volume I of the Transcript of Record.

Jurisdiction

The date of the judgment of the U. S. Court of Appeals for the Eighth Circuit (to be reviewed) is August 17, 1949. The date of the denial (VIII R 2287) of petitioner's timely Petition for Re-Hearing (VIII R 2247-2285) is October 31, 1949.

The judgment was entered in a patent-infringement suit, brought under the Patent Statutes of the United States on account of the infringement of petitioner's Letter Patent 2,040,177 issued by virtue of Section 4886 of the Revised Statutes of the United States (35 U.S.C. 31).

The jurisdiction of this Court is invoked under Section 1254(1) of Title 28 of the United States Code.

Statement of the Case

A *Summary of Matter Involved* is set forth on page 2, and a *Statement of Matter Involved* is set forth on pages 2 to 24 of the Petition for Writ of Certiorari, and such *Summary* and *Statement* are here included, by reference.

Specification of Errors

The reasons (1 to 6 inclusive) relied on for the allowance of writ of certiorari are set forth on pages 38 to 46 of the Petition and are here included by reference.

ARGUMENT

Argument—Point 1

(involving *Question 2* and *Reason 1* of the Petition)

It is submitted that the present case is one in which certiorari should be granted because, as set forth in *Reason 1* relied on for the allowance of certiorari of the Petition (which is incorporated herein by reference) and as will be brought out more fully hereinbelow, the Court of Appeals for the 8th Circuit, in the case at bar, has passed on a number of important Federal questions (i.e. questions relating to the law of patents) in a way in conflict with the applicable decisions of this Court and of Courts of Appeals for other Circuits.

That an important question of Federal law is involved and that the decision below is probably in conflict with the applicable decisions of this Court and in conflict with the decisions of Courts of Appeals for other Circuits are, of course, recognized grounds for granting certiorari. See *Douglas* v. *Cunningham,* 294 U.S. 207, 209; *Mandel Bros.* v. *Wallace,* 335 U.S. 291; *Jungersen* v. *Ostby and Barton Co.,* 335 U.S. 560; and *Faulkner* v. *Gibbs,* 338 U.S. (94 L.Ed. 30).

Argument—Point 1-A

(involving Question 2 and Reason 1-A of the Petition)

Legal presumption of patentable invention inherent in granting of patent

The decision of the Court of Appeals for the 8th Circuit in the case at bar, in reversing the jury's verdict and the jury's fact-finding of invention inherent in the verdict, explained its action in the following language:

> "Since it is our opinion that the evidence, viewed in the aspect most favorable to the plaintiff, does not sustain the conclusion that Johnsons' contribution to the art of lubrication rose to the level of patentable invention, it is unnecessary to consider other questions" (176 F.2d 449)

The Court of Appeals seemingly based its decision, inter alia, upon the conclusion that the evidence was not sufficient to establish patentable invention.

In other words, the Court of Appeals took the position that the granting of the patent was itself irrelevant and carried with it no presumption *of invention* and that the patentee (petitioner) had the burden of introducing evidence to show that the subject matter of the patent is *inventive,* and that the patentee's failure to do so was justification for deciding in favor of the infringer.

It is submitted that the Court of Appeals erred in thus placing upon the patentee (petitioner) the burden of affirmatively proving invention, and that the decision of the Court of Appeals is in direct conflict with the following decisions of this Court which hold that a patent is presumed to be valid (and the subject matter claimed therein *inventive*) and that an infringer who seeks to invalidate the patent in suit has the burden of establishing the defense of non-invention by clear and convincing evidence, and that reasonable doubts on the question of invention are resolved against the infringer so that, unless there is clear and convincing evidence of non-invention, the patent in suit must be upheld:

Coffin v. *Ogden* 18 Wall. 120, 124; 21 L.Ed. 821, 823
Lehnbeuter v. *Holthaus* 105 U.S. 94; 26 L.Ed. 939, 940
Cantrell v. *Wallick* 117 U.S. 689, 695, 696; 29 L.Ed. 821, 823
Washburn & Moen Mfg. Co. v. *Beat 'Em All Barbed Wire Co.* 143 U.S. 275, 285; 36 L.Ed. 154, 159
Radio Corp. v. *Radio Engineering Laboratories* 293 U.S. 1, 7, 8; 79 L.Ed. 163, 168
Mumm v. Decker 301 U.S. 168, 171; 81 L.Ed. 983, 985

Argument—Point 1-B

(involving Questions 1 and 5 and Reason 1-B of the Petition)

Invention is a question of fact for the jury

In reversing the jury's verdict and the fact-finding of invention inherent in its verdict, the Court of Appeals for

the 8th Circuit, in the case at bar, reconsidered the "prior art", *de novo,* as if it were the fact-trier and made its own fact-finding of non-invention based solely on its own interpretation of the "prior art" *which it does not identify*† but which *in its opinion**, rendered the admittedly *un*anticipated Johnson patent in suit invalid. The Court of Appeals summarily discarded the jury's verdict with the statement that:

> "If the patent is clearly void, the verdict of the jury is, of course, of no help to the plaintiff and other questions need not be considered." (176 F.2d 445)

In other words, the Court of Appeals took the position that if *it* were satisfied that the admittedly *un*anticipated coupler mechanism or construction of the patent in suit did not involve *invention,* then the judgment below in favor of petitioner would have to be reversed regardless of the fact that the jury had weighed all the evidence, pro and con, on the question of invention, and had rendered a verdict in favor of the patentee (petitioner) necessarily based on a fact-finding that the coupler mechanism or construction of patent in suit did involve invention.

It is submitted that the action of the Court of Appeals is clearly erroneous since it is well settled, under the following decisions of this Court, that invention is a question of fact and, in cases tried to a jury, is the sole province of the jury to decide:

> *Keyes* v. *Grant,* 118 U.S. 25, 30 L.Ed. 54, 57, 58
> *Thomson Spot Welder Co.* v. *Ford,* 265 U.S. 445, 446, 68 L.Ed. 1098, 1100
> **United States v. Esnault-Pelterie, 299 U.S. 201, 205,** 81 L.Ed. 123, 125

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* the Court of Appeals' Opinion nowhere even refers to the prima facie presumption of validity inherent in the patent, as discussed above under *Argument—Point 1-A* or the evidence (including evidence of public acceptance, commercial success, imitation by the infringer, etc.) which was introduced during the trial as constituting cogent evidence of invention to support the presumption of validity.

† except for the Gullborg patent (*never* relied on by defendant) and the Butler patent which the Court apparently did not rely on (*and could not rely on* in view of both Courts' fact-findings in Stewart-Warner *v.* Jiffy, 81 F.2d 786, as shown in *footnotes 4 to 19,* inclusive, on pages 5 to 8, inclusive of the Petition)

Battin v. *Taggert,* 17 How. 74, 85, 15 L.Ed. 37, 41
Bischoff v. *Wethered,* 9 Wall. 812, 814, 19 L.Ed. 829, 830
Williams Mfg. Co. v. United Shoe Machinery Corp., 316 U.S. 364, 367, 86 L.Ed. 1537, 1542
Elishewitz v. *Bronston,* 40 F.2d 434, 435 (CCA 2)
Kurtz v. *Belle Hat Lining Co.,* 280 Fed. 277 (CCA 2)
Radiator Specialty Co. v. *Buhot,* 39 F.2d 373, 376 (CCA 3)
Stubnitz-Greene v. *Fort Pitt Bedding Co.,* 110 F.2d 192 (CCA 6)
Vulcan Corp. v. *Slipper City Co.,* 89 F.2d 109 (CCA 6)
Research Products Co. v. *Tretolite,* 106 F.2d 530 (CCA 9)

Thus, the action of the Court of Appeals, in the case at bar, in substituting its own opinion on the question of invention, for the opinion of the jury, constituted an improper usurpation of the prerogative of the jury and a deprivation of the right to a jury trial as guaranteed to patentee (petitioner) under the *Seventh Amendment to the Constitution.*

It should be kept in mind that the Court of Appeals did *not* hold that, upon the evidence presented to the jury, the patent in suit was invalid *as a matter of law* and that, therefore, the trial judge should have granted defendant's motion for directed verdict or defendant's motion for judgment notwithstanding the verdict. Instead, the Court of Appeals simply substituted its own judgment and interpretation of the evidence for the judgment and interpretation of the jury, which was clearly improper.

It should also be kept in mind that, as will be discussed more fully hereinbelow, the Court of Appeals reached its fact-finding of non-invention upon the basis of the prior Gullborg patent 1,307,734 which, as shown by the Chart on page 29 of the Petition, was *never* relied on by defendant in the District Court, was not considered by the jury, was not included either in defendant's motion

for directed verdict or in defendant's motion for judgment notwithstanding the verdict, was not included in the Notice of Appeal or in appellant's (respondent's) Statement of Points under Rule 75(b) and was not even mentioned by appellant (respondent) during the argument or in brief on appeal.

Moreover, in its reversing decision, the Court of Appeals does not point to *any* prior-art patent or patents relied on by appellant (respondent) on its *motion for judgment notwithstanding the verdict,* as the "prior-art" over which the Court deemed the coupler mechanism of the construction of the patent here in suit not inventive.

Thus, for all that can be gleaned from the appellate Court's opinion, it may also have based its fact-finding of non-invention upon the Delaney patent or the Oliver patent which were relied on by defendant during the trial but not made grounds of its motion for directed verdict or its motion for judgment notwithstanding the verdict (see lines 2 and 4 of the Chart on page 29 of the Petition). Likewise, for all that can be gleaned from the opinion, the Court of Appeals may have based its fact-finding of non-invention upon the many other "prior-art" patents which it had considered as part of the "prior-art" in *Stewart-Warner* v. *Jiffy,* (81 F.2d 786) which prior decision the Court's opinion at bar discusses at length (176 F.2d 446-7);—as, for instance, the Alley patent, the Dupre patent, the Winkley patent, the Goldman patent, the Davis patent, the Jacques patent, the Bruce patent, the Zerk patent and the Tarlton patent, all of which were a part of the "prior-art" in the earlier case of *Stewart-Warner* v. *Jiffy,* supra, and some of which are also of record in the case at bar *but not relied on upon by defendant-respondent* (see lines 1, 3, 6, 11, 12, 13, 14, 16 and 17 of the Chart on page 29 of the Petition).

It is submitted that such a fact-finding of non-invention made by the Court of Appeals upon the basis of prior art* never urged by appellant and not considered

* Gullborg *and/or* Delaney, Oliver, Alley, Dupre, Winkley, Goldman, Davis, Jacques, Bruce, Zerk and Tarlton

by the jury (and not made grounds of motions under Rules 50-a and 50-b), was a clearly erroneous attempt to re-examine a fact (namely the fact-finding of invention inherent in the jury's verdict) found by a jury in violation of the *Seventh Amendment to the Constitution.*

Argument—Point 1-C

(involving Questions 1 & 5 and Reason 1-C of the Petition)

Jury's fact-finding should not be disturbed

As pointed out above under foregoing *Argument—Point 1-B,* there was cogent and credible evidence in the record to support the jury's verdict and the jury's fact-finding of invention inherent in the verdict (see pages 9, 11 to 20 of the Petition). The jury's interpretation of the evidence was expressly concurred in by the trial judge, who first considered and denied defendant's motion for directed verdict and thereafter considered an denied defendant's motion for judgment notwithstanding the verdict (see pages 23 & 24 of Petition).

Indeed, the Court of Appeals' decision nowhere even mentions any of the extensive evidence supporting the prima facie presumption of invention inherent in the patent in suit, much less decides that the evidence was insufficient to support the jury's verdict and fact-finding. It likewise does not identify any prior-art patent or patents (relied upon by defendant-respondent) which, in the Court's opinion, negative invention in the patent in suit.*

That the Court of Appeals may have disagreed with the jury's interpretation of the evidence is wholly immaterial, so long as the evidence was of the kind as to which reasonable men could differ (and, as to this, there is no doubt since, as will be discussed more fully hereinbelow, the Court of Appeals itself, in an earlier case between the same parties or their privies, made fact-findings, from these same underlying facts, sustaining in-

* except for the Gullborg patent (*never* relied on by defendant) and the Butler patent which the Court apparently did not rely on (*and could not rely on* in view of both Courts' fact-findings in Stewart-Warner *v.* Jiffy, 81 F.2d 786, as shown in *footnotes 4 to 19,* inclusive, on pages 5 to 8, inclusive of the Petition)

vention in petitioner's Jiffy coupler of the patent here in suit) since it is well settled that a jury's fact-finding on the question of invention should not be disturbed on appeal in the absence of a very obvious showing of error and that, where there is cogent and credible evidence in the record to support the verdict and the fact-finding implied therein, and where the fact-finding and verdict were expressly concurred in by the trial judge (who considered and denied defendant's motions for directed verdict and for judgment notwithstanding the verdict), a reversal of the jury's fact-finding and verdict and the judgment entered thereon is erroneous and constitutes a deprivation of the fundamental right to a jury trial as guaranteed by the *Seventh Amendment to the Constitution* and constitutes an improper and unauthorized re-examination of a fact found by a jury in a manner other than at common law and in violation of the *Seventh Amendment to the Constitution.*

St. Paul Plow Works v. *Starling,* 140 U.S. 184, 35 L.Ed. 404, 408

Continental Paper Bag Co. v. *Eastern Paper Bag Co.,* 210 U.S. 405, 416, 422; 52 L.Ed. 1122, 1127, 1129

Adamson v. *Gilliland,* 242 U.S. 350; 61 L.Ed. 356

Williams Mfg. Co. v. *United Shoe Machinery Corp.,* 316 U.S. 364, 367; 86 L.Ed. 1537, 1542

Goodyear Tire & Rubber Co. v. *Ray-O-Vac Co.,* 321 U.S. 275, 278; 88 L.Ed. 721, 724

Graver Tank & Mfg. Co. v. *Linde Air Products Co.,* 336 U.S. 271; 93 L.Ed. 492, 496

Faulkner v. *Gibbs,* 338 U.S. ; 94 L.Ed. 30

Argument—Point 2-A

(Involving Questions 3 & 4 and Reason 2-A of the Petition)

Court of Appeals is bound by fact-findings in earlier equity suit between the parties, involving the same subject-matter.

As pointed out in the Petition, the decision of the Court of Appeals in the case at bar is based on fact-

findings diametrically opposite to those made by the same Court (differently composed) and by the District Court (upon the same underlying facts) in an earlier equity suit, (decided 13 years before) between the same parties or their privies, involving the same subject matter.

Thus, in the earlier case of *Stewart-Warner Corp.* v. *Jiffy Lubricator Co.* (81 F.2d 786) the District Court and the Court of Appeals for the 8th Circuit held the Jiffy coupler (which is the subject of the Johnson patent here in suit) to be an invention different from the Butler patent 1,593,791 (which is the principal patent relied on by defendant-respondent in the case at bar) and also held that the herein-accused Alemite coupler was different from the disclosure of the Butler patent and was same as or a mechanical equivalent of petitioner's Jiffy coupler and was inspired by the earlier-marketed Jiffy coupler (and not by the "prior art").

In the case at bar, on the other hand, the Court of Appeals for the 8th Circuit held that the Johnson patent in suit was not inventive over the prior-art (not identified by it) even though the Court recognized that its present conclusion was perhaps inconsistent with that reached in the earlier case.

It is submitted that the decision of the Court of Appeals in the case at bar is erroneous and is in conflict with the decisions of the Courts of Appeals for other Circuits which hold that a court is bound (either under the principle of *res judicata* or under the principle of *stare decisis*) by its own prior fact-findings in a suit between the same parties or their privies, involving the same subject matter:

Carey v. *Ford Motor Co.* 115 F.2d 204 (CCA 6)

Murray v. *Detroit Wire Spring Co.* 206 Fed. 765 (CCA 6)

Arlac Dry Stencil Corp. v. *A. B. Dick Co.* 46 F.2d 899, 902 (CCA 3)

Concrete Mixing & Conveying Co. v. *Powers-Kennedy Contracting Corp.* 27 F.2d 668, 670 (CCA 2); reversed on other ground 282 U.S. 175

Seeking to justify its seeming inconsistency, the Court of Appeals' opinion in the case at bar refers to the more recent decisions of this Court as "raising the standards of originality necessary to sustain a patent". (176 F.2d 448)

Whether or not there has in fact been any raising of the standard of invention is posed in *Question 11* of the Petition and is discussed herein below under *Argument—Point 6*. However, it is here pointed out that, even if the standards of invention have been raised, that is no justification for a Court not to adhere to its own prior fact-decisions in successive suits between the same parties involving the same subject matter.

The *Concrete Mixing & Conveying Co.* case, supra, is in point on this question. Thus, in that case, the Court of Appeals followed its own prior ruling (holding the patent valid) even though the prior ruling did *not* involve the same parties and even though the Court felt dissatisfied with its prior ruling. Subsequently, this Court granted certiorari because of conflict with a decision of another Court of Appeals holding the same patent invalid and, while reversing on other grounds, this Court did not criticize the Court of Appeals for its conduct in following its prior decision on the same patent.

Argument—Point 2-B

(involving Questions 3 & 4 and Reason 2-B of the Petition)

Reversal of jury's fact-finding inconsistent with appellate Court's prior fact-findings which jury followed

Where the same Court of Appeals (differently composed) can draw diametrically opposite inferences and ultimate fact-findings from the same underlying facts, in two successive suits, then reasonable men could differ as to the inferences and ultimate fact-finding to be drawn

from such underlying facts, and the jury's verdict and fact-finding implied therein, in the second suit, wholly consistent and in harmony with that appellate Court's fact-findings in the earlier suit, cannot be set aside by that appellate Court merely because it can and does draw different inferences and ultimate fact-findings in the second suit.

Under the *Seventh Amendment to the Constitution* "no fact tried by a jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law". Under the *Seventh Amendment,* Federal Courts of Appeals are precluded from re-examining facts found by a jury and, instead, are limited to a review of questions of law, or errors in the conduct of the trial.

Fowler v. *Rathbones,* 79 U.S. 102; 20 L.Ed. 281
Duncan v. *Atchison, T. & S. F. R. Co.,* 72 Fed. 808 (CCA 9)
J. W. Bishop Co. v. *Shelhorse,* 141 Fed. 643 (CCA 5)
McCann v. *New York Stock Exchange,* 107 F.2d 908 (CCA 2), certiorari denied 309 U.S. 684

The only way in which the question of invention (which, as pointed out above, is fundamentally a question of fact) could be converted into a question of law in the case at bar was if the evidence so overwhelmingly showed lack of invention that reasonable men could *not* have differed;—in which case the trial judge should have granted the motions for directed verdict or the motion for judgment notwithstanding the verdict.

In the case at bar, the very conduct of the Court of Appeals absolutely negatives any such interpretation of the evidence. Thus, as pointed out above, the District Court and the Court of Appeals itself, in an earlier equity case between the same parties, on the same underlying facts, found that the Jiffy coupler, which is the subject of the Johnson patent here in suit, was sub-

stantially different from the closest prior art (i.e. the Butler patent) and was a different invention*. Both the jury and the trial judge, in the case at bar, upheld the inventive character of the hydraulic coupler mechanism of the Johnson patent in suit.

Even if we concede, for purposes of argument, that the Court of Appeals could have changed its mind on this question of invention between the earlier suit and the present suit, the fact remains that the Court of Appeals (differently constituted) did, in the earlier suit, disagree with the Court of Appeals (as now constituted). How then can it be said that the fact-question of invention in the patent in suit is one as to which reasonable men could *not* differ so as to require the entry of a directed verdict or judgment notwithstanding the verdict holding the patent invalid on the question of invention?

We respectfully submit that the Court of Appeals' present reversing decision is erroneous and that, under the facts, it was without authority to disturb the jury's implied fact-finding of invention, even though the Court of Appeals (as now constituted) was of a different opinion on the question of invention.

Argument—Point 3

(Involving Questions 6, 7, 8 & 9 and Reason 3 of the Petition)

Reversal can not be based on "prior-art" patent never relied on by defendant

The reversing decision of the Court of Appeals is based on the prior Gullborg patent.

While defendant-respondent's privies (Alemite Corp. and Stewart-Warner Corp.) have at all times owned this Gullborg patent, and while defendant-respondent was represented throughout this case by Stewart-Warner's patent counsel, yet defendant-respondent did not consider the Gullborg patent sufficiently relevant either to cite in its Answer or to notice under 35 U.S.C. 69 or to offer in

* see footnotes 6 to 19 on pages 5 to 8 of the Petition.

evidence or otherwise rely on it, either during the trial or in its motion for directed verdict or in its address to the jury or in its motion for judgment notwithstanding the verdict, or to include it in appellant's Statement under Rule 75-d or to mention in its oral argument or in its brief in the Court of Appeals.

This Gullborg patent was introduced in evidence by plaintiff-petitioner in connection with and as part of its proofs of a reasonable royalty, as a measure of damage;—the Alemite Corporation and Stewart-Warner Corporation having had a long-established royalty-rate of up to $2.50 per Gullborg coupler (the hydraulic coupler of the patent here in suit having virtually completely replaced the Gullborg coupler).

Under the authorities discussed hereinabove under *Argument-Points 1-B and 1-C*, it is clear that the jury and *not* the Court of Appeals was the one to make the fact-finding of invention (or non-invention) based on the prior-art. See also *Parsons* v. *Bedford* 3 Pet. 433, 447, 448 (7 L.Ed. 732, 737).

A fortiori, the Court of Appeals was without any authority to consider evidence not considered by the jury or by the District Court. As stated in *Siano* v. *Helvering* 79 F.2d 444, 446 (CCA-3):

> "We find no statute granting the Circuit Courts of Appeals original jurisdiction upon appeal . . . to make findings of fact based on affidavits which were not in evidence before the court below."

Defenses not pleaded cannot be relied on on appeal.

Schmidtke v. *Conesa* 141 F.2d 634, 635 (CCA 1)
Edward B. Marks Music Corp. v. *Jerry Vogel Music Co.* 140 F.2d 268, 270 (CCA 2)
Trounstine v. *Bauer, Pogue & Co.* 144 F.2d 379, 382 (CCA 2)
Federal Deposit Insurance Corp. v. *Congregation Poiley Tzedeck* 159 F.2d 163, 167 (CCA 2)

Roe v. *Sears, Roebuck & Co.* 132 F.2d 829, 832 (CCA 7)

Moreover, a Court of Appeals should consider only those points specifically raised by appellant in his *Statement of Points* under Rule 75-d of the Rules of Civil Procedure.

Jesionowski v. *Boston & Maine Railroad* 329 U.S. 452, 458, 459, 91 L.Ed. 416, 421
Ritchie v. *Drier,* 165 F.2d 238, 240 (U.S. App. D.C.)

The action of the Court of Appeals, in basing its reversing decision upon a "prior-art" patent not pleaded by defendant and not urged by the defendant during the trial or on its Motion for Directed Verdict or on its Motion for Judgment Notwithstanding the Verdict and not mentioned in the *Statement of Points* under Rule 75-d and not relied on in defendant's briefs or argument before the Court of Appeals, was improper and constituted a violation of the *Seventh Amendment to the Constitution* and also a violation of the *Fifth Amendment to the Constitution* (in that it deprived petitioner of its patent rights without due process of law;—due process requiring a jury trial whereas the Court of Appeals' action vitiated the jury trial by deciding the case on a ground not considered by the jury).

Argument—Point 4.

(Involving Questions 7, 8 & 9 and Reason 4 of the Petition)

Court of Appeals erroneously entered judgment for appellant in absence of a motion for judgment n.o.v. based on the ground adopted by the Court of Appeals for its action

Even if it be assumed for purposes of argument that the Court of Appeals could rely on the Gullborg patent at all (and, it is petitioner's position as outlined under foregoing *Argument—Point 3,* that the Gullborg patent could not properly be relied on by the Court of Appeals for any purpose whatever), then it is submitted that the Court of

Appeals erred in entering judgment for appellant *instead of remanding the case for a new trial,* so as to afford the jury an opportunity to reconsider the question of invention in the light of the Gullborg patent.

Where there has been no motion for judgment notwithstanding the verdict *on the specific ground in question,* the Court of Appeals *cannot* reverse and enter judgment for appellant and, instead, must remand the case for a new trial.

Cone v. *West Virginia Pulp & Paper Co.* 330 U.S. 212, 214-218, (91 L.Ed. 849, 851-854)

Aetna Insurance Co. v. *Kennedy* 301 U.S. 389, 394 (81 L.Ed. 1177, 1181)

Globe Liquor Co. v. *San Roman* 332 U.S. 571, 573-574 (92 L.Ed. 177, 179-180)

If the defendant *had* relied upon the Gullborg patent, petitioner would have introduced evidence bearing upon the Gullborg patent and which would have shown that the true significance of the Gullborg patent was not what the appellate Court concluded, in its Opinion (in the absence of such evidence), and petitioner would have shown, *by documentary evidence,* that sole commercial significance of the Gullborg patent was merely that imparted to it by its *gross* misuse* by Alemite Corporation, Stewart-Warner Corporation *and by respondent,* and petitioner would also have shown, by evidence, that the Gullborg patent does not anticipate the subject matter of the Johnson patent here in suit and does not negative invention in the Johnson patent here in suit.

The action of the Court of Appeals in reversing and *in directing entry of judgment for respondent,* deprived petitioner of its right to introduce such evidence in rebuttal of the Gullborg patent as "prior-art".

The Court of Appeals therefore further erred in not sending the case back for a new trial rather than directing entry of judgment for respondent.

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* for the misuse of this patent, see *Stewart-Warner* v. *Staley, Trustee for Universal Lubricating Systems Inc.* 42 F. Supp. 140

As stated in *Fountain* v. *Filson,* 336 U.S. 681 (93 L.Ed. 768, 769):

> "One of the reasons for so holding* was that otherwise the party who had won in the trial court would be deprived of any opportunity to remedy the defect which the appellate court discovered in his case. He would have had such an opportunity if a proper motion[2] had been made by his opponent in the trial court".

It should be noted that in *Fountain* v. *Filson,* supra, this Court emphasized the need for a "*proper* motion" for judgment notwithstanding the verdict. This necessarily implies that the motion for judgment notwithstanding the verdict must point out to the trial judge *the particular ground* upon which the appellate Court subsequently based its reversal. Otherwise, the language of this Court would be meaningless since a motion for judgment notwithstanding the verdict based on specifically *different* grounds (as was made in the case at bar) does *not* give the trial Court an opportunity to consider the particular point in question and does not give the other party an opportunity to "remedy the defect" (i.e. to introduce testimony in rebuttal of the Gullborg patent, in the case at bar).

In the recent case of *Weade* v. *Dichmann, Wright & Pugh* 337 U.S. 801 (93 L.Ed. 1273, 1277), wherein the Court of Appeals had reversed the judgment of the District Court in favor of plaintiff (predicated on one theory of liability) and had directed entry of judgment in favor of defendant, this Court reversed so much of the Court of Appeals' decision as directed entry of judgment, and this Court, instead, directed remand of the case for a new trial because the pleadings suggested another theory of liability which had not been considered by the jury.

As stated in *Boston & Maine R. R.* v. *Coppellotti* 167 F.2d 201, 204 (CCA 1):

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* that an appellate court cannot direct entry of judgment for appellant in the absence of a motion for judgment notwithstanding the verdict

[2] for judgment notwithstanding the verdict

"The trial judge is better qualified than the appellate court to determine whether a new trial should be granted or judgment notwithstanding the verdict entered. . . . Whether a new trial should be ordered or a judgment directed for the defendant should be decided by the judge who conducted the trial."

See also to like effect:

Garman v. *Metropolitan Life Insurance Co.* 175 F.2d 24, 28 (CA-3)

Marsh v. *Illinois Central R. Co.* 175 F.2d 498, 500 (CA-5)

It is submitted, therefore, that the Court of Appeals in the case at bar was without authority to direct entry of judgment for respondent (appellant), as distinguished from ordering a new trial, in view of the fact that the Gullborg patent upon which the Court of Appeals based its reversal was not made the subject of a motion for judgment notwithstanding the verdict. Clearly, under these facts, the action of the Court of Appeals constituted an improper re-examination of a fact tried by the jury in violation of the *Seventh Amendment to the Constitution* and also constituted a deprivation of plaintiff's property without due process of law in violation of the *Fifth Amendment to the Constitution.*

Argument—Point 5

(Involving Question 10 and Reason 5 of the Petition)

The Court of Appeals' decision in the case at bar, misconstrues and is in conflict with this Court's decisions in the *Bassick v. Hollingshead, Rogers* v. *Alemite* and *Lincoln v. Stewart-Warner* cases, supra, and such decision of the Court of Appeals is, on this point, also in conflict with this Court's decision in *Williams Manufacturing Co.* v. *United Shoe Machinery Co.*, 316 U.S. 364, 370, wherein this Court pointed out that the *Bassick, Rogers & Lincoln* cases did not apply to claims which were limited to a unitary device or to a unitary machine or mechanism, per se.

In the case at bar, the Court of Appeals said the following in respect to the Gullborg patent:

> "The patent which revolutionized the method of greasing the bearings of automobiles was the Gullborg patent No. 1,307,734, issued in 1919, for a combination consisting of a pin fitting, a grease pump or grease gun, a hose to connect the two, and a bayonet type of coupler for manually connecting the hose to the pin fitting." (176 F.2d 446 and VIII R 2239)

In *Bassick* v. *Hollingshead* and in *Rogers* v. *Alemite*, 298 U.S. 415, this Court held the contrary, however, namely, that this "*method*[1] of greasing the bearings of automobiles" was *old long before Gullborg;*—this Court saying:

> "*Before the date of Gullborg's invention,* grease cups were used for bearing lubrication. The cup was connected with the bearing by a tube and oil or grease was forced through the tube into the bearing by screwing down a cap or plunger which was part of the cut. *It became common*[2] *to substitute, in place of the grease cup, a tubular fitting and to force grease through the fitting by means of a 'gun' consisting of a compression chamber and an attached hose, the latter coupled to the fitting by a screw thread or bayonet coupling.* In the case of the bayonet coupler the fitting had lugs or pins[2] and the couplet device had slots[2] which engaged such lugs or pins to form a tight union. The grease would then be forced from the chamber of the gun into the bearing by the use of a plunger or pump. In some of the prior art appliances the aperture of the fitting was kept closed when greasing was not being done by a ball or capsule held against the opening of the fitting by a spring. This

[1] in which Gullborg made but a minor coupler improvement and but a minor grease-cup improvement

[2] This has reference, inter alia, to the British patent No. 21,893, issued in 1906 to Stephen E. Alley et al, which was before this Court in the above-cited cases and which is Plaintiff's Exhibit 187 in the case at bar (IV R 1657-1661) and to Plaintiff's physical Exhibits 188, 189 and 190, at bar, which were also before this Court in *Bassick* v. *Hollingshead*, supra.

closure is opened, during the greasing operation, by the pressure of the grease." (298 U.S. 416-7).

The Gullborg patent 1,307,734, therefore, did *not* revolutionize the method of greasing the bearings of automobiles as the 8th Circuit erroneously concluded in the absence of evidence bearing on this point (because this Gullborg patent was never relied on by defendant).

Indeed, both in *Bassick* v. *Hollingshead* and in *Rogers* v. *Alemite*, supra, the defendants' theretofore marketed accused devices were grease-guns with bayonet type couplers and bayonet type grease-cups or so-called "pin-fittings", *none* of which contained either of Gullborg's coupler improvement or Gullborg's grease-cup or "pin-fitting" improvement. Indeed, the vast majority of all of the hundreds of injunctions theretofore obtained by Stewart-Warner Corporation and Alemite Corporation and Bassick Mfg. Co., under this Gullborg patent, were leveled at grease-guns and bayonet type couplers and/or "pin-fittings" which did *not* contain Gullborg's coupler improvement nor Gullborg's grease-cup or "pin-fitting" improvement.

Hence, from a *true* commercial standpoint, Gullborg's improvements in grease-cup (or "nipple") and coupler, respectively, were entirely insignificant.

The sole significance of the Gullborg patent was that erroneously given to it by certain decisions of the courts† (and by the hundreds of competition-eliminating consent decrees induced thereby) prior to the Supreme Court's decision in *Bassick* v. *Hollingshead* and in *Rogers* v. *Alemite*, supra, and that given to it by Alemite's and Stewart-Warner's competition-eliminating* jobber-agreements of

† see footnotes at *298 U.S.416*

* see the *Department of Justice's* official release of June 23, 1949 relative to the case of *United States* v. *Mager & Gougelman, Inc.* filed on that day (*Trade Regulation Reporter* of Commerce Clearing House, Inc., Case No. 61,216 on pages 61073-4 of the July 7, 1949 issue) wherein the Assistant Attorney General in charge of the Anti-Trust Division, referring to the effect (upon competition) of unwarranted patent-infringement suits and false claims of patent rights, said:

"This is another example of how certain companies and individuals have used the patent rights and license agreements as a basis for restraining trade and commerce in violation of the anti-trust laws. Such violations . . . generally result in eliminating competitors . . ."

Plaintiff's Exhibit 502 (VII R 2197), and by Stewart-Warner's, Alemite's and respondent's gross misuse of this patent and abuse of judicial process†;—all of which petitioner would have proven by documentary evidence if respondent had relied on the Gullborg patent and upon its *status in the art* as assumed by the Court of Appeals.

In the case at bar the Court of Appeals further said:

"What the Johnsons did—as we can see it—was to substitute for the bayonet type of connecting means of Gullborg, which was old, a chuck type of connecting means, also *old*".

"Substituting an *old and well known* form of coupler for another form of coupler equally well known, did not, in our opinion, require invention, but merely mechanical skill".

"To use means *old* in the art to clamp a grease nozzle to a grease fitting so as to form a tight connection, does not involve patentable invention" (176 F.2d 448 and VIII R 2244).

". . . it is our opinion that the evidence . . . does not sustain the conclusion that the Johnsons' contribution to the art of lubrication rose to the level of patentable invention" (176 F.2d 448 and VIII R 2244-5).

By its above-quoted statements the Court apparently meant that chuck type couplers, as a class, were *(generically)* old, namely, that there were a number of other prior "chuck" type couplers shown in prior patents (though such prior "chuck" type couplers were not of the specific construction or did not contain the specific mechanism of the Johnson coupler as defined by the claims of the patent in suit).

The above-quoted statements of the Court indicate that the Court was either under a misapprehension as to what the claims of the Johnson patent really cover* or

† see footnote on page 15 hereof

* i.e. whether they cover the coupler construction *per se*, or whether they cover the "combination" of a coupler, pump and grease-cup

misinterpreted this Court's decisions in the *Bassick, Rogers* and *Lincoln* cases. Only upon the erroneous assumption that the claims of the Johnson patent in suit claim a "combination" of (a) a grease-gun, (b) a grease-cup and (c) a grease-coupler to connect the two, could either the Gullborg patent or *Bassick* v. *Hollingshead; Rogers* v. *Alemite* or *Lincoln* v. *Stewart-Warner,* have *any* proper relevance to the case at bar;—except for that Court's misinterpretation of these decisions hereinafter shown.

However (unlike the Gullborg patent) the claims of the Johnson patent in suit claim *only* a coupler alone, and only a specific construction or mechanism in a coupler.

If the above-quoted statements of the Court of Appeals and its reliance upon *Bassick* v. *Hollingshead, Rogers* v. *Alemite* and *Lincoln* v. *Stewart-Warner,* supra, indicate that the Court was holding the Johnson patent in suit invalid as drawn to an "exhausted combination" between (a) a grease-gun, (b) a grease-nipple and (c) a grease-coupler†, then it is pointed out that such a defense was *never* pleaded by the defendant in the case at bar,* and is clearly inapplicable to the case at bar, and *petitioner has not had its day in court on such defense.*

In referring to this Court's decision in the *Lincoln* v. *Stewart-Warner* case, the Court of Appeals in the case at bar said:

> "As the Supreme Court . . . stated, chucks are old and unpatentable as such" (176 F.2d 448)

Far from holding that "chucks are old and unpatentable, as such", this Court held, *on the contrary,* that chucks, *as such,* may be patentable;—this Court saying:

> "The invention, if any, which Butler made, was an improvement in such a chuck in the respect that the

† Petitioner asked for a clarification of the Court's opinion (VIII R 2247, 2285)

* either in its Answer or by Notice under 35 U.S.C. 69 (as was required by 35 U.S.C. 69, if such defense was to be available)

multiple jaws of his devide are closed over the nipple by the pressure of the grease, but we think he did no more than this" (303 U.S. 549).

It was only the "*combination*" of (a) grease-gun[1] (b) grease-nipple[1] and (c) grease-coupler,[2] which this Court held to be old and unpatentable "*as such*":

> ". . . the *combination* of elements disclosed[3] is old in the art. As the Circuit Court of Appeals held, a headed nipple or fitting connected with the hearing, and to be coupled to the conduit from the grease-gun, is old and unpatentable. A compressor or pump for propelling lubricant is old and unpatentable *as such.*" (303 U.S. 549).

Of course, there were *other* multi-jawed "chucks" in the art prior to Butler, as recognized by the Court of Appeals for the 8th Circuit in *Stewart-Warner* v. *Jiffy*, 81 F.2d 786 and as recognized by this Court in *Lincoln* v. *Stewart-Warner* (303 U.S. 545, 549) in which this Court said:

> "It is not denied that multi-jawed chucks had been used in industry as couplers in lubricating apparatus."

However, this is nothing more than a recognition that there are many prior patents showing as many specifically *different* kinds of construction in multi-jawed chucks or "chuck" type couplers;—many of such prior patents owned by Stewart-Warner Corporation though *never used* it.

It is *solely* because Butler included the admittedly old (and generically-defined) grease-gun and the admittedly old (and generically-defined) grease-nipple in the claimed "combination" (along with the specifically-defined Butler-

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[1] included in the *claim* in all-inclusive generic language

[2] included in the claim in specific language defining Butler's specific coupler improvement

[3] i.e., the *combination* of a grease-gun, a grease-nipple and a coupler

improved "chuck" or "coupling member") that this Court held the Butler patent invalid (and *not* because of any lack of patentability in the "chuck" or coupler, *as such*). Thus, this Court then went on to point out:

> ". . . (Butler) having hit upon this improvement[1] he did not patent it[1] *as such* but attempted to claim it[1] in *combination* with other old elements[2] which performed no new function in his claimed combination. The patent is therefore void as claiming more[2] than the applicant invented. The mere aggregation of a number of old parts[2] or elements[2] which, in aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them is not patentable invention. And the improvement of one part[1] of an old combination gives no right to claim that improvement[1] in combination with the other old parts[2] which perform no new function in the combination" (303 U.S. 549).

The Stewart-Warner Corporation, itself, so interpreted this Court's decision in *Lincoln* v. *Stewart-Warner, supra,* as shown by its application (PX-99 at IV R 1471-1493) for the reissuance of its Butler patent 1,593,791, filed in the U. S. Patent Office immediately after this Court's decision in *Lincoln* v. *Stewart-Warner.* Thus, the reason there given for seeking the reissuance of the Butler patent was that:

> ". . . the United States Supreme Court in *Lincoln Engineering Company of Illinois* v. *Stewart-Warner Corporation, decided* March 28, 1938 . . . took the view that the claims of the original patent were too broad, since they included the nipple and compres-

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[1] i.e. the improvement in the internal mechanism in or construction of the multi-jawed chuck type coupler

[2] namely the old grease-gun and the old grease-nipple which were included in Butler's claims in broad and all-inclusive language which comprehended *all* grease-gun or *all* grease-nipples irrespective of their internal construction or internal mechanism

> sor elements, and . . . indicated that the claims should be limited to the coupler which included all of applicant's (Butler's) novel structure. Promptly following this decision of the Supreme Court, the preparation of the present reissue application was started for the purpose of limiting the claims to the coupler so that the claims would coincide with the view of the Supreme Court'' (IV R 1479).

The Commissioner of Patents (and the Patent Examiner under him) also accepted the above interpretation of this Court's decision in *Lincoln* v. *Stewart-Warner* and again deemed (IV R 1483) Butler's self-same multi-jawed ''chuck'' type coupler patentable over all the prior-art ''chucks'' but with the grease-gun and the grease-nipple deleted from the claims, and with the claims limited to Butler's coupler or ''chuck'', *as such,* and, accordingly, the Commissioner of Patents granted to Stewart-Warner Corporation the Butler reissue patent Re. 20,852 on September 13, 1938 (PX 99-A at IV R 1495-1501) based on precisely the same disclosure as contained in the original Butler patent and based on the same tow claims as contained in the original Butler patent 1,593,791, but with the claims this time limited to the coupler or ''chuck'' *per se* (PX-99 at IV R 1500-1).

Counsel for defendant-respondent were of the same view. On pages 25 and 26 of their *Brief for Defendant-Appellant* filed in the Court of Appeals on March 9, 1949 on Appeal 13,835, they said:

> ''The decree affirmed by the Court of Appeals of the Seventh Circuit in this Lincoln decision was subsequently reversed in *Lincoln Engineering* v. *Stewart-Warner Corp.,* 303 U.S. 545, on the ground that the claim of the Butler patent was invalid in that it included certain cooperating elements, the grease gun etc., which formed no part of the coupler which Butler had invented . . .''

The Johnson patent 2,040,177, here in suit, claims *only* the specific coupler, as such, and all the claims of the Johnson patent define the mechanism and construction of Johnson's coupler, *as such.* The claims of the Johnson patent here in suit do *not* include either the grease-gun (or compressor) or the grease-nipple (or "fitting") as an element of the *claimed* invention;—the inclusion of the compressor and fitting being the *sole* ground of invalidity in *Lincoln* v. *Stewart-Warner,* 303 U.S. 545.

In its Opinion the Court of Appeals also said:

> "As . . . this Court . . . stated, chucks are old and unpatentable as such." (176 F.2d 448)

However, a reference to that Court's decision in *Stewart-Warner* v. *Jiffy* (81 F.2d 786) shows that in that earlier case it did *not* hold that chucks are unpatentable as such.

On the contrary, that Court, after reviewing the many prior patents on earlier multi-jawed chucks (including fluid-pressure-operated chucks), held that Butler's multi-jawed chuck type coupler was patentable over *all the many prior patents on manually and fluid-pressure operated multi-jawed chucks* (including, of course, the oldest form of chuck, namely in the carpenter's brace, of which that Court as well as all other Courts must, no doubt, have had knowledge).

Thus, after an extensive and *detailed* consideration and analysis of a number of *many* prior-art patents on multi-jawed fluid-pressure-operated chucks (81 F.2d 790-791), the 8th Circuit held that, as a matter of fact,

> ". . . *invention would be necessary* . . ."

to produce Butler's multi-jawed chuck type coupler, *notwithstanding the teachings of the prior art;*—that Court further saying:

> "We think that when we allow to the Butler patent such presumption of validity as its issuance by the

Patent Office would entitle it to (citing authority), even though neither Lavoie[1] nor Newton[2] were there cited against it (citing authorities), that the defense of anticipation for want of novelty was not sustained" (81 F.2d 791).

The District Court in Illinois, in *Stewart-Warner Corp.* v. *Lincoln Engineering Company of Illinois* (15 F.Supp. 578) made the same fact-finding, which the U. S. Court of Appeals for the 7th Circuit in *Lincoln Engineering Company of Illinois* v. *Stewart-Warner Corp.* (91 F.2d 757) sustained, namely that Butler's multi-jawed chuck type coupler *was inventive* over all the *many* chucks and chuck type couplers of the prior-art;—these two Courts disagreeing with 8th Circuit's decision in *Stewart-Warner* v. *Jiffy* (81 F.2d 786) *only* as to the *scope* of the coupler-defining portion of Butler's claim-language, namely, whether the coupler-defining portion of Butler's claim-language did or did not comprehend Stewart-Warner's "Alemite" branded hydraulic coupler construction and (in *Stewart-Warner* v. *Jiffy*, 81 F.2d 786) whether the coupler-defining portion of Butler's claim-language did or did not also comprehend the Johnsons' "Jiffy" branded chuck type hydraulic coupler.

The reversal of the 7th Circuit's decision, by this Court, in *Lincoln* v. *Stewart Warner* (303 U.S. 545) did *not* in any way disturb the fact-finding of the lower courts (nor the 8th Circuit's affirmance of the trial court's fact-finding in *Stewart-Warner* v. *Jiffy* 81 F.2d 786) that it *did* require invention to bring into being Butler's multi-jawed chuck type coupler of the coupler-defining portion of Butler's claim-language, notwithstanding all the many prior-art patents showing as many *different* fluid-pressure-operated multi-jawed chucks and chuck type couplers and connectors.

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[1] Lavoie patent 1,236,453 (DX-117 at VR 2010 to 2016)and Lavoie patent 1,295,994 (DX-119 at VR 2022 to 2025)

[2] Newton patent 1,118,876 (DX-126 at VR 2049 to 2053)

What this Court[1] and the 8th Circuit[2] stated was that while couplers[3] and multi-jawed chucks[4] were broadly old (i. e. as a class of devices), in that there were many prior patents showing as many *different* constructions in such couplers and chucks, yet a new and different coupler or chuck was, nevertheless, patentable over the old couplers or chucks of the prior-art if differing therefrom in internal mechanism or construction and if such differences in mechanism or construction required, *as a matter of fact*, the exercise of the inventive faculty.

As the specific internal mechanism or construction of Johnsons' coupler, as defined in the claims of the Johnson patent here in suit, is admittedly *not* anticipated by any coupler or chuck of the prior-art, but *differs* from such prior-art couplers or chucks, in respect to its internal construction or mechanism, there was inherent in this suit, the *fact-question* whether the differences between Johnson's coupler-construction or coupler-mechanism, on the one hand, and the constructions of the prior-art couplers and chucks, on the other hand, involved invention or whether it required the exercise of the inventive faculty to bring into being the Johnson coupler-construction defined by the claims of the patent here in suit. That *fact-question* was clearly a matter for the jury, and the fact-finding inherent in the jury's verdict is that it *did* involve invention. Thereafter the trial judge expressly concurred in this fact-finding implied in the jury's verdict.

Indeed, the margin of difference between the internal construction of Gullborg's bayonet coupler and the prior Barcus coupler*, on the basis of which such bayonet coup-

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[1] in *Rogers* v. *Alemite* and in *Bassick* v. *Hollingshead*, 298 U.S. 415 and in *Lincoln* v. *Stewart-Warner*, 303 U.S. 545

[2] in *Stewart-Warner* v. *Jiffy*, 81 F.2d 786

[3] as, for instance, the bayonet coupler of Gullborg patent 1,307,734 in *Bassick* v. *Hollingshead* and in *Rogers* v. *Alemite*, 298 U.S. 415

[4] as in *Lincoln* v. *Stewart-Warner*, 303 U.S. 545 and in *Stewart-Warner* v. *Jiffy*, 81 F.2d 786

* Barcus patent 1,117,762 (PX-183 at IV R 1654-6) and the *specimens* of Barcus' bayonet coupler and bayonet "nipple" (PXs 184 & 185) were before this Court in *Bassick* v. *Hollingshead*, supra, and the Barcus patent was before the Court in *Lyman et al* v. *Bassick* 18 F.2d 29.

ler, defined in the coupler-defining portions of the claim-language of Gullborg's claims 1, 2, 3, 4, 7 & 8 (IV R 1549-1550) was held patentable in *Lyman et al* v. *Bassick* 18 F.2d 29 (CCA 6), was *much smaller* than the margin of difference between the chuck type hydraulic coupler to which the claims of Johnson patent in suit are expressly limited and the prior-art couplers of record in the case at bar, as will be seen by comparing the spring-urged cup-shaped sealing washer 26 of Gullborg's *bayonet coupler* of patent 1,307,734 (PX-141 at IV R 15456-8) with the spring-urged cup-shaped washer 10 of Barcus' earlier *bayonet-coupler* patent 1,117,762 (PX 183 at IV R 1654-6).

In *Williams Mfg. Co. v. United Shoe Machinery Corp.* 316 U.S. 364 (86 L.Ed 1537) this Court held that the decisions in the *Bassick, Rogers* and *Lincoln* cases, supra, were not applicable to a suit where the claims of the patent in suit are limited to a unitary machine, device or mechanism.

To the same effect is *Glade* v. *Walgreen* 122 F.2d 306, 308-9 (CCA-7) certiorari denied 314 U.S. 692, and *Kellett Autogiro Corp.* v. *Brohan* 24 F.Supp. 81 (DC NJ).

The most recent decision interpreting the *Bassick, Rogers* and *Lincoln* cases, supra, is the case of *Farval Corp.* v. *Republic Steel Corp.* 82 F. Supp. 31 which was affirmed by the Court of Appeals for the 6th Circuit on December 16, 1949 (F.2d), and is particularly relevant because the patent there in suit related to the art of lubrication and involved mechanisms for supplying grease or other lubricants to the bearings of machinery and included pumps and valves and other grease-delivery mechanisms. In that case both Courts rejected the same interpretation of this Court's decision in the *Bassick, Rogers* and *Lincoln* cases as was erroneously adopted by the Court of Appeals in the case at bar. Hence the decision of the Court of Appeals in the case at bar is also in conflict with the decision in *Farval* v. *Republic,* supra.

Argument—Point 6

(Involving Question 11 and Reason 6 of the Petition)

The Court of Appeals, in the case at bar, recognized that its own fact-findings* in the earlier equity suit between the same parties, involving the same subject matter, were favorable to the validity of petitioner's Johnson patent here in suit on the sole question of invention upon which that Court invalidated said patent in the case at bar,

> ". . . *this Court* distinguished the Jiffy hydraulic coupler, the accused device in that case, from the device of Butler, and *was of the view that the Alemite hydraulic coupler, made by the Stewart-Warner Corporation, did not conform to the Butler* patent, . . ." (176 F.2d 447),
>
> "Implications favorable to the plaintiff might, perhaps, be drawn from some of the statements of this Court in *Stewart-Warner Corporation* v. *Jiffy Lubricator Co.,* supra, 81 F.2d 786" (176 F. 2d 448),

but concluded that those same fact-findings (in such earlier equity suit) are now no longer available to support the validity of petitioner's patent here in suit, because such fact-finding (in the earlier suit) must *now* be viewed

> "in the light of the more recent decisions of the Supreme Court raising the standards of originality necessary to sustain a patent . . . the present attitude of the Supreme Court toward claimed patentable improvements may be gathered from Cuno Engineering Corp. *v.* Automatic Devices Corp. 314 U.S. 84, and the more recent cases of Jungersen *v.* Ostby & Barton Co. 335 U.S. 560, and Mandel Brothers, Inc. *v.* Wallace 335 U.S. 291" (176 F.2d 449).

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*see footnotes 4 to 19 on pages 5 to 8 of the Petition.

We respectfully submit that the decision of the Court of Appeals for the 8th Circuit misconstrues and is in conflict with this Court's above-identified decisions.

In the *Cuno Engineering Corp.* case, this Court reversed the Court of Appeals and sustained the District Court's fact-finding of non-invention in harmony with this Court's rule that the fact-findings of the trial court should not be disturbed on appeal unless there is manifest error of the clearest kind in such fact-findings.

We respectfully suggest that this Court's decision in the *Cuno Engineering* case or in the other cases above cited were not intended and should not now be permitted to stand as authority for a Court of Appeals to set aside the jury's fact-finding of invention concurred in by the trial judge—on the basis of a "prior-art" patent and authorities *never* relied upon by defendant either in the trial Court or in the Court of Appeals, especially where the jury's fact-finding of invention is entirely consistent with and well supported by that same appellate Court's earlier fact-findings in an earlier suit equity between the same parties involving the same subject matter and where such earlier fact-findings are *res judicata* in the case at bar and were so pleaded and where the jury was (at defendant's request) expressly instructed, inter alia, in the language of this Court's decision in the *Cuno Engineering* case.

The Court of Appeals' erroneous interpretation and extreme misapplication of this Court's decision in the *Cuno Engineering* case deprives the fact-findings of a jury and of a trial judge of all meaning, and in the case tried to a jury, is, in effect, a deprivation of the right of trial by jury.

Conclusion

Petitioner therefore respectfully submits that for each of the reasons set out in the Petition, this case is one in which a writ of certiorari should be granted.

Respectfully submitted,

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(i.e. the prior-issuance of Butler patent)
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(i.e. the prior-issuance of Gullborg patent)
is irrelevant and was not pleaded as a defense, was never relied on by respondent either in the trial court or in the appellate court, was not the basis of any request for instructions nor the basis of any motion in the District Court nor the basis of any assignments of error or statement of points relied on in the Court of Appeals 9

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Petitioner's Reply Brief

Foreword:

While many of the erroneous statements and propositions contained in respondent's brief are, in petitioner's view, irrelevant and may be disregarded by this Court, yet in order that the Court may have available petitioner's reply to every point raised in respondent's brief, the following brief contains a reply to every point apparent in respondent's brief, and the foregoing explanatory *Index of Subject Matter* will enable the Court to select and refer at will to only so much of this reply brief as it may deem advisable, without necessarily examining the whole.

Respondent's brief evades the issues and the questions presented by the Petition, erroneously misrepresents the record, petitioner's position at bar, and the Court's earlier decision in *Stewart-Warner* vs. *Jiffy* 81 F.2d 786 (CCA-8).

Respondent's brief does however confirm the fact that, insofar as it relies on the Gullborg patent 1,307,734, the appellate Court's decision is bottomed on a defense *not* pleaded or tried and *not* made a ground of either a motion for directed verdict under Rule 50-a or of a motion for judgment n. o. v. under Rule 50-b.

Insofar as it relies on Butler patent 1,593,791 or upon the "prior-art" which that Court had before it in the earlier case of *Stewart-Warner* vs. *Jiffy*, supra, and in the case at bar[1], the appellate decision (as to which certiorari is sought) also presents an *intracircuit conflict*[2] with its own earlier decision in *Stewart-Warner* vs. *Jiffy*, supra (page 22, infra).

Respondent's brief also shows that the appellate *opinion* at bar would establish two *novel*, far-reaching and erroneous propositions or principles of patent law

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[1] see Chart of prior-art in both suits, on page 29 of Petition at bar

[2] *Dickinson* vs. *Petroleum Conversion Corp.*——U.S.——(94 L.Ed. 280).

for which there is neither statutory foundation nor any precedent in *any* reported decision (see pages 18 & 19, *infra*).

Respondent misrepresents petitioner's position at bar

On pages 1 & 2 and 17 to 21, inclusive, of its Brief, respondent erroneously and misleadingly suggests that the Petition is an attack upon the appellate Court's powers under 28 U.S.C. 2106, *per se* (see page 7, infra.)

On the contrary, the Petition is not at all based upon (and does not make) any attack on appellate court's powers under 28 U.S.C. 2106, *per se.*

A summary of the *Questions Involved* is set out on *page iii,* and a summary of the *Reasons* relied upon for the allowance of the writ is set out on *page iv* of the Index of Subject Matter of the Petition;—these *Questions* and *Reasons* being more fully stated in the Petition, and none of them are either based upon or involve an attack upon the appellate court's powers under 28 U.S.C. 2106, *per se.*

Respondent misrepresents decision in Stewart-Warner vs. Jiffy (81 F.2d 786)

Respondent erroneously misrepresents the Court's earlier decision in *Stewart-Warner* vs. *Jiffy,* supra, as having held Butler's coupler *not* inventive over the prior-art:

> "In deciding the case of *Stewart-Warner* vs. *Jiffy,* the Court of Appeals was concerned with the validity . . . of the claims of Butler patent No. 1,593,791 . . . The Court of Appeals for the Eighth Circuit in *Stewart-Warner* vs. *Jiffy* (81 F.2d 786) *held that such a coupler lacked invention over the prior art* . . ." (respondent's Brief, pp. 28 & 29)

On the contrary, however, the 8th Circuit held the Butler coupler *inventive* over the prior-art:

"We think that when we allow to the Butler patent such presumption of validity as its issuance by the Patent Office would entitle it to (citing cases), even though neither Lavoie nor Newton were there cited against it (citing cases), that the defense of anticipation for want of novelty was *not* sustained." (81 F.2d 791)

"The differences between the sealing and clamping mechanisms revealed by the Newton patent and the gripping and end-sealing of the plaintiff's model coupler are so substantial that the teaching of the Newton patent *would not enable a mechanic, skilled in the art, to make such a coupler* for lubricating apparatus, *but invention would be necessary.*" (81 F.2d 791)

On the same page (29) of its brief respondent further misrepresents the Court's earlier decision in *Stewart-Warner* vs. *Jiffy,* supra, by saying that the coupler of the aforesaid Butler patent 1,593,791 is "the same chuck which the Johnson patent seeks to cover".

However, in its earlier decision the 8th Circuit expressly stated that the "Jiffy" hydraulic coupler (which is the subject matter of the Johnson patent here in suit) is *vitally* different from the "chuck" type coupler of the Butler patent:

". . . the difference between the Butler patent and the Jiffy coupler (is) *substantial,* in that the mechanical or engineering principle . . . (of) the Butler patent . . . is different from that relied upon in the Jiffy structure . . . (81 F.2d 793)

The decision of the District Court, which was affirmed by the Court of Appeals in *Stewart-Warner* vs. *Jiffy* (81 F.2d 786), held that

> "The Johnson patent does not include spring fingers, and the mechanism is not, in my judgment, the equivalent of the Butler patent, and I shall so hold[1]."

and

> "That locking members consisting of jaws or chuck members actuated longitudinally by the body of a movable core or piston, without the interposition of spring fingers and which are moved radially and produce locking action upon a nipple by being propelled by such piston body or core through or into a restricted opening in the end of a coupler cylinder (i. e. *the 'Jiffy' hydraulic coupler*) are not mechanical equivalents of such (i.e. Butler's) specific means, but (the 'Jiffy' coupler is) *a different invention*[2]."

The Court of Appeals concluded its earlier decision in *Stewart-Warner* vs. *Jiffy* by saying that, in its opinion, "the findings and conclusions of the trial court are sustained by the evidence" (81 F.2d 794).

Therefore, the Butler coupler is clearly *not* "the same chuck which the Johnson patent seeks to cover", as erroneously and misleadingly stated by respondent.

In its decision as to which certiorari is sought, the Court of Appeals again recognized that the coupler of the Butler patent 1,593,791 is *not* "the same chuck which the Johnson patent seeks to cover" by saying:

> ". . . this Court distinguished the Jiffy hydraulic coupler, the accused device in that case, from the device of Butler, and was of the view that the Alemite hydraulic coupler, made by the Stewart-Warner Corporation, did not conform to the Butler patent" (176 F.2d 447).

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[1] the District Court's Opinion on page 34 of Volume 1 of the printed Transcript of Record in the case of *Stewart-Warner* v. *Jiffy* 81 F.2d 786; CCA-8; and 299 U.S. 554; No. 114 of the October Term, 1936 of this Court

[2] District Court's *Conclusions of Law*, on pages 41 & 42 of Volume I of the printed Transcript of Record in the case of *Stewart-Warner* v. *Jiffy* 81 F.2d 786; CCA-8; and 299 U.S. 554; No. 114 of the October Term, 1936 of this Court

Respondent misleadingly injects issue of infringement, whereas there is no such issue in this case, at this stage

On page 5 of its brief respondent misleadingly says that its "Alemite" hydraulic couplers which were found to be infringements of the Johnson patent here in suit

> "are different from the structure shown in the patent in design, construction and mode of operation etc."

However, the Court of Appeals did not disturb the fact-finding of infringement implied in the jury's verdict, and based its reversing decision solely upon the question of validity. Hence there is no justification for injecting the issue of infringement into the case at this time.

Moreover, in its earlier decision the 8th Circuit clearly pointed out that the "Alemite" hydraulic coupler there (and here) in suit is the mechanical equivalent of the "Jiffy" hydraulic coupler there (and here) in suit and forming the subject matter of the patent here in suit:

> ". . . we consider the Jiffy coupler a clear mechanical equivalent of the coupler (i.e. the 'Alemite' coupler) which has been made up by plaintiff (i.e. Stewart-Warner) . . " (81 F.2d 793);—

that Court further finding that the "Alemite" hydraulic coupler was suggested by the efficient structure of the earlier-marketed "Jiffy" hydraulic coupler (which is the subject matter of the patent here in suit):

> ". . . the ('Alemite' coupler is) a departure and different from the real disclosure of the (Butler) patent and . . . not suggested by the teaching of the Butler patent, but more probably, according to the evidence, by the efficient structure of the Jiffy coupler" (81 F.2d 793)

> "Shortly after its organization the *Jiffy* Company put on the market its lubricating apparatus which included

> a *coupler* intended and adapted to connect the coupler to the type of nipple above described by gripping on to the part of the tube of the nipple which extends out beyond the pin. It *combines automatic gripping and sealing of the parts and works effectively."* (81 F.2d 788)
>
> "The plaintiff (*Stewart-Warner*) *has not . . . made or sold any couplers in which the pressure of the lubricant actuated the compression or gripping of the parts upon the bearing nipple* until long after it had received examples of the defendant's so-called Jiffy lubricator" (81 F.2d 788)

Hence, there is no justification for the confusing injection, at this time, of the issue of infringement.

Respondent misrepresents record as to "prior-art"

On page 12 of its brief respondent erroneously and misleadingly says:

> "Claims of the Johnson patent can readily be applied to the prior art."

However, respondent has not attempted to apply any claim of the patent in suit to any prior art.

Indeed, respondent's expert testified that none of the claims of the Johnson patent in suit were readable upon any of the devices or constructions shown in any of the prior art patents or publications or on any of the commercial devices of the prior art (see references to the Record, on this point, on page 18 of the Petition).

Respondent's reference, in footnote on page 7 of its Brief, to the coupler shown in Saxton's abandoned application, and the inclusion of the drawing of this coupler as No. 12 on the Chart accompanying respondent's Brief, is likewise unwarranted because plaintiff's expert testified that this Saxton coupler construction is inoperative (III R 1271/4 to 1272/10) and this was confirmed by respondent's expert (III R 1305/7-31).

Respondent misrepresents Record in repeatedly saying that there are "undisputed" or "uncontroverted" facts conclusively showing non-invention as a matter of law, whereas there are no such "undisputed" or "uncontroverted" facts of record

The respondent's aforesaid misrepresentation of petitioner's position at bar is falsely premised upon the respondent's further misrepresentation that the facts are "undisputed"[1] and "uncontroverted".[2]

Neither the appellate Opinion at bar *nor respondent's Brief* point to or identify *any* specific fact or facts which are both "undisputed" (or "uncontroverted") *and* render the Johnson patent in suit invalid as a matter of law.

The four (4) assertedly "undisputed" or "uncontroverted" facts relied on by respondent do not render patent in suit invalid as a matter of law

The only facts relied on either in the appellate Opinion at bar or in respondent's Brief as being assertedly "undisputed", are the following:

1) the fact of the prior issuance and existence of Butler patent 1,593,791,

2) the fact of the prior issuance and existence of Gullborg patent 1,307,734,

3) that the Johnson brothers brought into being their "Jiffy" hydraulic coupler (which is the subject-matter of the patent here in suit) in their effort to avoid or escape the unwarranted and ruinous "Alemite litigation" falsely based on the Gullborg patent[3], and

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[1] Respondent's Brief: *page 1,* lines 6 & 8; *page 11,* line 7, *page 12,* lines 9 & 10 and 13, *page 17,* lines 5 & 6 and 9 & 10, *page 20,* line 16, *page 25,* line 20

[2] Respondent's Brief; page 24, lines 20 & 21, page 25, line 20

[3] "the makers of grease guns with bayonet type couplers, as well as those who made pin fittings which could be used in Gullborg's combination, were being sued as contributory infringers of Gullborg patent No. 1,307,734. August Johnson and his brother 'wanted to get a coupler where we would not have to depend on the pin to hold the coupler on the fittings.' What they wanted, 'to get away from' was 'an Alemite [Gullborg] pin connector.' This was 'on account of all our trouble in these inventions of ours, which was on account of the coupler using a fitting that would hook on a pin'." (Opinion at bar: 176 F.2d 446)

4) that a mechanic (Erickson) understood Johnson's *oral* explanation of his hydraulic coupler (before the Johnsons had ever built one) and thought it would work[2].

Mere fact of issuance of prior patent is, in and of itself, not sufficient to make "invention" a question of law

Of course, the *mere* fact of the prior-issuance or prior-existence of a patent does *not*, in and of itself, constitute such an "undisputed" or "uncontroverted" fact as renders a patent-in-suit invalid as a matter of law.

It is *also* necessary that the prior patent shall, *in fact*, disclose the *same* construction or mechanism as is defined by the claims of the patent-in-suit, or that it shall, *in fact*, not have required the exercise of the inventive faculty to bring into being the construction or mechanism defined by the claims of the patent-in-suit in view of the teachings contained in the prior patent.

Respondent's "undisputed" fact No. 1:

(i. e. the prior-issuance of Butler patent)
has been eliminated as a possible basis for a conclusion of "non-invention as a matter of law", by the appellate Court's own earlier decision (81 F.2d 786) as well as by testimony of respondent's own witnesses in the case at bar

The Court of Appeals itself recognized that it had ". . . distinguished the Jiffy hydraulic coupler . . . from the device of Butler . . ." (176 F.2d 447), and in *Stewart-Warner* vs. *Jiffy* (81 F.2d 786) pointed out the *specific* differences and that these differences were *vital* differences*.

[2] It appears that August Johnson told an automobile mechanic in or about 1928 about making something to do away with the old type of connector so that he (Johnson) would not have to use the pin on the Alemite fitting, and that he thought he could make something that would work like a drill chuck, utilizing the force from the grease gun to grip the fitting during the greasing operation. The mechanic understood what Johnson was talking about, and thought it would work." (Opinion at bar: 176 F.2d 446)

* see quotations from the Court of Appeals' *opinion* on pages 3 & 4, supra, and in the footnotes on pages 5 to 8, inclusive, of the Petition at bar

Respondent's witness, Butler, fully confirmed the Court of Appeals' earlier opinion in *Stewart-Warner* vs. *Jiffy*, supra, by testifying in the case at bar that the hydraulic coupler of the patent here in suit is different from the coupler of his patent 1,593,791 and that the points of difference are vital in that they are the points of similarity between the hydraulic coupler of the patent here in suit and the herein-accused "Alemite" hydraulic coupler and account for the practicability and commercial success of the "Alemite" hydraulic coupler[2].

In view of the foregoing, and in view of the fact that respondent hailed the "Alemite" hydraulic coupler found to infringe the patent here in suit as *"one of the most important developments in automotive lubrication" in a decade* (PX-45 at IV R 1403), it can hardly be said that "non-invention" over Butler has been so proven by respondent that it is "undisputed" or "uncontroverted", or so as to make non-invention "a matter of law".

Respondent's "undisputed" fact No. 2:

(i. e. the prior-issuance of Gullborg patent)
is irrelevant and was not pleaded as a defense, was never relied on by respondent either in the trial court or in the appellate court, was not the basis of any request for instructions nor the basis of any motion in the District Court nor the basis of any assignments of error or statement of points relied on in the Court of Appeals

The Gullborg patent was *neither* pleaded in respondent's Answer (I R 26-37) *nor* noticed under 35 U.S.C. 69*, was *not* made the basis of any motion to dismiss under Rule 41-b, was *not* made the basis of any request for instructions under Rule 51 and was *not* made the basis of respondent's motion for directed verdict under Rule 50-a (I R 51-53) *nor* made the basis of respondent's motion for judgment n.o.v. under Rule 50-b (I R 54-57).

[2] see references to Butler's testimony on page 19 of the Petition at bar

* respondent not having given *any* notice under 35 U.S.C. 69

Respondent, recognizing[1] that the appellate decision at bar is squarely bottomed on Gullborg patent 1,307,734 and on this Court's decision in *Bassick* vs. *Hollingshead* (298 U.S. 415) which adjudicated the Gullborg patent (but which decision was likewise *never* relied on by respondent in either of the Courts below), respondent's brief tries to justify the appellate Court's reliance upon the Gullborg patent and upon this Court's aforesaid inapplicable decision, by suggesting some catch-all generalities also included in respondent's motions under Rules 50-a and 50-b (along with specific grounds not here involved). These catch-all generalities, however, are clearly ineffectual under Rule 50.

An examination of respondent's motion for directed verdict (I R 51-53) and of respondent's motion for judgment n.o.v. (I R 54-57) shows that the Gullborg patent was not a basis of either of these motions.

Such a catch-all, general or *non*-specific "ground", as *ground 12* of the motion for directed verdict (which is repeated as *ground 7* of the motion for judgment n.o.v.),

> "That upon all of the evidence it appears that no cause of action has been established as to the issue(s) . . . of validity . . ." (I R 53),

was obviously ineffectual as a ground under Rule 50-a and hence ineffectual as a ground under Rule 50-b because it is not *specific* as expressly required by Rule 50-a[2] as well as by Rule 50-b.

Such catch-all, general or non-specific ground for judgment n.o.v. as that

> "1. The verdict cannot be sustained as there is no substantial evidence on the material issues sufficient to justify or support it." (I R 54)

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[1] Respondent's Brief: page 4, last two paragraphs, and lower half of page 5, and page 14 and pages 26 & 27

[2] Rule 50-a provides, inter alia, that

"A motion for directed verdict shall state the specific grounds therefor."

is likewise ineffectual as a ground of a motion under Rule 50-b[2] because it is a mere catch-all generality and is *not specific.*

Rule 50 and authorities require that grounds of motions under Rule 50 be specific, and catch-all generalities are ineffectual as a basis of motions under Rule 50

That mere *general* grounds or catch-all phrases such as the above-quoted *ground 12* of respondent's motion for directed verdict (and *ground 7* of its motion for judgment n.o.v.) and such as the above-quoted *ground 1* of its motion for judgment n.o.v., are *not* sufficient as a basis for a motion under Rule 50-a or for a motion under Rule 50-b, is well pointed out in *Virginia-Carolina Tie & Wood Co., Inc.* vs. *Dunbar et al,* 106 F.2d 383, 385 (4 Cir.) wherein that Court said:

> "(one of the) question(s) presented by the appeal (is) . . . : 'Did the Court commit error in refusing to direct a verdict for appellant?'
>
> . . . . . .
>
> "(this) question does not properly arise upon the record; for, although *plaintiff's counsel did move for a directed verdict* and excepted to the refusal of the court to grant same, *the record does not show that they stated any grounds of motion, as expressly required by rule 50(a)* of the Rules of Civil Procedure, 28 U.S.C.A. following section 723c. Prior to the adoption of this rule, there was conflict in the decisions of the federal courts as to the necessity for stating the grounds of a motion for directed verdict. New York Life Ins. Co. *v.* Doerksen, 10 Cir. 75 F.2d 96, 100. Rule 50(a) has settled that conflict, however, by providing that 'a motion for a directed verdict shall state the **specific** grounds therefor'. Moore Federal Practice, vol. 3, p. 3107; Simpkins

[2] Rule 50-b provides, inter alia, that a judgment n.o.v. may only be "in accordance with his motion for a directed verdict", i.e. upon the same *specific* grounds which were the basis of the motion for directed verdict

Federal Practice, 3d ed. p. 480. And we think it important that this requirement of the rule be observed, particularly in view of the enlarged powers granted the court with respect to such motions by rule 50(b), as otherwise judgment might be entered on such a motion after the close of the trial and on a ground which could have been met with proof if it had been suggested when the motion was made."

To like effect is each of the following decisions:

Atlantic v. *McDonald* 125 F.2d 849, 850 (4 Cir.):

> "*A sufficient ground for denying the motion is found in the fact that it fails to state 'the specific grounds therefor' as required by rule 50(a).* Virginia-Carolina Tie & Wood Co. *v.* Dunbar, 4 Cir. 106 F.2d 383, 385."

Stilwell v. *Hertz*, 174 F.2d 714, 715 (3 Cir.):

> "Undoubtedly, the defendant had, in the statute of limitations, a good defense to a substantial portion of Roche's claim. Although the applicable statute was pleaded in defendant's answer, it cannot prevail on this appeal (because) defendant failed to include **that** defense as a ground for its motion for directed verdict. . . ."

Louisville & N.R. Co. v. *Botts* 173 F.2d 164, 168 (8 Cir.)

Rothenberg vs. *Rothstein*, 9 F.R.D. 211, 212 (DC ED Pa)

Had the Gullborg patent been relied on by respondent, petitioner would have proved that the Gullborg patent was without any true commercial or technologic significance and that it was solely Alemite's large-scale, nation-wide illegal trade-suppression and subversion and abuse of legal process which gave the Gullborg patent its monopolistic effect and thus its "revolutionary" commercial appearance

If notwithstanding respondent's failure to rely on the Gullborg patent, the appellate Court felt that the

Gullborg patent should nevertheless be considered in any adjudication of the Johnson patent here in suit, the Court should have directed a new trial to give petitioner an opportunity to show what the position of the Gullborg patent was in the development in the art and to show it was not a pioneer patent as the appellate Court erroneously assumed and stated, and to show that its sole significance in the art was its gross misuse, coupled with the large-scale nation-wide abuse and subversion of legal process in its exploitation. This is illustrated by *Appendices A, B, C and D* hereto*.

Appendix A is Alemite Corporation's letter of April 16, 1932, paying $200,000.00 to petitioner in *Adams* vs. *Bassick*, 285 U.S. 531, to withdraw its petition from this Court (286 U.S. 567) involving Gullborg patent 1,307,734, after certiorari had been granted thereon (285 U.S. 531), thereby to insure a final adjudication of the Gullborg patent favorable to Alemite's illegal contentions† and practices.

Appendix B is Alemite Corporation's letter of May 2, 1932 to its 50 or more so-called "distributors", including respondent, showing its recognition of the illegality (1) of its contentions of "contributory infringement" of the Gullborg patent† and (2) of its unprecedented campaign of unwarranted trade-stifling patent-litigation based thereon and (3) of its other *competition-suppressing* practices[2] under the Gullborg patent (through which it

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*These are documents received in evidence on the trial of the Counterclaim in *Stewart-Warner* vs. *Staley* in the U.S. District Court for the Western District of Pennsylvania (Eq. 3342), the sufficiency of which Counterclaim was sustained at 42 F.Supp. 140. Copies are on file in the office of the Clerk of the District Court in the case at bar. U. S. Courts may take judicial notice of the records in any other Court of the United States: *Atlantic Fruit Co.* vs. *Red Cross Line* 5 F.2d 218, 219 (2 Cir.) and *Armstrong* vs. *Alliance Trust Co.* 126 F.2d 164, 167 (5 Cir.) and *Tempel* vs. *U.S.*, 248 U. S. 121, 130

†4 years later condemned by this Court in *Bassick* vs. *Hollingshead* and in *Rogers* vs. *Alemite* (298 U.S. 415)

[2] partly exemplified by its hundreds of *blank* "decree" forms of *Appendix C* and corresponding "settlement agreements" of *Appendix D* and its thousands of all-embracing competition-suppressing patent-agreements with jobbers (PX-502-c, VII R 2197) which were *not* before the Court or jury upon the trial of this case

had stifled competition for 13 years) and (4) that it was paying the $200,000.00 for the express purpose of thereby extending its illegal monopoly for another 4 years, and (5) stating that it had already devised another plan for further monopolizing the lubricating-equipment industry for another 10 or 12 years after the expiration of the Gullborg patent[3].

Appendix C is a specimen of one of the several hundred consent decree forms promulgated by Alemite and to which Alemite had jobbers and wholesalers sign their consent before (and without) any suit ever filed;—with the name of the court left in blank.

Appendix D is a specimen of the "settlement agreements" which accompanied the signing of the consent-decree forms of *Appendix C* by the jobbers, giving Alemite the authority to file suit at any time in any court and upon *any* complaint of its own choosing, and to enter such previously signed blank form of consent-decree in such subsequently filed suit.

It was through devices such as these, and many others of like effect, and the some 10,000 competition-suppressing patent agreements with jobbers exemplified by *Plaintiff's Exhibit 502-c* (VII 2197), coupled with the transaction shown by *Appendix A* and *Appendix B*, that the Gullborg patent was given any commercial significance.

Thus, if the Gullborg patent had been relied upon by respondent, in the District Court, petitioner would have shown that neither Gullborg's specific bayonet coupler

[3] according to the evidence, this plan was (1) to pirate petitioner's "Jiffy" hydraulic coupler (of the Johnson patent here in suit) and (2) to suppress petitioner's sales thereof through further unwarranted, ruinous and competition-suppressing patent-litigation (*Stewart-Warner* vs. *Jiffy*, supra, and *Stewart-Warner* vs. *Wayne Co., Appendix E*, page 14a, infra) and (3) to *falsely* represent to the trade that such immitative "Alemite" branded hydraulic couplers are covered by Butler patent 1,593,791 (which the 8th Circuit held was wholly inapplicable to the "Alemite" hydraulic coupler) and by the Alemite-owned Morris Reissue patent Re. 18,278 (item **2** in *Appendix E*) likewise inapplicable to the "Alemite" hydraulic coupler;—all against the background of the hundreds of all-embracing Alemite *blank* "decree" forms (*Appendix C*) signed by jobbers and the thousands of all-embracing Alemite patent agreements with jobbers (PX-502-c, VII R 2197)

construction nor Gullborg's specific bayonet "pin-fitting" or grease-cup construction were either necessary or desirable for high-pressure lubrication of automobiles or other machinery, and that the Gullborg patent was merely a guise for an illegal monopolistic scheme devised and effectuated by respondent and its privies and that there were on the market *many* other forms of bayonet type coupler and bayonet type grease-cups or "pin fittings" *not* embodying Gullborg's alleged coupler improvement or Gullborg's alleged grease-cup improvement, and that such non-infringing couplers and grease-cups were driven off the market by Alemite's misuse of this patent its large-scale abuse or subversion of legal process.

Gullborg patent 1,307,734, irrelevant, and Bassick vs. Hollingshead, Rogers vs. Alemite and Lincoln vs. Stewart-Warner, inapplicable

The utter irrelevance of Gullborg patent 1,307,734 (relied upon by the appellate Court) perhaps sufficiently appears from the fact that it was never relied upon by respondent either in the District Court or in the Court of Appeals.

The inapplicability of this Court's decisions in *Bassick* vs. *Hollingshead* and in *Rogers* vs. *Alemite* (298 U.S. 415) and in *Lincoln* vs. *Stewart-Warner* (303 U.S. 545) perhaps likewise sufficiently appears from the fact that respondent never relied on any of these decisions either in the District Court or in the Court of Appeals.

The irrelevance of the Gullborg patent and the inapplicability of this Court's above-cited decisions to the Johnson patent here in suit*, is further demonstrated however by the fact, tabulated in *Appendix E* hereto and, in part, shown graphically in *CHART G*, that respondent's privies the Alemite Corporation and its parent cor-

*because unlike the Gullborg patent (and unlike Butler patent adjudicated in *Lincoln* vs. *Stewart-Warner;* 303 U.S. 545), the Johnson patent here in suit does *not* claim any "combination" of pump, grease-cup and coupler;—the Johnson claims being limited to a coupler construction, *per se*

poration, the Stewart-Warner Corporation, have applied for and obtained (or acquired) *many* patents on "chuck" and hydraulic types of couplers long *after* the Gullborg patent and long after this Court's above-cited decisions on the Gullborg and Butler patents and also long after the 8th Circuit's decision in *Stewart-Warner* vs. *Jiffy* (81 F.2d 786; 8 Cir.) on the Butler patent, *and long after petitioner's Johnson patent here in suit.*

Only the first twelve Alemite-owned patents on "chuck" type grease-coupler patents (numbered **1** to **12**, inclusive, in *Appendix E*) are senior to the Johnson patent here in suit, in that they were applied for prior to the filing date of the Johnson patent. The last nine of these first 12 Alemite-owned "chuck" type grease-coupler patents (numbered **3** to **12**, inclusive, in *Appendix E*) were applied for long after the issuance of the Gullborg patent, as shown in *Appendix E.*

The next thirty-four (34) of these Alemite-owned "chuck" type or hydraulic grease-coupler patents (numbered **13** to **46**, inclusive, in *Appendix E*) were not only applied for long after the issuance of the Gullborg patent but also long after the filing (and effective) date of the Johnson patent here in suit, also as shown in *Appendix E,*—the last two of these (numbered **45** & **46**) having been applied for after the decision of this Court in *Bassick* vs. *Hollingshead* and *Lincoln* vs. *Stewart-Warner* and after the 8th Circuit's decision in *Stewart-Warner* vs. *Jiffy* (81 F.2d 786), and indeed after the decision of the 8th Circuit in *Min-A-Max* vs. *Sundholm* (102 F.2d 189) relied on by respondent;—all as shown in *Appendix E.*

The last of these 46 Alemite-owned "chuck" or hydraulic type grease-coupler patents (No. **46** in *Appendix E* and in *Chart G*) was applied for long after the trial of the case at bar and three months after the oral argument in the District Court on respondent's motion for judgment n.o.v.;—and it was after the hearing in the Court

of Appeals in the case at bar that respondent's patent-counsel presented the written arguments which are *Appendix F*, urging the patentability of the last (No. **46**) of these Alemite-owned "chuck" type hydraulic couplers over the much earlier hydraulic couplers of *Barks* and *Sundholm* and over Campbell's own earlier "chuck" type coupler (all shown in *Appendix E* and *CHART G*);—respondent's counsel having taken the *final step requisite to the issuance of this last Alemite-owned hydraulic coupler patent* (No. **46**) *more than a month after the decision of the Court of Appeals in the case at bar.*

This again demonstrates the specious character of respondent's arguments of "non-invention *as a matter of law*", whether based upon the unpleaded and untried Gullborg patent or upon this Court's decisions in the *Bassick, Rogers* and *Lincoln* cases, supra, or upon the appellate Court's earlier decision in *Stewart-Warner* vs. *Jiffy* or upon the appellate Court's decision in *Min-A-Max* vs. *Sundholm*, supra, or based upon any of the other possible grounds apparent or lurking in respondent's brief.

Min-A-Max vs. Sundholm does not establish standard of invention for case at bar, as shown by CHART H

On pages 7 and 15 of its brief respondent relies upon the decision of the Court of Appeals for the Eighth Circuit in *Min-A-Max* vs. *Sundholm*, 102 F.2d 187 (cert. den. 307 U.S. 637) as an indication of a standard of invention to be applied here.

However, respondent, as well as the Court of Appeals in its decision at bar, has completely overlooked the fact that the Boker patent in suit in *Min-A-Max* vs. *Sundholm* was literally and fully anticipated, as shown in *Chart H* hereto annexed, and that the claim thereof was further invalid on the independent ground that it sought to cover the "combination" of the admittedly old grease-cup[1] with

[1] colored blue in *Chart H*

the assertedly new nozzle[2]. Thus not only was Boker's tapered grease-delivery nozzle indistinguishable from the prior-art nozzles (such as that of the earlier Jurad patent), so that there was a total lack of *any* novelty whatever in the nozzle, *per se,* but the "combination" of nozzle and grease-cup was also old as shown in *Chart H,* and this Court had theretofore twice condemned[3] the claiming of a "combination" of an old grease-cup with an assertedly new coupler or grease-delivery nozzle merely upon the basis of the novelty of the coupler or nozzle *per se.*

Respondent's "undisputed" fact No. 3

At the bottom of page 4 of its brief respondent refers to the appellate Court's reliance upon Johnson's (1932) testimony in the Patent Office (4 years before the issuance of the Johnson patent in suit) that the Johnsons invented their "Jiffy" hydraulic coupler in June of 1928 in their efforts to escape the ruinous nation-wide campaign of unwarranted patent-litigation fostered by Alemite on the basis of the wholly illegal contention of "contributory infringement" of the Gullborg patent which this Court later condemned in *Bassick* vs. *Hollingshead* and *Rogers* vs. *Alemite,* supra, (as well as in Lincoln *vs.* Stewart-Warner, 303 U.S. 545).

Respondent apparently relies on this matter as one of the "undisputed" facts relied upon by the Court of Appeals to invalidate the Johnson patent in suit *as a matter of law.*

However, there is neither statutory foundation nor any precedent in any reported decision for what appears a most *novel* proposition of patent law, namely, that a patent in suit is invalid as a matter of law if the inventor made the invention while (or as a result of) fleeing from the ruinously oppressive illegal patent-suits on an inap-

[2] colored yellow in *Chart H*

[3] *Bassick* vs. *Hollingshead* and *Rogers* vs. *Alemite* (298 U.S. 415) and *Lincoln* vs. *Stewart-Warner* (303 U.S. 545)

plicable earlier patent of one who thereafter becomes the infringer of his later patent in suit.

Neither respondent nor the appellate Court has cited or suggested the existence of any authority, in any statute or reported decision, for this *novel* proposition of patent law which must be a basis of the appellate Court's decision at bar if, as suggested by respondent's brief (page 4), the Court relied on this fact as a basis for holding the patent invalid as a matter of law.

Respondent's "undisputed" fact No. 4

On page 15 of its brief, respondent relies upon Johnson's (1932) testimony in the Patent Office (4 years before the issuance of the patent in suit) that when (in 1928) the Johnsons explained their conception of their hydraulic grease-coupler to an automobile mechanic (before they made a physical embodiment of their idea) the mechanic understood their explanation and thought that such a grease-coupler would work.

Respondent relies on this matter as one of the "undisputed" facts relied upon by the Court of Appeals to invalidate the Johnson patent in suit *as a matter of law.*

However, there is no basis in any statute nor in any reported decision for what appears to be another most *novel* proposition of patent law, namely, that if an ordinary mechanic can understand the inventor's explanation of his idea before it is embodied in a physical device, and if it appears to such mechanic that the idea would work, then the patent on such device is invalid as a matter of law.

Neither respondent nor the appellate Court has cited or suggested the existence of any authority, in any statute or reported decision, for this *novel* proposition of patent law which must be a basis of the appellate Court's decision at bar if, as suggested by respondent's brief (page 15), the Court relied on this fact as a basis for holding the patent invalid as a matter of law.

Appellate decision at bar in conflict with decisions of other Circuits as to the correct interpretation of this Court's decision in Cuno Engineering Corp. vs. Automatic Devices Corp. (Falkenberg vs. Bernard Edward Co., 175 F.2d 427; 7 Cir.)

That in its decision at bar, the Court of Appeals may have been lead into error by its misinterpretation of this Court's decision in *Cuno Engineering Corp.* vs. *Automatic Devices Corp.*, 314 U.S. 84*, is also evident from the decision of the Court of Appeals for the 7th Circuit in *Falkenberg* v. *Bernard Edward Co.*, 175 F.2d 427 (certiorari denied Nov. 7, 1949); wherein the 7th Circuit, after reviewing and quoting from the decisions of a number of *other Circuits* interpreting the *Cuno* case on the standard of invention, concluded that this Court's decision in the *Cuno* case did *not* raise the standard of invention.

Here again the decision of the Court of Appeals in the case at bar is probably in conflict with the decisions of the Courts of Appeals of other Circuits[2] which have all uniformly interpreted this Court's decision in the *Cuno* case as *not* raising the standard of invention, whereas the Court of Appeals in the case at bar, held that this Court's decision in the *Cuno* case did raise the standard of invention, even to the point where it felt compelled to repudiate the Findings of Fact and Conclusions of Law in *Stewart-Warner* vs. *Jiffy* (81 F.2d 786) which were favorable to the validity of the patent here in suit. (*Question* 11 & *Reason* 6 of Petition.)

Therefore there is also presented in the Petition a general question of law which is of public interest and should justify the granting of certiorari, namely, the question of the correct interpretation of this Court's

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* see quotation from the appellate Opinion at bar, appearing on page 29 of the Brief in Support of the Petition, under *Argument-Point 6*

[2] *Falkenberg* vs. *Bernard Edward Co.*, supra, and the like decisions of the other Circuits cited in the *Falkenberg* case

decision in the *Cuno* case, namely, whether the correct interpretation is that of the 7th Circuit in the *Falkenberg* vs. *Bernard Edward* case and that of the other Circuits whose decisions are cited therein, or whether the correct interpretation is that of the Court of Appeals in the case at bar and that of the other Circuits cited in its Opinion at bar, and whether this Court's decision in the *Cuno* case has so raised the standard of invention as to have required the Court of Appeals in the case at bar to create the *intracircuit conflict* on fact-findings shown in the Petition (*Dickinson* vs. *Petroleum Conversion Corp.*,——— U.S. ———; 94 L.Ed. 280).

Though differently composed, Court should not repudiate its own earlier fact-findings

A Court of Appeals, though differently composed, should not repudiate its earlier decision. This is pointed out in the recent decision in *Dickinson* vs. *Mulligan,* 173 F.2d 738, 740-1 (2 Cir.):

> "It appears to all three of us in the present court most desirable to repudiate a precedent so established. In a final court of varying composition it might be asking too much that the first decision should become an authoritative precedent against the convictions of the other members . . . we ought to be content, as we are, to sink our differences, and yield to the precedent, whatever our confidence in our conclusion."

In *Dickinson* vs. *Mulligan,* supra, the intracircuit conflict was *not* as to any fact-findings, whereas in the case at bar the intracircuit conflict is as to fact-findings. It therefore follows with greater force in the case at bar that the appellate Court should not have repudiated its own earlier decision nor that of the District Court affirmed thereby, where the jury's verdict sought to be overruled is in harmony with the Court's earlier fact-findings.

Intracircuit conflict, in case at bar, also justifies grant of certiorari

In view of this Court's decision in *Dickinson* vs. *Petroleum Conversion Corp.* (U.S. ; 94 L. Ed. 280) handed down since the filing of the Petition at bar, the intracircuit conflict *in fact-findings* between the decision of the Court of Appeals in the case at bar and the decision of the same Court (differently composed) in the case of *Stewart-Warner* vs. *Jiffy* (81 F.2d 786) is submitted as an additional reason relied upon for the allowance of writ of certiorari.

The Findings of Fact and the Conclusions of Law of both the District Court and the Court of Appeals in *Stewart-Warner* vs. *Jiffy* (81 F.2d 786) support the inventiveness of the "Jiffy" coupler (the subject matter of the patent here in suit) by every criteria of invention universally adopted by courts, as shown by *the 9 points* set out on *pages 5 to 8 of the Petition* and by the quotations in the 15 footnotes thereto.

This is particularly so in view of the testimony of respondent's expert that the coupler of the same Butler patent represented the nearest approximation, in the prior-art, to the "Jiffy" hydraulic coupler of the Johnson patent here in suit (which Butler coupler he admitted was not anticipatory in character but was relied on only on the contention that the Johnson patent did not involve the exercise of the inventive faculty).

Decisions since filing of Petition:

Jury's fact-finding of invention not to be upset on appeal, and jury's fact-finding entitled to greater weight than Judge's fact-finding, and even trial Judge's fact-finding of invention must be affirmed if there is any substantial evidence to sustain it

Since the filing of the Petition at bar, Courts of Appeals of other Circuits have handed down decisions

on a point of law involved in *Questions 1, 2, 3 and 5* set out in the Petition.

Thus, the Court of Appeals for the 9th Circuit held, in *Cutler* vs. *Lyophyl*———F.2d——— (84 USPQ 54, 58, 61):

> "We cannot upset the jury's findings that claims 6, 11, 12 and 13 were each valid unless 'the evidence is such that without weighing the credibility of the witnesses there can be but one reasonable conclusion as to the verdict. . . .' *Brady* v. *Southern Ry.*, 320 U.S. 476, 479-480."

It is respectfully submitted that in reversing the jury's fact-finding of invention, concurred in by the trial judge, the decision of the Court of Appeals in the case at bar is probably in conflict with the 9th Circuit's decision in *Cutter* vs. *Lyophyl* supra.

To like effect is the recent (February 2, 1950) decision of the 2nd Circuit in *Orvis* vs. *Higgins*,———F.2d ——— (13 Fed. Rules Serv. 52a.42, Case 7), wherein it was pointed out that a jury's fact-finding has far greater binding force upon an Appellate Court than the fact-finding of a trial judge alone, because the binding force of the jury's fact-finding is expressly prescribed by the Constitution.

The recent (January 17, 1950) decision of the 6th Circuit in the case of *The Atlantic & Pacific Tea Co.* vs. *Bradley*———F.2d———(84 USPQ 209, 210) holds that even the fact-finding of invention of the trial judge alone must be affirmed if there is any substantial evidence to sustain it.

Respondent's impugning of trial by jury is both unwarranted and irrelevant

There is no justification for respondent's statement on the top of page 8 of its brief that

"Undoubtedly these earlier decisions delineating the narrowing area in which Petitioner had to assert invention induced Petitioner to request a jury."

The error of such reflection upon jury trials is well pointed out by the late Mr. Chief Justice Hughes in *United Gas Public Service Co.* vs. *Texas,* 303 U.S. 123, 140, 141:

". . . we have never held that it is beyond the power of the State to provide for the trial by a jury of questions of fact because they are complicated. *Cases at law triable by a jury in the federal courts often involve* most difficult and complex questions, as for example, in *patent cases* at law presenting issues of validity and infringement. See Tucker *v.* Spalding, 13 Wall. 453, 455; Keyes *v.* Grant, 118 U.S. 25, 36, 37; Royer *v.* Schultz Belting Co. 135 U.S. 319, 325; Coupe *v.* Royer, 155 U.S. 565, 578, 579. Most difficult questions of fact in protracted trials, with much conflicting expert testimony, are not infrequently presented in criminal cases triable by jury. The issue of life or death may be decided in such a case."

Conclusion

Petitioner therefore respectfully submits that its petition at bar involves important questions and general principles of law which are of public interest and justify this Court in granting certiorari.

C. A. Taney, Jr.
Leonard L. Kalish
attorneys for petitioner

Appendix A

Excerpts from Universal's Exhibit No. 355 on the trial of the Counterclaim in *Stewart-Warner Corp.* vs. *Austin L. Staley, Trustee for Universal Lubricating Systems, Inc.*, Equity No. 3342 in the Western District of Pennsylvania (42 F.Supp. 140)

ALEMITE CORPORATION

Chicago, Illinois

Kiddle, Margeson & Hornidge,
511 Fifth Avenue,
New York, N. Y.

April 16, 1932.

Gentlemen:

We are handing you herewith a copy of a License Agreement dated April 16, 1932 between Adams Grease Gun Corporation of New York and Alemite Corporation of Chicago.

In connection with this License Agreement, **we are obligated to pay Two Hundred Thousand Dollars ($200,000.00) in cash to the Adams Grease Gun Corporation immediately*** upon either (1) the effective dismissal of a writ of certiorari‡ now pending in the United States Supreme Court in the suit of Alemite (formerly The Bassick Manufacturing Company) *vs.* Adams Grease Gun Corporation, Equity No. 42-164, in the United States District Court for the Southern District of New York, or (2) **upon the affirmance by the United States Supreme Court of that part of the decision of the United States Circuit Court of Appeals for the Second Circuit† under review on said writ of certiorari,** in the event that the United States Supreme Court reviews the said decision despite the application of the Adams Grease Gun Corporation to dismiss the said writ of certiorari.

Subject to your acceptance of the conditions stated in this letter, we are handing you our certified check to your order for $200,000.00, and we hereby authorize you, im-

* all emphasis and footnotes supplied

† Bassick Mfg. Co. *vs.* Adams Grease Gun Corp. 52 F.2d 36 and 54 F.2d 285

‡ 285 U.S. 531

mediately upon either (1) the effective dismissal of the writ of certiorari† now pending in the United States Supreme Court in the suit of Alemite (formerly The Bassick Manufacturing Company) *vs.* Adams Grease Gun Corporation, Equity No. 42-164, in the United States District Court for the Southern District of New York, or (2) **the affirmance by the United States Supreme Court of that part of the decision of the United States Circuit Court of Appeals for the Second Circuit* under review on said writ of certiorari,** in the event that the United States Supreme Court reviews the said decision despite the application of the Adams Grease Gun Corporation to dismiss the said writ of certiorari, **to pay to the Adams Grease Gun Corporation the sum of $200,000.00. If, on the other hand, the proceedings on the writ of certiorari† are disposed of on the merits in such a way as to constitute a reversal of that part of the decision of the United States Circuit Court of Appeals for the Second Circuit* under review of said writ of certiorari, then you are to repay to us the whole of said sum of $200,000.00.**

. . . . . .

Yours very truly,

ALEMITE CORPORATION
By /s/ J. E. Otis, Jr.

ACCEPTED AND AGREED TO:
KIDDLE, MARGESON & HORNIDGE
By /s/ Henry T. Hornidge

ADAMS GREASE GUN CORPORATION hereby accepts and agrees to the provisions and conditions of this escrow agreement and further agrees that Kiddle, Margeson & Hornidge shall be under no liability for any impairment of the said fund in the event of and as a result of the failure of the above mentioned bank in which the said certified check is or may be deposited.

ADAMS GREASE GUN CORPORATION
By /s/ Daniel G. Adams

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* Bassick *vs.* Adams 52 F.2d 36, and 54 F.2d 285
† 285 U.S. 531

Appendix B

Excerpts from Alemite's letter of May 2, 1932 to all its Distributors (including respondent at bar) explaining Alemite's letter of April 16, 1932 which is Appendix A hereto;—Alemite's below-quoted letter being Universal's Exhibit No. 1434 on the trial of the Counterclaim in *Stewart-Warner Corp.* vs. *Austin L. Staley, Trustee for Universal Lubricating Systems, Inc.*, Equity No. 3342 in the Western District of Pennsylvania (42 F.Supp. 140)

May 2, 1932

Letter No. 367

Sent to all distributors and two foreign distributors

Dear .....

We have been confronted by a rather serious circumstance in connection with the Alemite and Zerk patents. In order that you might be thoroughly familiar with the entire situation, I will endeavor to explain in as few words as possible, the predicament which confronted us.

As you know, we have had a long drawn out legal battle with the Adams Grease Gun Corporation of New York. We finally obtained a very excellent, clear cut decision in our favor from the Second Circuit Court of Appeals* at New York last July.

In the ordinary course of events this would have ended the activities of the Adams Grease Gun Corporation finally. As a general rule a decision from an Appellate Court is final in patent matters as it is only very rarely that the Supreme Court will take a patent case.

We were very much surprised when the Adams Grease Gun Corporation applied to the United States Supreme Court to review the decision of the Second Circuit Court of Appeals*, and much more surprised when the Supreme Court agreed to do so.†

The history of the Supreme Court for the past ten years on patent decisions has been most discouraging from the standpoint of the patentees. Out of the twenty-three cases on patents which have come before them, nineteen have been held invalid. The marked liberal attitude of this court has been the subject of numerous articles recently, many of which you have undoubtedly read, and they seem

* Bassick *vs.* Adams 52 F.2d 36
† 285 U.S. 531

singly and collectively to be set against any corporation's monopoly, even though such a monopoly is legal and held under United States patents.

After due deliberation on our part **and after having talked to** three or four of **the foremost patent attorneys** in the United States, both here and in New York, **we decided** that we should **not permit the Supreme Court to pass on the validity of our patents,** fearing that we would fare in their hands, about the same as other patentees have fared during the past few years. It was therefore decided that we should settle the matter with the Adams Grease Gun Corporation, and in doing so have the Supreme Court dismiss the case. The only way we could accomplish this end was by granting to the Adams Grease Gun Corporation a license under the Alemite patents, which was negotiated and concluded about a week ago.

By doing this we have kept the decision of the Second Circuit Court of Appeals*, which is a very excellent one, **intact, and** in our opinion **it can be enforced against other infringers very satisfactorily.**

. . . . . .

You know that it has always been our desire not to grant any more licenses than were absolutely necessary and it was for this reason that we have taken this opportunity of explaining rather in detail our actions and to assure you that in our opinion we have taken steps which will best protect our interests, which are so closely coupled with yours, for at least four years more, at which time the Gullborg patents expire.

Of course, **we are working on a plan† now,** which I am not at liberty to discuss, **which** if successful, **will** in all probability **extend our patent monopoly for ten or twelve years after the expiration of the Gullborg patent.** The Zerk patents run until 1942 and it is our hope that we can extend our patent situation until that time—at least with some degree of success.

. . . . . .

Yours very truly, J. E. Otis, Jr. Vice President
ALEMITE CORPORATION.

---

* Bassick *vs.* Adams 52 F.2d 36
† See footnote 3 on page 14 of foregoing Reply Brief

Appendix C

Specimen of the *several hundred* Consent Decrees signed by jobbers and wholesalers, with the name of the court and the patent-in-suit left blank or undetermined, which collectively constitute Universal's Exhibits 798, 799 and 800 on the trial of the Counterclaim in *Stewart-Warner Corp.* vs. *Austin L. Staley, Trustee for Universal Lubricating Systems, Inc.*, Equity No. 3342 in the Western District of Pennsylvania (42 F.Supp. 140)

UNITED STATES DISTRICT COURT.

THE BASSICK MANUFACTURING COMPANY,
Plaintiff,

Versus

Defendant.

In Equity No.

DECREE.

THIS CAUSE having come on to be heard on the record and proceedings herein and on the stipulation of the parties that a decree be entered finding title and infringement as charged in the Bill of Complaint, providing for a perpetual injunction against the defendant, and providing for an accounting as prayed in the Bill of Complaint, it is now on motion of solicitors for plaintiff in accordance with said stipulation.

ORDERED, ADJUDGED AND DECREED as follows:

(1) That the plaintiff, The Bassick Manufacturing Company, is possessed of the title in and to the United States Letters Patent enumerated and described in the Bill of Complaint.

(2) That said Letters Patent are good and valid in law.

(3) That defendant has infringed said letters patent and violated the rights of the plaintiff thereunder by using and selling lubricating apparatus embodying the said patented inventions and by using and selling devices designed and intended for use in apparatus embodying said patented inventions.

(4) That a writ of perpetual injunction be issued forthwith against the defendants, its agents, employees, associates and confederates enjoining them from making, using or selling the combinations patented in said Letters Patent and/or any of the parts thereof, or any other devices embodying the inventions described and claimed in said Letters Patent and or adapted to be used in systems or combinations embodying the same, either for original equipment or for replacement under the guise of "repairs" or otherwise, and from offering or advertising so to do and from aiding or abetting or in any way contributing to the infringement of said Letters Patent or either of them.

(5) That plaintiff recover from defendant the damages which it has suffered and the profits which defendant has made by reason of defendant's infringement of said letters patent, and that this cause be referred to a Master of this court to be appointed to take and report an account of such damages and profits, and that the defendant and its agents, clerks and employees are required to attend before said Master from time to time as he shall direct, and to produce before him all such books, papers, vouchers, documents and devices and to submit to such oral examination as he may direct.

(6) That plaintiff recover of defendant its costs and disbursements of this suit to be taxed in the minimum sum of $250.00, and that it have execution therefor against the defendant.

_____

United States District Judge.

The parties hereby appearing in this cause, it is stipulated that the foregoing decree may be entered and the same is hereby approved as to form and substance, and the defendant waives service of the injunction writ in this cause.

(Jobber's name) _____
(By its partner or
Corporate officer)

_____

Pres.

Signed by the said owner, partner or corporate officer of the above named defendant at _____ (City) _____ (State) this _____ day of _____,

Appendix D

Specimen exemplifying the *several hundred* Settlement Agreements which accompanied the signing of the Consent Decree forms of Appendix C, and which Settlement Agreements are also a part of Universal's Exhibits 798, 799 and 800 on the trial of the Counterclaim in *Stewart-Warner Corp.* vs. *Austin L. Staley, Trustee for Universal Lubricating Systems, Inc.*, Equity No. 3342 in the Western District of Pennsylvania (42 F.Supp. 140)

This

SETTLEMENT AGREEMENT
Made and entered into between
THE BASSICK MANUFACTURING COMPANY
of Chicago, Illinois (A Delaware corporation) and

(jobber's name to be filled in here)

a jobber having a place of business at
(City) (State),

WITNESSETH THAT:

WHEREAS, The Bassick Co. claims that the jobber is accountable to the Bassick Co. because of the jobber's direct and contributory infringement of the Bassick Co.'s United States Patents covering ALEMITE and ALEMITE-ZERK lubricating equipment, now, therefore, in settlement of the said claim and in mutual consideration of the following covenants and undertakings, it is agreed:

(1) Subject to the following limitations and conditions the Bassick Co. hereby releases the jobber from any and every claim of every nature whatsoever which the Bassick Co. may have or could have against the jobber on account of the jobber's infringement of the Bassick Co.'s patents covering its Alemite and Alemite-Zerk lubricating equipment.

(2) Subject to the following limitations and conditions the jobber agrees forthwith to discontinue the sale of lubricating equipment manufactured by parties other than the Bassick Co. but interchangeable with the Alemite

and Alemite-Zerk products of the Bassick Co. and in execution of this agreement hereby signs and delivers the attached form of consent decree.

(3) The Bassick Co. agrees that it will not file in court or make any use of the consent decree, now signed by the jobber, so long as the jobber abides by its aforesaid agreement. The Bassick Co. agrees further that in case it is informed of any breach of this agreement on the part of the jobber, the Bassick Co. will give the jobber ten days' notice of the Bassick Co.'s intention to file the attached consent decree in the United States District Court thereby giving the jobber an opportunity to convince the Bassick Co. that the jobber is keeping its above stated agreement, but provided also that if the Bassick Co. is not so convinced it shall be at liberty to file the said consent decree and to have issued thereupon an injunction directed to the jobber together with an order for an accounting of the damages and profits due the Bassick Co. on account of all of the jobber's business in infringement of the Bassick Co.'s patent rights both before and after the execution of this agreement, together with a judgment and execution for the minimum sum of $250.00 to cover the Bassick Co.'s costs and fees involved in such litigation.

(4) The Bassick Co. agrees that in the event that any competent court of final jurisdiction holds all of the claims of the Bassick Co.'s United States patents covering its Alemite and Alemite-Zerk lubricating equipment to be invalid, then this agreement and the attached consent decree shall become wholly null and void and the jobber shall be as free to handle the lubricating equipment of other manufacturers as though this settlement agreement had never been entered into.

EXECUTED in duplicate at Chicago, Illinois, this day of , , by

THE BASSICK MANUFACTURING COMPANY

By /s/ J. E. Otis, Jr. V-Pres.

Appendix E

46 Alemite-owned patents on "chuck" and hydraulic type grease-couple arranged in the chronologic sequence of their filing dates

and

some of the significant events arranged in chronologic sequence in relation to the filing of these 46 Alemite-owned patents

Alemite-owned U.S. patents on "chuck" type grease-couplers

senior* to the Johnson patent here in suit

None of these Alemite-owned patents were ever used commercially

	filing date	inventor's name	patent number	issue date	
1	12–23–15	Seng	Re. 15,632	11–18–19	(IV R 1608)
2	8– 7–16	Morris	Re. 18,278	3–11–30	(IV R 1576)
	12–21–18:	Application filed for the Gullborg patent 1,307,734 (relied on by the Court of Appeals in the case at b but never relied on by respondent in either of t Courts below).			
3	12–21–18	Fessler	1,315,484	9– 9–19	(IV R 1615)
	6–24–19:	Gullborg patent 1,307,734 issues			(PX-141 at IV R 154
4	3–23–21	Seng	1,467,508	9–11–23	(IV R 1612)
5	6–17–21	Bradbury†	1,468,732	9–25–23	(IV R 1621)
6	5–29–22	Zerk	1,711,870	5– 7–29	(IV R 1627)
7	2–19–23	Butler relied on by respondent as its principal "prior-art."	1,593,791	7–27–26	(V R 1705)
8	1– 3–24	Zerk	1,803,520	5– 5–31	(IV R 1636)

*i.e. issued on application filed *prior to* Johnson's filing date of October 30, 19 (*Alexander Milburn* vs. *Davis-Bournonville Co.* 270 U.S. 390, 400)

†Alemite's and Stewart-Warner's patent-attorney (of the firm of Williams, Bradbur McCaleb & Hinkle)

filing date	inventor's name	patent number	issue date	
2-11-25	Murphy	1,685,408	9-25-28	(IV R 1642)

2-10-28: *Alemite* filed suit *against* petitioner's suppliers, *Wm. Robertson & Sons, Inc.* in United States District Court for the Northern District of Illinois, Eastern Division (Equity No. 7883) charging that petitioner's "Jiffy" grease-gun infringed Gullborg patent 1,307,734.

3-19-28	Herb	1,838,549	12-29-31	(IV R 1648)
3-26-28	Butler	1,796,827	3-17-31	(IV R 1559)
3-26-28	Butler	1,816,567	7-28-31	(IV R 1566)

July 1928: Johnsons invent the "Jiffy" chuck type hydraulic coupler here in suit, in their effort, *inter alia*, to get away from the "Alemite" bayonet coupler and so to try to avoid further harassment by Alemite's unwarranted but costly suits falsely based on Gullborg patent 1,307,734, and Johnsons explain their chuck type hydraulic coupler to mechanic Erickson, their co-worker, who understood Johnsons' explanation and thought that Johnsons' chuck type hydraulic coupler would work (*appellate opinion, at 176 F.2d 446*).

4-15-30: Consent decree entered in *Alemite* vs. *Wm. Robertson & Son, Inc.*, supra.

6-20-30: Alemite learns of petitioner's "Jiffy" hydraulic coupler here in suit (PX-86 at IV R 1429).

10-27-30: Alemite obtains a sample of petitioner's "Jiffy" hydraulic coupler here in suit (I R 251 and PX-133 at IV R 1537).

10-30-30: Johnsons file application for patent here in suit.

12- 2-30: Alemite learns that Johnsons filed patent-application on "Jiffy" hydraulic coupler here in suit (PX-135 at IV R 1539).

8-21-31: *Alemite* files suit *against petitioner* in the United States District Court for the District of North Dakota (Equity 519) charging that petitioner's "Jiffy" chuck type hydraulic coupler is an infringement of Gullborg patent 1,307,734 (this is the suit decided in *Stewart-Warner* vs. *Jiffy*, 81 F.2d 786; CCA-8).

Alemite-owned patents on hydraulic or "chuck" type grease-couplers junior* to the Johnson patent here in suit

	filing date	inventor's name	patent number	issue date
13	9–17–31	Creveling	1,958,183†	5– 8–34
14	9–17–31	Creveling	1,970,279	8–14–34
15	9–17–31	Creveling	1,984,865	12–18–34
16	9–17–31	Creveling	2,025,225	12–24–35
17	9–17–31	Creveling	2,025,226	12–24–35
18	9–17–31	Creveling	2,025,227	12–24–35
	10–10–31:	Petitioner formally advises Alemite, by petitione Answer in the aforesaid suit of *Alemite* vs. *Ji* (Equity 519) that its "Jiffy" hydraulic coupler w the subject matter of pending U. S. patent-applicati with claims allowed therein (PX-512 at VII R 220		
19	10–27–31	Nord	2,098,514	11– 9–37 (see Chart
	2–23–32:	certiorari granted in *Adams* vs. *Bassick*, 285 U.S. 531 Gullborg patent 1,307,734.		
20	3–25–32	Dodge	1,941,134	12–26–33
21	3–25–32	Tear	1,974,550	9–25–34
22	3–25–32	Dodge	1,976,059	10– 9–34
23	4– 1–32	Dodge	1,960,529	5–29–34
24	4– 1–32	Dodge	1,970,845	8–21–34
25	4– 1–32	Dodge	1,999,447	4–30–35
	4–16–32:	Alemite pays Adams $200,000.00 to withdraw its pe tion (286 U.S. 567) after certiorari had been grant thereon (285 U.S. 531) in case involving Gullbo patent 1,307,734 (*Appendices A & B* hereto).		
	4–18–32:	certiorari granted at 285 U.S. 531 dismissed on pe tioner's motion in *Adams* vs. *Bassick*, (286 U.S. 56 involving Gullborg patent.		
26	4–20–32	Allen	1,941,133	12–26–33
	5– 2–32:	Alemite advises respondent and its other "distributors of the reasons for paying Adams to withdraw its pe tion from this Court, and of its plan to extend i monopoly for years after the expiration of the Gullbo patent (*Appendix B*, hereto).		

*i.e. issued on applications filed *after* Johnson's filing date of October 30, 1 (*Alexander Milburn* vs. *Davis-Bournonville Co.* 270 U.S. 390, 400)

† U. S. patents are public documents of an executive department of the Federal Gove ment and, as such, are to be judicially noticed, by analogy to ruling in *N.L.R.B.* vs. *Ati* (331 U.S. 398; footnote 2 on page 406) and *Tempel* vs. *U.S.* (248 U.S. 121, 130) and *Tolfr* vs. *Wetzler* (22 F.2d 214, 216; DC NJ) applies this principle to U. S. patents

filing date	inventor's name	patent number	issue date	
5- 4-32	Creveling	1,941,132	12-26-33	
6-27-32	Dodge	1,929,628	10-10-33	
6-27-32	Thompson	1,960,518	5-29-34	
7-29-32	Allen	1,941,136	12-26-33	
7-29-32	Bock	2,008,574	7-16-35	
7-29-32	Clark	2,025,228	12-24-35	
10-15-32	Tear	1,969,915	8-14-34	
10-15-32	Dodge	1,993,878	3-12-35	
3-20-33	Bystricky	2,016,809	10- 8-35	(DX-143, V R 2090 and see Chart G)
4-28-33	Watson	2,019,282	10-29-35	
4-28-33	Creveling	2,055,600	9-29-36	

June 1933: Alemite and respondent place on the market their imitative and infringing hydraulic coupler here in suit, under the name of "Alemite", and announce it to the trade as the greatest contribution in the field of lubrication within a decade (PX-45 at IV R 1407 and 1409).

8-24-33	Creveling	2,123,404	7-12-38	
12-22-33	Williams†	2,047,132	7- 7-36	(see Chart G)
1-22-34	Bystricky	2,056,249	10-6-36	(PX-173 at IV R 1601 and see Chart G)
4- 5-34	Nord	2,061,086	11-17-36	(see Chart G)
5-17-34	Raisch	2,079,361	5- 4-37	(see Chart G)
1-28-35	Williams Jr.‡	2,061,062	11-17-36	

3- 5-35: Decision of U.S. District Court for the District of North Dakota, in *Alemite* (*Stewart-Warner*) vs. *Jiffy Lubricator Co.* (Equity 519) holding that petitioner's "Jiffy" hydraulic coupler here in suit is *not* an infringement of Alemite's Butler patent 1,593,791 and that such "Jiffy" hydraulic coupler is *not* the equivalent of the Butler coupler but is *a different invention.*

†Alemite's and Stewart-Warner's then chief patent counsel, (of the firm of Williams, adbury, McCaleb & Hinkle)

‡Stewart-Warner's patent-attorney in its own patent department

	filing date	inventor's name	patent number	issue date	
44	4–29–35	Krannak	2,070,013	2– 9–37	(see Chart G

12–28–35: *Stewart-Warner* files suit *against* petitioner's principa customer, *Wayne Company*, in the U.S. District Cou for the Northern District of Illinois, Eastern Divisio (Equity No. 14,999), charging infringement of Gullbor patent 1,307,734 against petitioner's "Jiffy" equipmen

2–11–36: Decision in *Stewart-Warner* vs. *Jiffy*, 81 F.2d 786 (CCA-S affirming District Court which held, inter alia, tha petitioner's "Jiffy" hydraulic coupler there and her in suit is not a mechanical equivalent of the Butle coupler, but "*a different invention*";—the appellat court holding that the "Alemite" hydraulic coupl there and here in suit is *not* according to the teachin of the Alemite-owned Butler patent 1,593,791 but wa inspired by and copied from petitioner's prior-marketed "Jiffy" coupler which is the subject matter of th Johnson patent here in suit.

2–21–36: Petitioner's principal customer, Wayne Company, dis continues further purchase and sale of petitioner' "Jiffy" equipment (PX 436 at VII R 2192 and PX 509 at VII R 2198) on account of the filing of the sui of *Stewart-Warner* vs. *Wayne Company*, supra.

5–12–36: Johnson patent in suit issues to petitioner on petitioner' "Jiffy" hydraulic coupler.

5–18–36: Decision in *Bassick* vs. *Hollingshead* and in *Rogers* vs *Alemite*, 298 U.S. 415, on Gullborg patent 1,307,734.

3– 2–37: *Stewart-Warner* dismisses its above-identified suit *against Wayne Company*.

3–28–38: Decision in *Lincoln* vs. *Stewart-Warner*, 303 U.S. 545, on Butler patent 1,593,791.

5–12–38: Stewart-Warner files patent-application for reissuance o Butler patent 1,593,791, to delete grease-pump and grease-cup from the claims of this patent;—giving thi Court's decision in *Lincoln* vs. *Stewart-Warner*, supra as the justification for such reissuance (PX-99 at IV R 1471-1491). See quotation on pages 23 & 24 of peti tioner's Brief filed January 14, 1950.

9–13–38: Butler patent 1,595,791 reissued as Re. 20,852 to Stewart Warner with claims to Butler's coupler, *per se* (PX-99 at IV R 1495-1501).

filing date	inventor's name	patent number	issue date	
9–19–38:	Suit at bar filed by petitioner against respondent.			
2–28–39:	Decision in *Min-A-Max* vs. *Sundholm* 102 F.2d 189 (CCA-8) involving Alemite-controlled Boker patent 1,802,700			(see Chart H, attached).
10–24–42	Campbell	2,362,880	11–14–44	(see Chart G)
5–27–47:	Verdict returned in the case at bar, finding "Alemite" hydraulic coupler an infringement of Johnson patent in suit.			
9–29–47:	Hearing on defendant-respondent's motion for judgment n.o.v. in case at bar.			
12–22–47	Campbell	2,486,113	10–25–49	(see Chart G)
5– 2–49:	Hearing in the Court of Appeals in the case at bar.			
5–14–49:	Respondent's counsel file written argument in Patent Office, in Alemite-owned Campbell application Serial No. 793,130 (item 46, above) urging patentability of Campbell's chuck type hydraulic coupler over the prior-art chuck type hydraulic couplers of the Barks patent, the Sundholm patent and the earlier Campbell patent, all shown in Chart G, and requesting allowance of patent and pointing out that competitive coupler already on the market is an infringement of patent sought on this application (see *Appendix F*, hereto).			
8–17–49:	Decision of Court of Appeals in the case at bar (176 F.2d 444).			
9–28–49:	Final fee paid into Patent Office by respondent's attorneys, so as to bring about the issuance of Campbell patent 2,486,118 (item 46, above) on October 25, 1949, shown in last figure of Chart G.			

Appendix F

UNITED STATES PATENT OFFICE

Applicants: Thomas A. Campbell — Case 7
Ernest G. Stock — Div. 52

Invention : HYDRAULIC COUPLER
Serial No. 793,130 — Filed December 22, 1947

Mail Division
May 14, 1949
U. S. Patent Office

2300 Board of Trade Building
Chicago 4, Illinois
May 12, 1949

Hon. Commissioner Patents
Washington, D. C.

Sir:

. . . (parts omitted here being the claims) . . .

At interviews courteously granted by the Primary and Assistant Examiners in charge of this application to applicants' attorneys and one of the inventors, the Examiners

. . . (parts omitted here) . . .

were shown a competitive coupler which is now on the market and is an almost indistinguishable copy of the commercial coupler of applicants' assignee except that the coupler of applicants' assignee has stamped thereon the assignee's trademark and parts number, whereas the competitive coupler is without identifying marking. The two couplers were disassembled and the interchangeability of the parts was demonstrated.

It was pointed out that in the Campbell patent relied upon by the Examiner the sealing member 64, which effects the seal with the fitting, engages the fitting as a result of its own resiliency and not by virtue of lubricant pressure acting to force this sealing member against the fitting. In fact, in the Campbell patent the metal washer 60 is provided for the express purpose of preventing

lubricant pressure from forcing the sealing member 64 against the end of the fitting. The patent specification, page 2, column 2, lines 28 through 32, states "The mechanical compression of the sealing member which results from attaching the coupler to a fitting is relied upon to effect a lubricant-tight seal between the sealing member 64 and the head of the fitting."

It was further pointed out that the coupler of this Campbell patent was designed for use with a special fitting having a ball-like sealing surface to be engaged by the sealing member of the coupler and that the sealing member of the coupler was given a curved, annular sealing surface 66 to form a ball and socket joint with the rounded head of the fitting. This coupler was not designed or adapted for use with the flat headed lubricant fitting so commonly used in the lubricating field. This Campbell patent also lacks other features of applicants' invention as hereinafter pointed out in connection with the respective claims.

The Sundholm patent of record relates to a coupler forming a metal to metal seal with the end of the fitting and in this respect is representative of well-known commercial types of couplers utilizing such metal to metal seals. These metal to metal seals have the disadvantage of failing to effect a seal where the sealing surface of the fitting is nicked or damaged as by flying rocks and stones where the fitting is used on an automobile. They also have the disadvantage of being ineffective to prevent any leakage where light oil or other free flowing liquid is used. Such couplers are usually of relatively large diameter and of heavy and cumbersome construction in order to provide a heavy sealing force between the metal surfaces of the coupler and fitting and to prevent separation of the parts under this heavy sealing force. The Sundholm coupler lacks any rubber-like sealing member for engaging a fitting and is very different from applicants' structure in construction and mode of operation.

The patent to Barks et al No. 1,966,278 of July 10, 1934 also was discussed. The coupler shown in Fig. 5 of this Barks patent is generally similar to that shown in the Campbell patent of record but is less pertinent than the Campbell coupler in that the jaws of the Barks coupler engage the sides of the fitting rather than the neck of the fitting and the coupler was not designed to give any appreciable angularity between the coupler and fitting. The form shown in Fig. 1 of the Barks et al patent was not designed for use with a headed fitting but for application to the cylindrical end of the old style "pin fitting" which was in such widespread use at the time the application for this Barks et al patent was filed. In this Fig. 1 there is no appreciable angularity between the coupler and the fitting, no multidiameter rubber-like sealing member, and a lack of other features of applicants' claims.

. . . (parts omitted here) . . .

Respectfully submitted,

Hinkle, Horton, Ahlberg, Hansmann & Wupper

By /s/ Elwood Hansmann

FEB 15 1950
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1949.

No. 543

JIFFY LUBRICATOR COMPANY, INC.,
Plaintiff-Petitioner,

vs.

THE ALEMITE COMPANY,
Defendant-Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

CASPER W. OOMS,
209 S. La Salle St.,
Chicago, Illinois,

HERBERT G. NILLES,
Black Building,
Fargo, North Dakota,

JOHN D. BLACK,
First National Bank Building,
Chicago, Illinois,

ELWOOD HANSMANN,
THOMAS F. MCWILLIAMS,
Board of Trade Building,
Chicago, Illinois,
Attorneys for Defendant-Respondent.

THE BUNTHORP-WARREN PRINTING COMPANY, 310 WEST JACKSON, CHICAGO

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1949.

No. 543.

JIFFY LUBRICATOR COMPANY, INC.,
Plaintiff-Petitioner,

vs.

THE ALEMITE COMPANY,
Defendant-Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

FOREWORD.

The petition for writ of certiorari and the brief filed in support thereof when stripped of their prolixity, constitute nothing more than an attack upon the appellate court's exercise of its familiar and long established power to direct the entry of a judgment notwithstanding the verdict of a jury where the undisputed facts leave no issue for determination by the jury.

In this case the Court of Appeals on the undisputed facts held the patent in suit clearly invalid and directed the entry of a judgment of dismissal. Such action of the Court of Appeals in directing the entry of a judgment of dismissal is in accord with the practice under the common

law approved by this Court in *Baltimore and Carolina* v. *Redman,* (295 U. S. 654).

This approved common law appellate practice of entering or directing judgment upon reversal has more recently been incorporated into the Judicial Code (28 U. S. C. § 2106) relative to which this Court stated on January 16, 1950:

> "Under this statute for the first time the power of the Supreme Court and the Courts of Appeals to enter judgment when remanding a case to the lower court is set out in identical language in a single section. That coextensive power is to direct 'such appropriate judgment * * * as may be just under the circumstances.' * * *" (*Bryan* v. *United States,* ..... U. S. ..... 94 Law Ed. Adv. Op. 287, 290.)

A SHORT STATEMENT OF THE CASE.

Petitioner's failure to set forth "a summary and short statement of the matter involved" in this cause compels Respondent to make that statement in this Brief.

This is an ordinary patent infringement suit involving the usual issues of validity and infringement. The District Court overruled respondent's motions for a directed verdict and for judgment notwithstanding the verdict (I R. 57) and entered judgment for petitioner (I R. 61). The Court of Appeals reversed on the ground that the patent was clearly invalid for lack of invention (176 F. 2d 444, VIII R. 2246). In so doing the Court of Appeals acted in accordance with 28 U. S. C. § 2106 and in accordance with long-established and well-recognized Federal procedure.

The Johnson patent No. 2,040,177 here in suit has never been passed upon by any Court other than the Courts which have acted in the instant suit although there is now pending another suit on the patent in another circuit. There is no conflict of decisions nor is there involved any general principle of law which is of public interest and which would justify this Court in devoting its time and effort to consideration of this controversy between private parties.

The Device of the Patent in Suit and the Accused Devices Are Lubricating Couplers of the Chuck Type in Which the Lubricant Pressure Secures the Coupler to the Lubricant-Receiving Nipple.

Johnson patent No. 2,040,177, which is here in suit, was issued May 12, 1936 (IV R. 1348), and is entitled "Hydraulic Lubricating Connection." This patent covers

generally a coupler for connecting a grease gun to a grease fitting or nipple for the purpose of lubricating a bearing of an automobile or other piece of machinery to which the fitting or nipple is attached. The particular form of gripping means utilized in the Johnson patent for securing the coupler to the grease fitting or nipple is of the chuck type, wherein jaws are moved forwardly into a tapering sleeve to constrict or force the jaws against the fitting, in the same manner in which the jaws of carpenter's braces and drills are urged into gripping engagement with bits and drill shanks.

At the time the Johnsons made, in 1930, the first coupler of the kind shown in the patent in suit, most automobiles and many other machines had their bearings equipped with the cylindrical fittings of Gullborg patent No. 1,307,734 (IV R. 1545). Such fittings had an inlet end provided with a passage yieldably closed by a ball which rested on a spring supported by a cross pin that extended transversely through the cylindrical fitting and projected from both sides thereof. The coupler of the Gullborg patent had a piston-like sealing member for engaging the flat end of the fitting and a cylindrical shell provided with bayonet or L-shaped slots which would engage and lock with the ends of the pin when the coupler shell was slipped over the cylindrical fitting and rotated with respect thereto.

The coupler of the Johnson patent in suit was designed for attachment to the Gullborg fitting by gripping the cylindrical end of the fitting beyond the pin. The Johnsons' purpose in substituting a chuck type of gripping means for the bayonet slots of the Gullborg coupler was to seek to avoid a holding that this chuck-type coupler was an infringement of the Gullborg patent and not to produce a coupler of superior merit. This was alluded to in the decision of the Court of Appeals (176 F. 2d 446; VIII R. 2240).

The Alemite hydraulic couplers which are charged to be infringements of the Johnson patent are different from the structure shown in the patent in design, construction, and mode of operation. These couplers, which are shown in the blueprints, Defendant's Exhibit 95 (IV R. 1434-69), were designed for use with a headed fitting and are not capable of use with the Gullborg fitting. The Alemite hydraulic couplers form a ball and socket joint with the head of the fitting to which they are attached and have metal sealing surfaces engaging the fitting to prevent leakage of lubricant therebetween when the coupler is located either in direct alignment with the fitting or at a substantial angle with respect thereto.

The Art in Which the Patent in Suit Appeared Was an Old and Well-Litigated Art in Which Courts Had Defined Established Limits of Potential Invention.

Throughout the years many patents have issued on various forms of couplers for attaching a grease gun to a grease fitting or nipple associated with a bearing to be lubricated. In *Bassick Mfg. Co.* v. *Hollingshead Co.* (298 U. S. 415), this Court in 1935 had occasion to consider one of these patents—Gullborg patent No. 1,307,734 issued on June 24, 1919 (IV R. 1545). This Court stated the Gullborg patent related to

> "• • • an improvement in the hose coupler, which is but one element in the old and well-understood combination of a compression chamber or pump, a hose, a hose coupler, and a grease cup or fitting connected to the bearing to be lubricated • • •." (298 U. S. 415, 419.)

In *Lincoln Engineering Co.* v. *Stewart-Warner* (303 U. S. 545), this Court in 1938 had occasion to consider Butler patent No. 1,593,791 dated July 27, 1926 (V R. 1705)

which disclosed a coupler for connecting a grease gun to a fitting and in which were used the principles inherent in the old carpenter's braces and drill chucks. Of this Butler patent for a chuck-type coupler this Court stated:

> "* * * Butler's alleged invention is in the same field and deals with similar apparatus as did Gullborg's patent, considered in the Rogers (Hollingshead) case. As there shown, it was old practice in the lubrication of bearings to use in combination a fitting connected with the bearing through which oil or grease was to be propelled into the bearing and a gun, which was joined to the fitting by a coupler. In the greasing operation the coupler is fastened to the head of the fitting and the pump is operated to drive the lubricant through the fitting to the bearing. Not only was this combination old but the elements long used in the art varied in design and dimension. Fittings were of different sizes and shapes and had diverse arrangements for their closure when not in actual use for the injection of lubricant. Guns were of many sizes and types. Various forms of coupler had been used for sealing the connection between the pump hose and the fitting. * * * (303 U. S. 545, 546, 547.)
>
> "* * * The invention, if any, which Butler made was an improvement in what he styles in his specifications the 'chuck' and in his claim a 'coupling member.' It is not denied that multi-jawed chucks had been used in industry and as couplers in lubricating apparatus. **Butler may have devised a patentable improvement in such a chuck in the respect that the multiple jaws in his device are closed over the nipple by the pressure of the grease, but we think he did no more than this.** * * * The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention. * * *" (303 U. S. 545, 549.) (Emphasis ours.)

The asserted invention of the Johnson patent in suit, made many years after the Butler patent issued, was merely a variant of the Butler chuck with multiple jaws closing over the nipple by the pressure of the grease. This is readily apparent from the chart attached to the back cover of this brief reproducing figures from the prior art in this Record,* all of which disclose the simple arrangement of a fluid operated chuck of this type, in which the fluid pressure wedges the jaws in the chuck against an encircled connector to secure the connection.

Prior to the opinion of the Court of Appeals in this case the same Court in 1939 considered the Boker patent No. 1,802,700 dated April 28, 1931,—another patent covering a lubricating coupler. In holding the Boker patent invalid the Eighth Circuit Court of Appeals stated (*Min-A-Max Co.* v. *Sundholm*, 102 F. 2d 187, 188):

> "* * * The nozzles through which the lubricant is forced from grease pumps into standard grease cup equipment either fit over and fasten to the grease cups or are manually held thrust into them or against them. It seems likely that many of the thousands of handy mechanics in these United States could readily make suitable nozzles for the purpose. * * *"

---

* The Saxton drawing which appears as No. 12 on this chart is taken from a Saxton patent application (D. Ex. EE, V. R. 1727) filed prior to the Johnson application and involved in a Patent Office interference with the Johnson application. In this interference both the Patent Office Examiner and Board of Appeals held Saxton, and not the Johnsons, to be the first inventor and the Johnson application was finally rejected. The Johnson patent was issued only because Saxton failed to complete the prosecution of his application and failed to take out his patent. Whether the Patent Office had the power to issue the Johnson patent, after the Patent Office had determined Saxton to be the first inventor, is one of the issues which was raised in the Court of Appeals but not there decided.

In the Trial Court Respondent Repeatedly Raised the Issue Determined by the Court of Appeals—That the Patent in Suit Was Clearly Invalid.

Undoubtedly these earlier decisions delineating the narrowing area in which Petitioner had to assert invention induced Petitioner to request a jury. At the conclusion of the trial Respondent moved for a directed verdict under Rule 50 of the Federal Rules of Civil Procedure (I R. 51). In its motion for a directed verdict Respondent asserted that the Johnson patent was invalid because clearly anticipated, **was invalid for lack of invention over the prior art,** and that upon all of the evidence it appeared that **no cause of action had been established as to the issues of either validity or infringement** (I R. 51-3). The case was submitted to the jury which returned a verdict for Petitioner.

Respondent moved to set aside the verdict of the jury and to have judgment entered in accordance with its motion for a directed verdict and again asserted (I R. 54) that **the verdict could not be sustained as there was no substantial evidence on the material issues sufficient to justify or support** it, that the Johnson patent was invalid because anticipated **and for lack of invention over the prior art,** and that upon all of the evidence and as a matter of law it appeared **that no cause of action had been established either as to the issues of validity or infringement** (I R. 54-7). The trial court without opinion denied Respondent's motion for judgment notwithstanding the verdict (I R. 57). Respondent appealed to the Court of Appeals and assigned as one of the points relied on that:

> "* * * the claims in suit of the Johnson and Johnson patent are invalid because these claims are anticipated by **and are invalid for want of invention over the prior art patents and commercial structures**

introduced in evidence and because the patentees of the patent in suit were not the original and first inventors of any material and substantial part of the alleged invention disclosed and claimed in these claims. * * *" (I R. 76) (Emphasis ours.)

The Court of Appeals (176 F. 2d 444) (VIII R. 2236) reversed the judgment of the trial court for the reason that the Johnson patent **was clearly invalid for lack of patentable invention.** Notwithstanding Petitioner's repeated assertions that the Court of Appeals reversed on patents not relied upon by Respondent and on points not asserted by Respondent, the record clearly discloses that Respondent in its pleadings, in its motion for directed verdict, in its motion for judgment notwithstanding the verdict, and in its appeal, consistently urged that the Johnson patent was clearly invalid for lack of invention. In its opinion the Court of Appeals stated:

> "* * * The defendant denied infringement, denied that the Johnsons were the first inventors of the coupler disclosed by the patent in suit, **and asserted that the patent was void because of anticipation and lack of invention.**" (VIII R. 2237) (Emphasis ours.)

There is no foundation for Petitioner's statement that the Court of Appeals reversed the judgment of the trial court on grounds not asserted by Respondent.

ARGUMENT.

I.

THERE BEING NO CONFLICT OF DECISIONS NOR IMPORTANT QUESTION OF FEDERAL LAW PRESENT, THERE IS NO REASON FOR THE GRANT OF THE PETITION.

This Court has repeatedly stated that an ordinary patent infringement case does not present any important questions of Federal law worthy of consideration by this Court. As stated in *Keller* v. *Adams-Campbell Co.* (264 U. S. 314, 319):

> "* * * Such an ordinary patent case with the usual issues of invention, breadth of claims, and noninfringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent. * * *"

In *Layne and Bowler Corp.* v. *Western Well Works Co.* (261 U. S. 387, 393), this Court stated:

> "* * * it is very important that we be consistent in not granting the writ of certiorari except in cases involving principles the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the circuit courts of appeal."

See also *General Talking Pictures Corp.* v. *Western Electric Co.* (304 U. S. 175, 178, 179).

This absence of any real issue which would justify this Court in issuing a writ of certiorari is made abundantly clear by the laborious, involved, and lengthy Petition for Writ of Certiorari and Brief in support thereof which have been filed by Petitioner. If Petitioner had a single

worth-while issue to present to this Court, the Petition could have disclosed it. Petitioner has created a number of fictional issues which are not present in the case.

What the Petition seeks by indirection to attack is the propriety of the exercise by the Court of Appeals of the long established and familiar power to reverse a judgment based upon a verdict of a jury when the undisputed facts establish such clear invalidity of the patent in suit that no question was presented by the evidence for resolution by the jury.

Petitioner conceals this attack in such extravagant assertions as that the Court of Appeals for the Eighth Circuit was not aware of the rule that a patent is prima facie valid. There is absolutely nothing in the clear opinion of the Court of Appeals which even suggests that the experienced Judges of the Court of Appeals were unaware of this elementary rule of patent litigation. Petitioner's counsel overlooked no opportunity to stress the rule vehemently and often.

This presumption of validity, like any other similar presumption, may be overcome by evidence. In the instant case the Court of Appeals expressly pointed out that in view of all of the evidence the patent was clearly invalid, and it therefore had no occasion to refer to the presumption of validity which had been wholly overcome by such evidence.

II.

THE COURT OF APPEALS PROPERLY REVERSED THE JUDGMENT OF THE TRIAL COURT ON THE GROUND THAT THE PATENT BEING CLEARLY INVALID THERE WAS NO QUESTION TO BE SUBMITTED TO THE JURY FOR DETERMINATION.

The structure of the chuck-type lubricating coupler shown and described in the Johnson patent is exceedingly simple. The prior art patents introduced in evidence contain drawings and complete descriptions of the method of operation of the respective structures shown in the drawings. The physical devices introduced in evidence may be readily inspected and their mode of operation and construction readily appear on such inspection. There was no disputed question of fact relative to the operation of the structures shown in the Johnson patent and the prior art. The claims of the Johnson patent can be readily applied to the prior art.

The undisputed facts established by the record in this case abundantly confirm Respondent's contention throughout the trial and on appeal that there was no question properly to be submitted to the jury.

In *Market Street Cable R. Co.* v. *Rowley* (155 U. S. 621, 625), this Court stated:

> "Did the court below err in refusing to instruct the jury to find a verdict for the defendant on the ground that the patent sued on was void for want of novelty?
>
> "The defendant put in evidence a number of patents prior in date to the plaintiff's, and asked the court to compare the inventions and devices therein described with those claimed by the plaintiff. No extrinsic evidence was given or needed to explain terms of art, or to apply the descriptions to the subject-matter, so that the court was able, from mere comparison, to

say what was the invention described in each, and to affirm from such mere comparison whether the inventions were or were not the same. The question was, then, one of pure construction and not of evidence, and consequently was matter of law for the court, without any auxiliary fact to be passed upon by the jury.

"If upon the state of the art as shown to exist by the prior patents, and upon a comparison of the older devices with those described in the patent in suit, it should appear that the patented claims are not novel, it becomes the duty of the court to so instruct the jury.

* * * * *

"In view then, of the state of the art as manifested by several prior patents, we think it is plain that the patent of Lyon and Munro is void for want of patentable novelty, and that the court below erred in not so instructing the jury." (id. 630.)

The Court below, in its opinion in the instant case, stated (176 F. 2d 444, 445; VIII R. 2238):

> "The vital question for decision is, we think, whether the patent in suit (referred to as the Johnson patent) is clearly invalid for lack of patentable invention over the prior art. If the patent is clearly void, the verdict of the jury is, of course, of no help to the plaintiff and other questions need not be considered."

The principle applied by the Court, that in situations such as presented by the record in this case, where there is no fact to be passed upon by the jury, the verdict of a jury is of no help, is completely confirmed by the following patent cases:

Hurin v. *Electric Vacuum Cleaner Co.* (C. C. A. 6, 298 Fed. 76, 78).

McIlvaine Patent Corp. v. *Walgreen Co.* (C. C. A. 7, 138 F. 2d 177).

Ryan Distributing Corp. v. *Caley* (C. C. A. 3, 147 F. 2d 138).

Burroughs Adding Mach. Co. v. *Rockford Milling Mach. Co.* (C. C. A. 7, 292 Fed. 550).
Delories v. *Whitney* (C. C. A. 1, 63 Fed. 611, 618).
Brothers v. *Lidgerwood Mfg. Co.* (C. C. A. 2, 223 Fed. 359, 360).

An analysis of the opinion of the Court below discloses that the Court of Appeals considered not only the undisputed art of record in this case, but also:

(a) the opinion of this Court in the *Hollingshead* case (298 U. S. 415) in which the Gullborg patent relating to a manually operated grease coupler was held invalid;

(b) the opinion of this Court in the *Lincoln* case (303 U. S. 545) in which the Butler patent, relating to an automatic chuck-type grease coupler which rendered the older manual type coupler automatic by the incorporation therein of the principles of the old and generally used multi-jawed chucks, was considered and held invalid;

(c) its opinion in *Stewart-Warner* v. *Jiffy* (81 F. 2d 786), also dealing with the Butler patent, in which the Court stated:

> "Reviewing the prior art, however, we find that it is an old idea to make a chuck whose jaws or gripping elements are segments carried by a cylinder; the segments being drawn together into firm grip upon an object by wedging action between the cylinder and the segments. It is also an old idea to actuate the segments so carried in a cylinder into gripping by wedging action caused by the forward movement of a piston in the cylinder." (81 F. 2d 786, 791.)
>
> "* * * Though none of these patents actually anticipates the claim of the Butler patent covering his coupler adapted for lubricating apparatus, they preclude any conclusion that his was a pioneer patent in the art of making automatic chucks. * * *" (81 F. 2d 786, 792).

(d) its opinion in the case of *Min-A-Max* v. *Sundholm* (102 F. 2d 187), in which the Boker patent on a lubricating coupler was held invalid and in which the Court stated in 1939:

> "* * * It seems likely that many of the thousands of handy mechanics in these United States could readily make suitable nozzles for the purpose. * * *"

Considering the reason for making the alleged invention of the Johnson patent in suit the Court of Appeals below in its opinion in this case stated:

> "* * * It appears that August Johnson told an automobile mechanic in or about 1928 about making something to do away with the old type of connector so that he (Johnson) would not have to use the pin on the Alemite fitting, and that he thought he could make something that would work like a drill chuck, utilizing the force from the grease gun to grip the fitting during the greasing operation. The mechanic understood what Johnson was talking about, and thought it would work." (176 F. 2d 444, 446; VIII R. 2240-1.)

The Court of Appeals thus accepted the patentee's own testimony (V R. 1894-2004) relative to the structure and purpose of the lubricating coupler of his patent and upon the authority of the earlier opinions, stated:

> "* * * Substituting an old and well known form of coupler for another form of coupler equally well known, did not, in our opinion, require invention, but merely mechanical skill.
>
> "* * * To use means old in the art to clamp a grease nozzle to a grease fitting so as to form a tight connection, does not involve patentable invention. * * *" (176 F. 2d 448.)

* * * * *

"Since it is our opinion that the evidence, viewed in the aspect most favorable to the plaintiff, does not

sustain the conclusion that the Johnsons' contribution to the art of lubrication rose to the level of patentable invention, it is unnecessary to consider other questions." (id. 449.)

In other words, the Court of Appeals held that any slight changes in shape and substitution of old elements to which plaintiff could point in support of the Johnson patent did not amount to patentable invention. In this respect the Court of Appeals conformed to the views of this Court as expressed in *Jungersen* v. *Ostby & Barton Co.* (335 U. S. 560), wherein this Court said:

"* * * The patentee claims that the centrifugal forcing of wax into the primary mould had never before been combined with the other features of his process. We think this fact is of no legal significance. Where centrifugal force was common as a means of introducing molten metal into the secondary mould, its use in an intermediate step to force molten wax into the primary mould was not an exemplification of inventive genius such as is necessary to render the patent valid. Cf. *Lincoln Engineering Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545, 82 L. ed. 1008, 58 S. Ct. 662; *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84, 86 L. ed. 58, 62 S. Ct. 37. The patentee himself admitted that the same principle was employed in both steps. Thus Jungersen employed in his claimed invention well known skills and practices in a manner and for a purpose long familiar in the field of casting. His claimed improvement is therefore not patentable." (335 U. S. 560, 566, 567.)

Petitioner Is Really Attacking the Established Practice of Entry of Judgment by a Court Where the Undisputed Facts Disclose No Issue of Fact to Be Submitted to a Jury.

What is apparent through the complexities of Petitioner's statement of its case is the fact that the real attack of the Petition is upon the appellate court's exercise of its familiar and long-established power to enter a judgment notwithstanding the verdict of the jury where the undisputed facts leave no issue for determination by the jury.

It is elementary that trial by jury is accompanied by the power of the court to direct the verdict of the jury, or to enter judgment notwithstanding a verdict, if the undisputed facts leave no issue for the jury's determination.

> "• • • But it is well settled that where the trial judge is satisfied upon the evidence that the plaintiff is not entitled to recover, and that a verdict, if rendered for plaintiff, must be set aside, the court may instruct the jury to find for the defendant." (Citing cases.) *The C. A. Treat Mfg. Company* v. *The Standard Steel & Iron Company*, 157 U. S. 674, 675.
>
> "If, after the plaintiff's case had been closed, the court had directed a verdict for the defendant on the ground that the evidence, with all inferences that the jury could justifiably draw from it, was insufficient to support a verdict for the plaintiff, so that such a verdict, if returned, must be set aside, it would have followed a practice sanctioned by repeated decisions of this court. • • • *Baylis* v. *Travelers' Insurance Company*, 113 U. S. 316, 320.

It is similarly clear that if judgment is entered upon a jury's verdict, the appellate court can direct a judgment if the trial court has erroneously ruled upon a motion for directed verdict. While the exercise of this power was

for long trammeled by procedural niceties as to whether a proper reservation had been made in the trial court to invoke the exercise of this power on appeal, (*Slocum* v. *New York Life Ins. Co.*, 228 U. S. 364) Federal Rule 50 (b) has fully clarified the procedural detail. *Montgomery Ward & Co.* v. *Duncan*, 311 U. S. 243, 250.

This Court, in *Baltimore & Carolina Line* v. *Redman*, 295 U. S. 654, not only exercised this inherent power of an appellate court, but, upon the narrow issue of whether upon reversal judgment should be directed or the case remanded for a new trial when the appellate court's determination extinguished any basis for liability, held that judgment should be directed.

The case was an action for negligence and the jury found for the plaintiff, motions for directed verdict were denied, and judgment for plaintiff entered. On appeal the Second Circuit Court of Appeals divided on the question whether it should reverse on the ground of the insufficiency of the evidence to present an issue for the jury, but the majority did reverse and remanded for a new trial. The Court of Appeals held that it could not enter a final judgment of dismissal.

This Court sustained not only the propriety of the appellate practice of reversing a judgment entered upon a verdict of a jury where the undisputed facts left no foundation for liability, but the practice of entering final judgment in the appeals court without the ultimately futile remand, saying (pp. 659-661):

> "At common law there was a well established practice of reserving questions of law arising during trials by jury and of taking verdicts subject to the ultimate ruling on the questions reserved; and under this practice the reservation carried with it authority to make such ultimate disposition of the case as might be made essential by the ruling under the reservation, such as

non-suiting the plaintiff where he had obtained a verdict, entering a verdict or judgment for one party where the jury had given a verdict to the other, or making other essential adjustments.

"Fragmentary references to the origin and basis of the practice indicate that it came to be supported on the theory that it gave better opportunity for considered rulings, made new trials less frequent, and commanded such general approval that parties litigant assented to its application as a matter of course. But whatever may have been its origin or theoretical basis, it undoubtedly was well established when the Seventh Amendment was adopted, and therefore must be regarded as a part of the common-law rules to which resort must be had in testing and measuring the right of trial by jury as preserved and protected by that Amendment.

"This Court has distinctly recognized that a federal court may take a verdict subject to the opinion of the court on a question of law, and in one case where a verdict for the plaintiff was thus taken has reversed the judgment given on the verdict and directed a judgment for the defendant."

* * * * *

"In view of the common-law practice and the related state statute, we reach the conclusion that the judgment of reversal for the error in denying the motions should embody a direction for a judgment of dismissal on the merits, and not for a new trial. Such a judgment of dismissal will be the equivalent of a judgment for the defendant on a verdict directed in its favor."

In *National City Bank* v. *Oelbermann,* 298 U. S. 638 (1936), this Court in a *per curiam* opinion followed the practice approved in the *Redman* case.

This common law Federal appellate practice of entering and directing judgment upon a reversal has recently been codified in the revision of the United States Code. Title 28, section 2106 provides:

"The Supreme Court or any other court of appel-

late jurisdiction may affirm, modify, vacate, set aside or reverse any judgment, decree, or order of a court lawfully brought before it for review, and may remand the cause and direct the entry of such appropriate judgment, decree, or order, or require such further proceedings to be had as may be just under the circumstances."

This section of the Code has had the consideration of this Court in the case of *Bryan* v. *United States* (94 L. Ed. Adv. Op. 287) wherein this Court pointed out that under this new section of the Code a Court of Appeals certainly has power to direct "such appropriate judgment . . . as may be just under the circumstances."

The common law procedure, both of reviewing the judgment after jury trial and reversing without remand for the new trial on the ground that the undisputed facts left no issue for the jury has been consistently followed in the United States Courts:

New England Mutual Life Ins. Co. v. *Cohen*, 83 F. 2d 163, 166 (C. C. A. 2).

Sheehan v. *New York, N. H. & H. R. Co.*, 93 F. 2d, 442, 444 (C. C. A. 2).

Geo. D. Horning v. *McAleenan*, 149 F. 2d 561, 565 (C. C. A. 4).

Sun Life Assur. Co. v. *Maloney*, 132 F. 2d 388, 390 (C. C. A. 5).

Conn. Mut. Life Ins. Co. v. *Lanahan*, 113 F. 2d 935 (C. C. A. 6).

Brunet v. *S. S. Kresge Co.*, 115 F. 2d 713, 716 (C. C. A. 7).

Lowden v. *Bell*, 138 F. 2d 558, 560-561 (C. C. A. 8).

That this procedure was properly followed in this case appears to be conceded by Petitioner in its contention that the Court of Appeals had not held the patent in suit "in-

valid as a matter of law" and the implication that had the Court done so the procedure would be unassailable (Brief, p. 5). Petitioner admits that there are circumstances where the issue can be decided as a matter of law, saying (Brief, p. 11):

> "The only way in which the question of invention (which, as pointed out above, is fundamentally a question of fact) could be converted into a question of law in the case at bar was if the evidence so overwhelmingly showed lack of invention that reasonable men could **not** have differed;—in which case the trial judge should have granted the motions for directed verdict or the motion for judgment notwithstanding the verdict."

That this is such a case Petitioner admitted in the Court of Appeals where it said in its brief, page 99:

> "* * * The determination of whether or not such anticipation is present can in some cases be determined by a mere comparison of the patent-in-suit with the prior patents relied on so that, under some circumstances, the Court can conclude, as a matter of law, that there is clearly no 'anticipation.' The case at bar is such a case."

That Petitioner was right in conceding this case to be "such a case" readily appears from the facts.

The Exercise by the Court of Appeals of Its Power to Reverse the Judgment Entered by the Trial Court Raises No Constitutional Question.

Petitioner by its questions 4, 8, and 9 asserts that the action of the Court of Appeals in reversing the judgment of the trial court deprived petitioner of its right to a jury trial and that this action is in violation of the rights guaranteed to it by the Seventh Amendment to the Constitution. This same type of argument was asserted in the case of *Ryan Distributing Corp.* v. *Caley* (147 F. 2d 138, C. C.

A. 3, 1945; cert. den. 325 U. S. 859). The *Ryan* case was a suit for patent infringement tried to a jury. The jury returned a verdict in favor of the patent owner. The Court set aside the verdict of the jury and entered judgment holding the patent invalid. Relative to the argument on the right to a jury trial, the Court of Appeals said (147 F. 2d 138, 142):

> "Finally, defendant argues that, if the trial judge's ruling is sustained, it deprives every patentee of his right to a trial by jury on the question of invention as guaranteed by the 7th Amendment of the Constitution. On this the defendant cites *Slocum* v. *New York Life Ins. Co.*, 1913, 228 U. S. 364, 33 S. Ct. 523, 57 L. Ed. 879 Ann. Cas. 1914D, 1029, but fails to cite the qualifying decision in *Baltimore & Carolina Line, Inc.* v. *Redman*, 1935, 295 U. S. 654, 55 S. Ct. 890, 79 L. Ed. 1636 and Rule 50(b) of the Federal Rules of Civil Procedure. Rule 50(b) was designed to reserve the legal question involved where a motion for a directed verdict made at the close of all the evidence is denied. Such reservation was held sufficient to empower the judge to enter judgment notwithstanding the verdict even though he denied the motion for directed verdict prior to submission of the case to the jury. Rule 50(b) in terms makes the denial subject to later determination if the proper steps are taken. See discussion in 3 Moore's Federal Practice § 50.02 and 8 Cyclopedia of *Federal Procedure* [2d ed.] § 3497. See also *Montgomery Ward & Co.* v. *Duncan*, 1940, 311 U. S. 243, 61 S. Ct. 189, 85 L. Ed. 147. Defendant's contention in this respect is wholly without merit."

In *Montgomery Ward* v. *Duncan* (311 U. S. 243, 254, 1940), this Court affirmed the right of an appellate court to reverse the action of the trial court in refusing to enter judgment notwithstanding the verdict, stating:

> "• • • The appellate court may reverse the former action and itself enter judgment n.o.v. • • •."

See also the quotation from the case of *Baltimore & Carolina* v. *Redman* appearing on pages 18-19 hereof.

We have pointed out hereinabove that in this case the Court concluded that the evidence viewed in the aspect most favorable to plaintiff does not sustain the conclusion that the Johnson patent is valid. As stated by this Court in *Coughran* v. *Bigelow* (164 U. S. 301, 308):

> "• • • granting a nonsuit for want of sufficient evidence is not an infringement of the constitutional right of trial by jury."

In *Capital Traction Co.* v. *Hof* (174 U. S. 1, 13), this Court stated:

> "'Trial by jury' in the primary and usual sense of the term at the common law and in the American Constitutions, is not merely a trial by a jury of twelve men before an officer vested with authority to cause them to be summoned and impaneled, to administer oaths to them and to the constable in charge, and to enter judgment and issue execution on their verdict; but it is a trial by a jury of twelve men, in the presence and under the superintendence of a judge empowered to instruct them on the law and to advise them on the facts, and (except on acquittal of a criminal charge) to set aside their verdict if in his opinion it is against the law or the evidence. This proposition has been so generally admitted, and so seldom contested, that there has been little occasion for its distinct assertion. Yet there are unequivocal statements of it to be found in the books."

Under these authorities, the Johnson patent being clearly invalid for lack of patentable invention, and "the evidence" establishing that the Johnsons' contribution to the art of lubrication did not rise to the level of patentable invention, the trial court should have directed the jury to return a verdict for the defendant upon its motion or, in the alternative, should have granted its motion for judgment notwithstand-

ing the verdict. It was this error of the trial court which the Court of Appeals corrected by reversing the judgment of the lower Court. This exercise of familiar judicial power by the Court of Appeals did not in any way infringe upon Petitioner's rights to a jury trial guaranteed to it by the Seventh Amendment.

In essence the Court below held that patentable invention was not involved when the old type manually operated coupler was equipped with the multi-jawed chucks of the prior art, and that this was particularly true when such a combination had theretofore been disclosed and published in the Butler and other patents.* The Court held that such a structure was clearly invalid for lack of patentable invention and properly reversed the judgment entered by the trial court. In so reversing the judgment of the trial court the Court of Appeals did not weigh conflicting evidence, it did not consider the credibility of witnesses, and it did not make any findings of fact on fact questions which were in any way disputed. The Court of Appeals in its opinion merely accepted uncontroverted facts which led only to the conclusion that the Johnson patent is invalid for lack of invention (*Jungersen* v. *Ostby & Barton Co.*, 335 U. S. 560.

This Case Does Not Involve the Question Whether Invention Is a Question of Law or Fact.

Petitioner asserts that a question involved in this case is the determination of whether invention is a question of fact or a question of law (Question 1, Petition page 31). There is no occasion for this Court to consider this question in this case because there is no such question present. The

* See chart attached at rear of this brief.

Court of Appeals in its opinion held that as a matter of law the Johnson patent is invalid. The Court stated:

> "The vital question for decision is, we think, whether the patent in suit (referred to as the Johnson patent) is clearly invalid for lack of patentable invention over the prior art. If the patent is clearly void, the verdict of the jury is, of course, of no help to the plaintiff and other questions need not be considered." (176 F. 2d 445; VIII R. 2238.)

The Court also said in its opinion:

> "* * * the evidence," (*i. e.*, the facts) "viewed in the aspect most favorable to the plaintiff, does not sustain the conclusion that the Johnsons' contribution to the art of lubrication rose to the level of patentable invention * * *." (176 F. 2d 449; VIII R. 2245.)

It is therefore clear that if invention be a question of law the Court of Appeals as a matter of law has held in this case that there is no invention in the patent in suit and that if invention be a question of fact the Court of Appeals has held that on the uncontroverted facts Johnsons' contribution to the art of lubrication did not rise to the level of patentable invention. Regardless, therefore, of whether invention is a question of fact or law, the conclusion is the same, *i. e.*, that the Johnson patent is invalid.

III.

THE OPINION OF THE COURT OF APPEALS BELOW DID NOT MISINTERPRET OR UNDULY EXPAND THE OPINIONS OF THIS COURT IN BASSICK v. HOLLINGSHEAD, ROGERS v. ALEMITE, AND LINCOLN v. STEWART-WARNER.

Petitioner by its question 10 (Petition page 36) suggests that the opinion of the Court of Appeals in this case misinterprets and unduly expands the opinions of this Court in *Bassick* v. *Hollingshead, Rogers* v. *Alemite* (298 U. S.

415) and *Lincoln* v. *Stewart-Warner* (303 U. S. 545). There is no basis for this assertion. In its opinion the Court of Appeals properly interpreted the cited opinions of this Court when it stated (176 R. 2d 444, 446; VIII R. 2240):

> "* * * The question of contributory infringement reached the Supreme Court in 1935 and was decided on May 18, 1936, in the cases of *Bassick Manufacturing Co.* v. *R. M. Hollingshead Co.*, and *Rogers et al.* v. *Alemite Corporation*, 298 U. S. 415. The Supreme Court held, in substance, that, since the combination of a grease pump, connecting conduit, coupler, and pin fitting was old in the art, Gullborg could not, by inventing a new and improved type of coupler or pin fitting, claim either of these in combination with the old forms of the other elements so as to exclude the public from the use and sale of the old forms of fittings or grease guns even though these might be used respectively with Gullborg's improved coupler or his improved pin fittings, because, in the combinations claimed, an old-type fitting or an old-type coupler had no novel function over those of the prior art. See *Lincoln Engineering Co.* v. *Stewart-Warner Corporation* (1938, 303 U. S. 545, 547-548)."

From this quotation from the opinion of the Court below it is apparent that the Court was aware of the precise limitations expressed in these opinions of this Court. Nowhere in the opinion of the Court below is there a statement that the Johnson patent is invalid because its claims include a grease gun or fitting. Nowhere is there in the opinion of the Court below any statement that the claims of the Johnson patent are invalid because they claimed more than the patentee invented as this Court held in the *Hollingshead, Rogers,* and *Lincoln* cases. In its opinion the Court of Appeals stated:

> "* * * What the Johnsons did—as we see it—was to substitute for the bayonet type of connecting means

of Gullborg, which was old, a chuck type of connecting means, also old. * * * Substituting an old and well known form of coupler for another form of coupler equally well known, did not, in our opinion, require invention, but merely mechanical skill. * * *

"* * * To use means old in the art to clamp a grease nozzle to a grease fitting so as to form a tight connection, does not involve patentable invention. * * *"
(176 F. 2d 448; VIII R. 2244, 2245.)

Here are clear and unequivocal statements by the Court of Appeals that the specific coupler construction disclosed and claimed in the Johnson patent does not in and of itself constitute a patentable invention. There is, therefore, no basis for the contention that the opinion of the Court below misinterpreted or unduly expanded the earlier opinions of this Court.

IV.

IN URGING THAT THE DECISION OF THE COURT OF APPEALS IN STEWART-WARNER v. JIFFY (81 F. 2d 786) WAS CONTRADICTED BY THE INSTANT DECISION PETITIONER MISSTATES THE EARLIER DECISION.

Petitioner repeatedly (Petition pp. 4-8, 17-18, 23, 25, 26, 32, 42; Brief, pp. 7-10, 11-12, 26, 29) asserts that when the Eighth Circuit Court of Appeals held the Johnson patent clearly invalid it failed to follow its own earlier determination of the presence of invention in the Johnson ("Jiffy") coupler in *Stewart-Warner Corp.* v. *Jiffy Lubricator Co.*, 81 F. 2d 786.

This repeated misrepresentation that there was a common issue decided differently in the two cases is not only completely refuted by the Record, but was denied by the Court of Appeals when it answered Petitioner's contention that the earlier opinion found invention in the "Jiffy" coupler:

"While this Court distinguished the Jiffy hydraulic

> coupler, the accused device in that case, from the device of Butler, and was of the view that the Alemite hydraulic coupler, made by the Stewart-Warner Corporation, did not conform to the Butler patent, the Court did not hold that whatever advance in the art over the Butler coupler was disclosed by the Jiffy hydraulic coupler would amount to patentable invention." (176 F. 2d 447.)

Petitioner was not unaware of this flat answer to the argument about which the Petition is built, as Petitioner quotes in its Brief a mutilated fragment of this passage, as well as another mutilated excerpt from the opinion also distinguishing the earlier decision (Brief, p. 29). Although the opinion of the Court of Appeals contains an adequate answer to this repeated perversion of the relationship of the two cases, the essential facts of the cases preclude any such construction as Petitioner seeks to force upon them.

The opinion of the Court of Appeals in *Stewart-Warner Corp.* v. *Jiffy Lubricator Company* (81 F. 2d 786), involving the scope of the Butler patent was announced February 11, 1936. The Johnson patent involved in the instant suit did not issue until May 12, 1936. Neither the application on which the Johnson patent issued nor any of the claims which issued in the Johnson patent were before the Court of Appeals in the earlier case. It is therefore manifest that the Court of Appeals in this earlier decision did not and could not have considered the validity of the Johnson patent, the only question determined by the Court below.

In deciding the case of *Stewart-Warner* v. *Jiffy,* the Court of Appeals was concerned with the validity and scope of the claims of Butler patent No. 1,593,791 which issued in 1926 (V R. 1706), *i. e.,* ten years prior to the issuance of the Johnson patent. The Court of Appeals for the Eighth Circuit in *Stewart-Warner* v. *Jiffy* (81 F.

2d 786), held that such a coupler lacked invention over the prior art and that Butler's claims had to be limited to a specific form of chuck construction. Later the Court of Appeals for the Seventh Circuit in *Lincoln* v. *Stewart-Warner* (91 F. 2d 757), gave Butler's monopoly a broader construction. This Court subsequently held the Butler patent invalid, but also held that Butler's contribution could not have been more than a hydraulic coupler in which the lubricant pressure forced the chuck jaws over the nipple, the same chuck which the Johnson patent seeks to cover. The difference between the two Courts of Appeals with respect to the scope of Butler's monopoly is of no importance in the present controversy since under either construction neither the Johnsons nor others are entitled to re-patent what Butler had earlier disclosed and sought to claim as his monopoly.

From the foregoing it will be apparent that in *Stewart-Warner* v. *Jiffy* the Court of Appeals was concerned only with the question of validity and infringement of the claims of the Butler patent. In the present litigation the issues are the validity and infringement of the claims of the Johnson patent. This difference in issues alone clearly repudiates Petitioner's repeated misrepresentation that the instant decision reverses or contradicts findings made in the earlier case.

This is only one of several instances in which petitioner throughout this litigation has sought to misconstrue and misapply the decision of the Court of Appeals in *Stewart-Warner* v. *Jiffy*.

Conclusion.

The opinion and judgment of the Court below predicated upon the clear invalidity of the Johnson patent must stand because the chuck coupler of the Johnson patent does not constitute a patentable invention over the prior art.

Nowhere in the Petition or in the Brief filed in support thereof does Petitioner point out any distinguishing characteristic, either in the structure or mode of operation of the Johnson coupler, which would lift it over the prior art. Petitioner offers no suggestion as to what Johnson accomplished by his alleged invention which was not accomplished equally well by the same combination of old elements operating in the same way in the prior art.

In the welter and maze of nonrelevant facts and immaterial arguments and fancied questions asserted, Petitioner has refused to meet the basic issue determined by the Court below that there is no patentable invention in the Johnson patent. The Court below correctly held that the Johnson patent is clearly invalid.

The Petition for a writ of certiorari should be denied.

Respectfully submitted,

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February 14, 1950.

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CHARLES ELMORE CROPLEY
CLERK

In the

Supreme Court of the United States

No. 543 October Term, 1949

Jiffy Lubricator Company

petitioner

v.

The Alemite Company

respondent

Petition for Re-Hearing under Rule 33(2) on Petition for Writ of Certiorari

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Petition for Re-Hearing

To the Honorable The Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Jiffy Lubricator Company, respectfully petitions for a re-hearing on its Petition filed January 14, 1950 for Writ of Certiorari which was denied on March 13, 1950.

In support of its present Petition for Re-Hearing, petitioner relies, inter alia, upon *Appendices A to D,* inclusive, annexed to petitioner's *Reply* Brief filed March 8, 1950 (which Appendices are here included by reference) and upon the 8th Circuit's decision in *Trico Products Co.* vs. *Delman Corp. et al,* decided March 8, 1950; F.2d (84 USPQ 416, 420).

Counsel's Certificate under Rule 33(2)

The undersigned, counsel for petitioner, hereby certify that the within Petition for Re-Hearing is presented in good faith and not for purposes of delay and that the Petition is limited to grounds not presented in the Petition for Writ of Certiorari as filed on January 14, 1950 nor otherwise previously presented except to the extent covered by petitioner's Reply Brief filed March 8, 1950.

C. A. Taney, Jr.
Leonard L. Kalish
counsel for petitioner

Grounds for Petition for Re-Hearing

Ground 1: The 8th Circuit overruled the jury's fact-finding of invention and held petitioner's Johnson patent in suit invalid upon its assumption that the invention which is the subject matter of Gullborg patent 1,307,734 revolutionized the lubricating equipment industry or, in other words, was a pioneer patent, and such matter had not been tried in the Court below and such revolutionary appearance was *falsely* created by illegal practices of respondent's privies, in cooperation with respondent, which may come within this Court's condemnation in *Hazel-Atlas*

Glass Co. vs. *Hartford Empire Co.,* 322 U.S. 238 and *Precision Instrument Mfg. Co.* v. *Automotive Maintenance Mach. Co.* 324 U.S. 806, and the 8th Circuit's decision in the case at bar tends both to condone and to place a high reward upon the specific practices theretofore held illegal in *Stewart-Warner* vs. *Staley* 42 F.Supp. 140, by holding the Johnson patent here in suit invalid for the benefit of a piratical infringer, upon an unpleaded defense tainted with and permeated by, if not indeed squarely bottomed on, such illegal practices.

Ground 2: The recent (March 8, 1950) decision of the 8th Circuit in *Trico Products Corp.* vs. *Delman Corp. et al* F.2d (84 USPQ 416, 420) now shows that the 8th Circuit has fundamentally changed its standard of invention and its *law of invention* between

1) its decision in *Stewart-Warner* vs. *Jiffy Lubricator Co.* 81 F.2d 786 (which supports the jury's fact-finding of invention in the case at bar)

and

2) its decision in the case at bar as to which certiorari is sought,

and that such change in the standard or in the law of invention made by the 8th Circuit is in conflict with the 7th, 6th and 1st Circuits and is one which should be reviewed by this Court, inter alia, in order to resolve such conflict and to avoid another 17 years of patent litigation in an industry heretofore illegally monopolized by 19 years of unwarranted Alemite litigation.

Authorities relied upon by Petitioner in support of its Petition for Re-Hearing

Authorities relied on as to Ground 1:

Hazel-Atlas Glass Co. v. *Hartford-Empire Co.,* 322 U.S. 238

Precision Instrument Mfg. Co. v. *Automotive Maintenance Mach. Co.* 324 U.S. 806

Stewart-Warner vs. *Staley* 42 F.Supp. 140 (DC WD Pa.)

Authorities relied on as to Ground 2:

Trico Products Corp. vs. *Delman Corp. et al* (**8 Cir.**) F.2d (84 USPQ 416, 420), **decided March 8, 1950**

Falkenberg vs. *Bernard Edward Co.* (**7 Cir.**) 175 F.2d 427, **decided June 21, 1949** and certiorari denied on November 7, 1949 at U.S. (94 L.Ed 70)

Brown & Sharpe Mfg. Co. vs. *Kar Engineering Co.* (**1 Cir.**) 154 F.2d 48, **decided March 14, 1946** and certiorari denied on June 10, 1946, at 328 U.S. 869

Trabon Engineering Co. vs. *Dirkes et al* (**6 Cir.**) 136 F.2d 24, **decided June 4, 1943**

Matters submitted in support of the Grounds of the Petition for Re-Hearing

Ground 1:

The practices which have created the wholly false appearance as to the status in the art of Gullborg patent 1,307,734, upon which status the 8th Circuit predicated its decision at bar, are but exemplified by aforementioned *Appendices A*, B[2], C[3] & D[4].*

In Stewart-Warner Corp. vs. *Staley,* 42 F. Supp. 140 (DC WD Pa) the Court ruled that these very practices and other practices contributing to the false status of the Gullborg patent erroneously relied on by the 8th Circuit in the case at bar (all of which practices petitioner was ready to prove and would have proved in the case at bar had the Gullborg patent been relied upon) constituted violations of the anti-trust laws and unfair competition.

Are not the practices exemplified by *Appendices A*, B[2], C[3] and D[4]* also a fraud upon the Courts?

---

* "paid various defendants in patent suits brought by plaintiff, substantial sums of money and other valuable considerations not to defend such suits or to forego further appeals therein, in order to obtain favorable judgments therein which might be cited as precedents in other patent litigation, without apprising the court of the payment made by the plaintiff in such suits to obtain such judgments" (42 F. Supp. 140)

2 Alemite's letter explaining its $200,000.00 payment to petitioner in *Adams* vs. *Bassick* 285 U.S. 531

3 "consent decrees" signed by jobbers without any suit filed

4 "settlement agreements" explaining "consent decrees"

It is respectfully submitted that if a patent is to be held invalid because of fraud practiced in the obtaining of the patent, as in the *Precision Instruments Co.* case, *supra*, then, a fortiori, a defense to the validity of the patent in suit should not be sustained where the defense is permeated and indeed created by illegal practices of the defendant (*Stewart-Warner* vs. *Staley, supra*); particularly where such defense was neither pleaded nor tried below nor urged in the Court of Appeals.

In view of the serious nature of these matters and in view of this Court's decisions in the *Hazel-Atlas* and *Precision Instrument* cases, supra, and not knowing whether this Court's denial of certiorari in the case at bar may have been based upon the fact that these matters were not in the Petition itself (but only in the Reply Brief), petitioner takes this opportunity to call these matters to the Court's attention by the present petition for re-hearing.

Moreover, in view of the 8th Circuit's reliance upon the Gullborg patent and upon its presumed pioneer character, petitioner should be given an opportunity to prove the *true* status and significance of the Gullborg patent before its Johnson patent is held invalid thereon, as such Gullborg patent was neither pleaded nor ever relied upon in either Court below.

Ground 2:

In *Trico* vs. *Delman*, supra, the 8th Circuit has now made it clear that it is presently applying and *has in the case at bar applied* a substantially different law of invention and higher standard of invention than it formerly applied in *Stewart-Warner* vs. *Jiffy Lubricator Co.* 81 F.2d 786 "for determining whether patented improvements of practical value and which have met with commercial success involve invention or only mechanical skill", and predicated its fundamental change in the standard of invention or in the law of invention upon this Court's decision in *Cuno Engineering Corp.* vs. *Automatic Devices Corp.* 314 U.S. 84, and in so doing interpreted this Court's decision

in the *Cuno* case in a way which is patently in conflict with the interpretation given to the *Cuno* decision by other Circuits, in the following cases:

Falkenberg vs. *Bernard Edward Co.* 175 F.2d 427 (7 Cir.) decided on June 21, 1949 and certiorari denied on November 7, 1949 at U.S. (94 L.Ed. 70)

Brown & Sharpe Mfg. Co. vs. *Kar Engineering Co.*, 154 F.2d 48 (1 Cir.) decided on March 14, 1946 and certiorari denied on June 10, 1946 at 328 U.S. 869

Trabon Engineering Co. vs. *Dirkes et al* 136 F.2d 24 (6 Cir.) decided on June 4, 1943

While the 8th Circuit in the recently-decided *Trico* case, supra, and this Court in the *Cuno* case *merely affirmed* the District Court's fact-finding of non-invention, in the case at bar the 8th Circuit *reversed* the jury's fact-finding of invention concurred in by the trial Judge, where the trial Judge had expressly instructed the jury in this Court's language in its *Cuno* decision and where such fact-finding of the jury was concurred in by the trial Judge and was wholly in harmony with and supported by the 8th Circuit's earlier (1936) decision between the parties in *Stewart-Warner* vs. *Jiffy* 81 F.2d 786.

In *Falkenberg* vs. *Bernard Edward Co.*, 175 F.2d 427 (decided June 21, 1949), the Court of Appeals for the 7th Circuit held that this Court's "flash of creative genius" test (which test the jury was expressly instructed to apply in the case at bar) did *not* change the law of patents in respect to the fundamental question as to what degree or margin of difference over the prior-art constitutes "invention". In so holding, the 7th Circuit is in harmony with the 1st Circuit's decision in *Brown & Sharpe Mfg. Co. et al* vs. *Kar Engineering Co., Inc.*, 154 F.2d 48, 51 and also with the 6th Circuit's decision in *Trabon Engineering Corp.* vs. *Dirkes et al*, 136 F.2d 24, 27, as will be seen from the following quotations from the 7th Circuit's decision in the recent *Falkenberg* case:

"Plaintiff is the owner of U. S. Letters Patent No. 2,409,425 pertaining to drapery mountings. . . . (175 F.2d 427). The usual defenses of invalidity and non-infringement are presented.

"The trial court made a finding that

> 'plaintiff's hanger was novel, presented a genuine improvement to the drapehanging trade, and had remarkable public acceptance.'

"The court said

> 'Under the state of the law as it formerly existed, these elements would probably combine to produce patentable invention.'

"However, the trial court held that there was absent *a flash of genius* as described in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84, and, after quoting from that case, concluded:

> 'Therefore, Claims 14 and 15 of Patent No. 2,409,425 are declared invalid for lack of invention. . . .'

"It is apparent the trial court felt that as a result of the *Cuno* decision something new had been added by the Supreme Court to the test to be applied in determining invention. Indeed other courts have been of the same opinion. In *Brown & Sharpe Mfg. Co. et al.* v. *Kar Engineering Co., Inc.*, D. C., 59 F.Supp. 820, page 825, the trial court said:

> 'If it were not for *Cuno Engineering Corporation* v. *Automatic Devices Corporation* . . . and the line of authority which it has engendered, see, for example, *Anderson Co.* v. *Lion Products Co.*, 1 Cir. 127 F.2d 454, I should, on the basis of the considerations set forth in the preceding paragraph, have concluded that Bower had made a patentable invention. But I cannot see how such a conclusion can stand in the light of the changed standards prevailing since the

recomposition of the Supreme Court of the United States. . . .

'Tested by the rules enunciated by Mr. Justice Douglas in *Cuno's* case, I conclude that claims 1, 5, 7 and 14 of the Bower patent are invalid. . . .'

"The use of the term, 'flash of creative genius,' was unfortunate and met widespread surprise and criticism. For example, see the decision of this court in *Chicago Steel Foundary Co.*, 7 Cir., 132 F.2d 812. Even the Court of Appeals for the First Circuit, reversing its former adherence to that view, said on the appeal of the *Brown & Sharpe* case, 154 F.2d 43, 51, after citing the opinion of the district court heretofore quoted:

'The foregoing squarely presents us with the question whether the Supreme Court in the *Cuno* case intended to establish for the future a new and higher standard of invention than had prevailed in the past.'

"Citing a number of cases in which that question had been considered, the appellate court analyzed whether the flash of creative genius phrase had added a new or higher test of invention, and concluded that all the Supreme Court had intended in the *Cuno* case was a restatement of the traditional test. The Court held that its earlier view to the contrary was a mistake.

"In *Trabon Engineering Corp.* v. *Dirkes et al*, 136 F.2d 24, the Court of Appeals for the Sixth Circuit reversed a holding of invalidity by the district court, and in discussing the flash of genius concept stated, 136 F.2d at page 27:

'. . . We do not interpret the observation as indicating anything more significant than that the quality of invention is "something more" than expected mechanical skill. Nor do we read the phrase as another conscious effort to define the indefinable.'

"We hold that the trial court herein erred in construing the phrase, '*flash of genius,*' as adding a test for invention of a higher degree or superior to that which would have produced patentable invention under the law as it existed prior to the date of the *Cuno* decision. As we have done heretofore (*Chicago Steel Foundry Co.* v. *Burnside Steel Foundry Co.*, supra) we reject the flash of genius test." (175 F.2d 428-9)

. . . . . .

". . . Since we feel that 'state of the law' has not changed, the trial court's finding that these elements would probably combine to produce patentable invention under the state of the law formerly existing is tantamount to a finding of patentable invention.

"A long line of cases could be cited holding that the determination of patentable invention is a question of fact; however, other courts have dealt with the issue as though it were a question of law. A citation of such authorities would not be helpful in view of the recent decision of the United States Supreme Court in *Graver Tank and Mfg. Co., Inc. et al* v. *Linde Air Products Co.*, 336 U.S. 271. In that case Justices Black and Douglas, in a concurring opinion, stated that it is their view that the ultimate question of patentability is a question of law. However, the majority opinion specifically applies Rule 52(a), Federal Rules of Civil Procedure, 28 U.S.C.A., and states, 336 U.S. at page 275:

> '. . . A court of law, such as this Court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional showing of error.'

"And, further, 336 U.S. on page 279:

> '. . . But the record in this case, while not establishing to a certainty that the findings are right, fall far short of convincing us that they are clearly

erroneous. We think that the rules that govern review entitle the trial court's conclusions to prevail and that the process claims are invalid under the statute.'" (175 F.2d 430)

The 8th Circuit in its recent (March 8, 1950) decision in *Trico Products Corporation* vs. *The Delman Corporation et al* (F.2d) expressly held that not only in that case but also *in the case at bar* (i.e. *Alemite* vs. *Jiffy*, 176 F.2d 444) it had given an interpretation to this Court's "flash of creative genius" test of the *Cuno* case (314 U.S. 84) different from that given to it by the 7th, 1st and 6th Circuits in the *Falkenberg*, the *Brown & Sharp* and the *Trabon* cases, supra, as will appear from the following quotation from the 8th Circuit's recent decision in the *Trico* case:

"Sanborn, Circuit Judge.

"The important question for decision in these cases is whether the determination by the District Court that (the) claims . . . . . are void for want of invention, is clearly erroneous.

. . . . . .

"The issues were tried to the District Court without a jury.

. . . . . .

"The District Court determined that, under the evidence and the applicable law, while infringement was apparent if the claims in suit were valid, they were not valid, because the subject matter of the claims involved neither invention nor discovery but only mechanical skill. The court dismissed the plaintiff's complaints.

. . . . . .

"The question whether an improvement involves merely mechanical skill or the exercise of the faculty of invention is a question of fact, and a finding either way upon that question by a trial court is,

under Rule 52(a) of the Rules of Civil Procedure for the United States District Courts (28 U.S.C.A.), conclusive on appeal unless clearly erroneous. (citing authorities)

. . . . . .

"It is our opinion that the conclusion reached by the District Court was, at least, a permissible one and in substantial accord with the decision of the Supreme Court in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U.S. 84 and with the recent decisions of this Court in *Frank Adams Electric Co.* v. *Colt's Patent Fire Arms Mfg. Co.*, 148 F.2d 497; *Koochook Co. Inc.* v. *Barrett*, 158 F.2d 463; *Hall Laboratories, Inc.* v. *Economics Laboratory, Inc.*, 169 F.2d 65; **Alemite Co. v. Jiffy Lubricator Co., 176 F.2d 444** and *Miller* v. *Tilley*, 178 F.2d 526. **It is, no doubt, true that this Court is applying higher standards than it formerly did for determining whether patented improvements of practical value and which have met with commercial success involve invention or only mechanical skill.** Compare, *G. H. Packwood Mfg. Co.* v. *St. Louis Janitor Supply Co.*, 8 Cir., 115 F.2d 958 with *Frank Adam Electric Co.* v. *Colt's Patent Fire Arms Mfg. Co., supra*, 148 F.2d 497. **The Supreme Court has, we think, raised the standards of originality necessary to sustain patents for improvements** such as those involved in the instant cases, **regardless of their usefulness or commercial success.** Compare, *Eibel Process Co.* v. *Minnesota & Temco Electric Motor Company* v. *Apco Manufacturing Company*, 275 U.S. 319 with **Cuno Engineering Corp. v. Automatic Devices Corp.**, supra, 314 U.S. 84.

"The judgment appealed from is affirmed."

In view of the 8th Circuit's clear-cut acknowledgment in its recent decision in the *Trico* case, supra, that it has recently raised its standard of invention or changed its law of invention in reliance upon this Court's decision in the *Cuno* case and was presently applying and *has in*

the case at bar applied a law of invention substantially different or a standard of invention substantially higher than it formerly applied, it is respectfully submitted that the 8th Circuit has made such a shift in the fundamental law of patents as to create confusion and uncertainty both for trial Judges as well as for litigants, particularly in view of the above-cited decisions of the 7th, 1st and 6th Circuits, all construing this Court's decision in the *Cuno* case as *not* changing the law of invention or the standard of invention. Indeed, in the above-cited decisions, the 7th, 1st and 6th Circuits reversed the District Court's fact-findings of non-invention which had been based upon this Court's supposedly different and higher standard of invention claimed to have been promulgated in the *Cuno* case, while in the case at bar the 8th Circuit reversed the jury's fact-finding of invention in reliance upon this Court's *Cuno* decision, while in the still more recent *Trico* case the 8th Circuit affirmed the District-Court's fact-finding of non-invention also upon this Court's *Cuno* decision;—the 8th Circuit disagreeing and being patently in conflict with the 7th, 6th and 1st Circuits as to the construction or interpretation to be placed upon this Court's "flash of creative genius" test in its *Cuno* decision.

Thus, if a jury expressly instructed to apply this Court's "flash of creative genius" test of the *Cuno* case makes a fact-finding of invention in the case where the patent in suit is admittedly not anticipated by the prior-art and the trial Judge concurs in such fact-finding of invention and the Appellate Court reverses such fact-finding of invention even though such fact-finding is entirely in harmony with and supported by, if not indeed required by, the same Appellate Court's earlier decision in *Stewart-Warner* vs. *Jiffy*, 81 F.2d 786, and such reversal of the jury's fact-finding of invention is based upon this Court's supposedly new, different and higher standard of invention claimed to have been promulgated in the *Cuno* case, then there has been such a fundamental shift in the law of patents as it relates to

the all-pervading question of invention, as to make any and all fact-findings of invention by jury and/or trial Judge, meaningless.

Conclusion

The lubricating equipment industry, to which the Johnson patent here in suit relates, has for nineteen years (1920 to 1939) been racked and suppressed by Alemite patent litigation and Alemite-inspired patent litigation, the extent and character of which has not been equalled or even remotely approached in any other industry.

This has now been followed by Alemite's piracy of what it announced to the world as the greatest contribution to the lubricating equipment industry in a decade, i.e. the multi-jawed chuck type hydraulic coupler covered by the Johnson patent here in suit.

It is now poised to launch its new campaign of patent-litigation based upon the much junior Alemite-owned Campbell patent 2,486,133 as indicated in *Appendix F* annexed to petitioner's Reply Brief, which Campbell patent is item 46 in *Appendix E* and is shown in *Appendix G* annexed to petitioner's Reply Brief.

Therefore, not only to resolve the patent conflict between the 8th Circuit, on the one hand, and the 7th, 1st and 6th Circuits, on the other hand, as to the "flash of creative genius" test of the *Cuno* case, but also to avoid further extensive patent litigation in the same industry, certiorari should be granted in the case at bar.

Thus, if the 8th Circuit's interpretation of the "flash of creative genius" test is correct, this Court should now say so, so that the industry as a whole, as well as the trial courts which will be called upon for the next seventeen years to render further decisions in patent litigation in this industry, may know what the law of invention is.

If upon grant of certiorari this Court should hold that the 8th Circuit's interpretation of the "flash of

creative genius" test of the *Cuno* case is correct, there will be no need for further patent litigation in this industry, because, by that test, the Alemite-owned Campbell patent 2,486,133, above referred to will, no doubt, not be asserted.

If, on the other hand, this Court should hold, upon a grant of certiorari in the case at bar, that the 8th Circuit's interpretation of the "flash of creative genius" test of the *Cuno* case is erroneous and that the contrary interpretation of the 7th, 1st and 6th Circuits is correct, then, no doubt, there will likewise be no need for further litigation, because patents will, no doubt, be respected throughout the industry without resort to litigation.

If, however, this Court fails to grant certiorari in the case at bar, the industry faces another 17 years of Alemite patent-litigation, because in the face of the conflict between the 8th Circuit, on the one hand, and the 7th, 1st and 6th Circuits, on the other hand, neither the industry nor the trial courts have any guide-post as to *the law of invention,* and again confusion will reign in this industry as it did from 1920-1939;—confusion which has heretofore been capitalized by Alemite and Stewart-Warner in illegally monopolizing the industry (*Stewart-Warner* vs. *Staley,* 42 F.Supp. 140) for its own sole enrichment.

Therefore, petitioner prays for a re-hearing on its Petition for Writ of Certiorari and in respect to this Court's order of March 13, 1950 denying such Petition;—to the end that this Court may grant certiorari in the case at bar.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1949.

No. 543

JIFFY LUBRICATOR COMPANY, INC.,
Petitioner,

vs.

THE ALEMITE COMPANY,
Respondent.

RESPONDENT'S REPLY TO PETITION FOR REHEARING.

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I.

The Petition for Rehearing Violates Rule 33(2) of This Court and Should Be Denied.

Rule 33(2) of the rules of this Court provides that any petition for rehearing of an order denying a petition for a writ of certiorari must be limited to: (1) "grounds which are confined to intervening circumstances of substantial or controlling effect," or (2) "to other substantial grounds available to petitioner although not previously presented."

Counsel's apologetic certificate in support of the petition for rehearing concedes that the alleged new grounds "not presented" in the petition for writ of certiorari were not

"• • • previously presented *except to the extent* covered by petitioner's Reply Brief filed March 8, 1950." (Emphasis ours.)

The petition for rehearing filed herein does not include any grounds within either category specified in the foregoing rule and for this reason alone the petition for rehearing should be denied.

Ground 1 asserted in the petition for rehearing presents the argument that Gullborg patent No. 1,307,734 (not here in suit, which issued in 1919 and expired almost fourteen years ago) was, during the time it was in force, clothed with an allegedly false cloak of commercial success. It is not shown in the present petition how this allegation, even if true, can impart validity to the Johnson patent here in suit which the Court below stated was clearly invalid as lacking invention over the prior art.

Ground 1 of the petition for rehearing and the allegations with respect thereto are admittedly contained in the reply brief filed by petitioner in support of its petition for certiorari and, therefore, under Rule 33(2) of this Court, cannot provide the basis for a petition for rehearing.

Ground 2 of the petition for rehearing relates to alleged conflicts among the Courts of Appeal as to the interpretation to be placed upon the opinion of this Court in *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, 314 U. S. 84. This argument has heretofore been urged extensively in the petition for certiorari (Question 11, page 37), the brief in support thereof (pages 29 and 30), and in petitioner's reply brief (pages 20 and 21).

In the previous arguments petitioner urged the opinion of the Seventh Circuit Court of Appeals in *Falkenberg* v. *Bernard Edward Co.*, 175 F. 2d 427, "and that of the other circuits whose decisions are cited therein." The

decisions cited therein are *Browne & Sharpe Mfg. Co.* v. *Kar Engineering Co.*, 154 F. 2d 48, and *Trabon Engineering Co.* v. *Dirkes*, 136 F. 2d 24. In its petition for rehearing in support of ground 2, petitioner asserts these same cases and in addition the recent case of *Trico Products Corp.* v. *Delman Corp.*, ... F. 2d..... (84 U. S. P. Q. 416), in which the Eighth Circuit Court of Appeals affirmed the judgment of a trial Court holding two patents invalid. In the *Trico* case the Court merely restated the rule with respect to invention which it set forth in its opinion in the instant case. The decision in the *Trico* case adds nothing to the arguments heretofore presented by petitioner relative to these cases and, therefore, the whole of ground 2 of the petition for rehearing, having been extensively presented to this Court, is not properly within the petition for rehearing.

It is apparent therefore that since both of the grounds of the petition for rehearing have been presented to this Court in the original petition and briefs in support thereof, the present petition for rehearing is not a proper petition under Rule 33(2) and should be denied.

II.

The Petition for Rehearing Is, in Substance, Without Merit.

Petitioner, in its reargument of the matters heretofore brought before this Court in its extensive petition and briefs, again studiously avoids the clear-cut issue determined by the Court below.

Petitioner brought suit for infringement of Johnson patent No. 2,040,177 which issued in 1936. The Court of Appeals below stated, relative to the Johnson patent:

> "• • • What the Johnsons did—as we see it—was to substitute for the bayonet type of connecting means

> of Gullborg, which was old, a chuck type of connecting means, also old * * *. Substituting an old and well known form of coupler for another form of coupler equally well known, did not, in our opinion, require invention, but merely mechanical skill. * * * To use means old in the art to clamp a grease nozzle to a grease fitting, so as to form a tight connection, does not involve patentable invention. * * * it is our opinion that the evidence, viewed in the aspect most favorable to the plaintiff, does not sustain the conclusion that the Johnsons' contribution to the art of lubrication rose to the level of patentable invention." (176 F. 2d 444, 448, 449.)

In the original petition and briefs, petitioner carefully refrained from attempting to point out wherein the Johnson patent contributed anything new to the field of lubricating couplers and failed completely to show wherein the structure of the Johnson patent constitutes an invention over the prior art shown by the record in this case. The petition for rehearing again avoids the only issue determined by the Court of Appeals below. There being no patentable invention in the structure of the Johnson patent, the opinion of the Court below must stand.

In a last ditch effort to persuade this Court to grant certiorari petitioner has attempted to inject into this case a question of illegal patent practice and monopoly. The alleged facts upon which petitioner now argues in support of ground 1 and in its reply brief on the petition for certiorari are outside of the record in this case and have no bearing on the validity of the Johnson patent, the only issue determined by the Court below.

The Gullborg patent of which petitioner complains was issued in 1919 and the last litigation in which it was involved was the decision by this Court in 1936, a few months before the patent expired. The disclosure of the Gullborg patent constitutes art long prior to the Johnson patent

here in suit. Nothing offered by petitioner can attribute any novelty or vitality to the Johnson patent which the Court of Appeals has held clearly invalid.

It is of course impossible—and petitioner does not attempt—to show how the reckless and unfounded charges of illegal practices under the Gullborg patent before 1936 affect the instant suit brought by Jiffy Lubricator Company for infringement of the Johnson patent. The *Hazel Atlas* case and the *Precision Instrument* case urged in support of ground 1 both relate to situations in which illegality relating to the patent in suit was established as a defense. These authorities are therefore not relevant to the present case where plaintiff attempts to employ alleged illegal patent practices ascribed to the defendant as supporting plaintiff's case on a clearly invalid patent.

The case of *Stewart-Warner* v. *Staley,* 42 F. Supp. 140 (relied on in petitioner's Brief in Support of Petition for Writ of Certiorari, p. 15, and Petitioner's Reply Brief, p. 13), is likewise not relevant. Alleged violation of the anti-trust laws was the subject matter of that case. Petitioner errs in stating that the Court there concluded that the anti-trust laws had been violated as the opinion is concerned solely with a motion to strike the complaint.

Ground 2 of the petition for rehearing asserts that the Eighth Circuit Court of Appeals in patent cases has established a standard of invention higher than, and in conflict with, various other Courts of Appeal. Petitioner does not suggest that the standard of invention applied by the Eighth Circuit Court of Appeals is not in conformity with the tests of invention prescribed by this Court. A study of the opinions of the Eighth Circuit Court of Appeals relied upon by petitioner clearly indicates that the Court is applying a standard of invention not in conflict with other Courts of Appeal.

All of the opinions cited by petitioner in ground 2 recognize that there must exist ingenuity beyond the skill of the ordinary mechanic before a Court is warranted in holding that there is a valid patentable invention. Relative to the structure of the Johnson patent, the Court of Appeals below stated:

> "* * * Substituting an old and well known form of a coupler for another form of coupler equally well known, did not, in our opinion, require invention, but merely mechanical skill. * * *
>
> "* * * To use means old in the art to clamp a grease nozzle to a grease fitting so as to form a tight connection, does not involve patentable invention. * * *" (176 F. 2d 444, 448).

Petitioner has failed to show wherein the structure of the Johnson patent distinguishes over the prior art patents in the record. The conclusion that the Johnson patent is clearly invalid for lack of invention is in harmony with the standards of invention set forth in all of the opinions of the various circuits cited by petitioner.

Petitioner's surmise that, upon a denial of its petition for rehearing, the lubricating industry faces dire prospects of continued patent litigation, is lacking in substance. There certainly has been much litigation involving lubricating apparatus including decisions of many Courts of Appeal and at least two decisions of this Court (303 U. S. 545; 298 U. S. 415 and see footnote 3, 298 U. S. 417) setting forth the standards of invention applicable to patents for lubricating apparatus.

Petitioner has been primarily responsible for the existence of such patent litigation since 1938 and such litigation was instituted in the face of these earlier clear-cut opinions reviewing extensive art in this crowded field and establishing the minimum requirements of novelty sufficient to sustain the validity of patents on lubricating ap-

paratus. This litigation has merely confirmed the standards heretofore set.

Respectfully submitted,

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